

Exhibit 6

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13 UNITED STATES DISTRICT COURT
14 NORTHERN DISTRICT OF CALIFORNIA
15 OAKLAND DIVISION
16

17 FINJAN LLC,
18 Plaintiff,
19 v.
20 PALO ALTO NETWORKS, INC.,
21 Defendant.
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Case No. 4:14-CV-04908-PJH

**DEFENDANT PALO ALTO
NETWORKS, INC.'S
INVALIDITY CONTENTIONS
AND RELATED DISCLOSURES
PURSUANT TO PATENT LOCAL
RULES 3-3 AND 3-4**

Courtroom: 3, 3rd Floor
Judge: Honorable Phyllis J. Hamilton

I. PATENT LOCAL RULE 3-3 INVALIDITY CONTENTIONS

In accordance with Patent Local Rules 3-3 and 3-4, Defendant Palo Alto Networks, Inc. (“PAN”) submits invalidity contentions for U.S. Patent No. 6,804,780 (“the ’780 Patent”), U.S. Patent No. 7,418,731 (“the ’731 Patent”), U.S. Patent No. 7,613,926 (“the ’926 Patent”), U.S. Patent No. 7,647,633 (“the ’633 Patent”), U.S. Patent No. 8,141,154 (“the ’154 Patent”), U.S. Patent No. 8,225,408 (“the ’408 Patent”), and U.S. Patent No. 8,677,494 (“the ’494 Patent”) (collectively, the Asserted Patents”).

PAN’s Contentions address the following claims asserted by Finjan LLC (“Finjan”) in its Infringement Contentions, served on April 1, 2021:

<u>U.S. Patent No.</u>	<u>Asserted Claims</u>
6,804,780	1-2, 5, 9-10, 13, 17-18
7,418,731	1-3, 14-15, 17
7,613,926	1-30
7,647,633	14
8,141,154	1-2, 4, 6, 7, 10
8,225,408	1, 3-8, 22
8,677,494	3-5, 7, 10-16

PAN’s discovery and investigation in connection with this lawsuit are ongoing, and these disclosures are based on PAN’s current knowledge and understanding of the ’780, ’731, ’926, ’633, ’154, ’408, and ’494 Patents, Finjan’s Infringement Contentions, the prior art, and other facts and information available at this time in the present action. PAN reserves the right, to the extent permitted by the Court and the applicable rules, to amend, modify, and/or supplement these Contentions and associated document production if PAN obtains additional or different information or if PAN asserts additional or different claims or otherwise modifies its assertions. In particular, Finjan’s deficient Infringement Contentions fail to provide PAN with adequate notice as to Finjan’s infringement theories. Thus, PAN reserves the right to amend, modify, or

1 supplement the information provided herein, including identifying, charting, and relying on
2 additional references.

3 Furthermore, the Court has not yet construed the Asserted Claims in the present action.
4 Accordingly, PAN reserves the right to amend, modify, or supplement these Contentions should
5 any of the claim limitations be construed by the Court. PAN further reserves the right to amend,
6 modify, or supplement these Contentions in response to any proposed claim construction or
7 alleged supporting evidence offered by Finjan, any report from any expert witness for Finjan
8 regarding claim construction, any claim construction briefing filed by Finjan, and any position
9 taken by Finjan concerning claim construction, infringement, validity, or other relevant issues.

10 To the extent that these Contentions reflect constructions of claim terms that may be
11 consistent with or implicit in Finjan's Infringement Contentions, no inference is intended or
12 should be drawn that PAN agrees with such claim constructions. These Contentions are not
13 intended to reflect PAN's claim construction positions, which will be disclosed in due course in
14 accordance with this Court's Scheduling Order. Moreover, PAN's Contentions, including the
15 attached claim charts, may reflect alternative positions as to claim construction and claim scope.
16 Nothing in this document should be construed as an admission that PAN agrees with Finjan's
17 assertions or that any claim is valid, enforceable, or infringed.

18 The accompanying claim charts list specific examples of prior art that included and/or
19 disclosed, either expressly or inherently, each limitation of the identified claims and/or made
20 obvious each limitation of the identified claims. PAN has endeavored to identify relevant
21 portions and/or features of the identified prior art. The identified prior art, however, may
22 contain additional descriptions of or alternative support for the claim limitations. The citations
23 included in each chart are illustrative, not exhaustive. PAN may rely on un-cited portions or
24 features of the identified prior art, other documents, and fact and expert testimony to provide
25 context or to aid in understanding the identified prior art. Where PAN cites to a particular
26 figure in a reference, the citation should be understood to encompass the caption and
27 description of the figure and any text relating to the figure. Similarly, where PAN cites to
28 particular text referring to a figure, the citation should be understood to include the figure and

1 caption as well. The claims addressed in the charts are anticipated and/or rendered obvious under
2 35 U.S.C. § 102 and/or § 103.

3 Finjan has not provided sufficient evidence of conception and reduction to practice of the
4 '780, '731, '926, '633, '154, '408, and '494 Patents. Thus, the '780, '731, '926, '633, '154, '408,
5 and '494 Patents are not entitled to any date of invention earlier than their effective filing date.
6 To the extent Finjan is able to assert an earlier date of invention for the '780, '731, '926, '633,
7 '154, '408, and '494 Patents, PAN further reserves its right to amend, modify, or supplement its
8 Contentions, including, but not limited to its identification and production of prior art.

9 To the extent a prior art reference is identified as part of one or more combinations of
10 references under 35 U.S.C. § 103, PAN reserves the right to chart that reference independently
11 under 35 U.S.C. § 102 at a later date should circumstances dictate. Further, in many instances
12 where a particular contention calls for combining references, any one of a number of references
13 can be combined. The inclusion of certain exemplary combinations of prior art references does
14 not exclude other combinations.

15 Moreover, as certain prior art references and inventions are described in multiple related
16 patents or publications with similar or identical specifications or disclosures, to the extent PAN
17 has identified a citation in one reference, PAN reserves the right to rely on parallel or similar
18 citations in related patents or publications. Persons of ordinary skill in the art ("POSITA") would
19 read a prior art reference and understand a prior art invention as a whole and in the context of
20 other publications and known technologies. Therefore, to understand and interpret any specific
21 statement or disclosure of a prior art reference or invention, such persons would rely on other
22 information within the reference or invention, along with other publications and known
23 technologies. PAN reserves the right to establish what was known to persons of ordinary skill in
24 the art through other publications, products, and/or testimony. PAN also reserves the right to rely
25 on uncited portions of the prior art references, other publications, and testimony to establish that a
26 POSITA would have been motivated to combine certain of the cited references so as to render the
27 claims obvious.

28 PAN may also rely on other documents and information, including inventor admissions,

1 concerning the scope of the Asserted Claims, and prior art relevant to the Asserted Claims, found
2 in: the '780, '731, '926, '633, '154, '408, and '494 Patents, the patent prosecution histories for
3 the '780, '731, '926, '633, '154, '408, and '494 Patents, and related patents and/or patent
4 applications; any deposition testimony of any inventor of the '780, '731, '926, '633, '154, '408,
5 and '494 Patents; any previous trial testimony of any inventor of the '780, '731, '926, '633, '154,
6 '408, and '494 Patents; and any papers filed or any evidence produced or submitted by Finjan in
7 connection with this litigation, any pending litigation, or any previous litigation, related to the
8 '780, '731, '926, '633, '154, '408, and '494 Patents. In particular, PAN reserves the right to
9 contend that the Asserted Claims are invalid under 35 U.S.C. § 102(f) in the event PAN obtains
10 evidence that the inventors named on the '780, '731, '926, '633, '154, '408, and '494 Patents did
11 not invent (either alone or in conjunction with others) the subject matter claimed in the '780,
12 '731, '926, '633, '154, '408, and '494 Patents.

13 PAN's investigation of prior art systems and products is ongoing. PAN has diligently
14 sought and will continue to diligently seek discovery from Finjan and third parties to
15 demonstrate earlier invention and reserves its right to contend that the Asserted Claims are
16 invalid under 35 U.S.C. § 102(g). To date, Finjan has not produced all relevant discovery
17 requested by PAN regarding, among other things, prior art systems and products; therefore, PAN
18 reserves the right to raise any such or further deficiencies with Finjan and/or the Court as needed
19 and further reserves the right to amend, modify, and/or supplement its Contentions. PAN has
20 also sought discovery and is continuing to seek discovery on the issues of public use and/or the
21 on-sale bar, which discovery is ongoing, and reserves its right to contend that the Asserted
22 Claims are invalid under 35 U.S.C. § 102(b). PAN's further investigation and/or subsequent
23 discovery from Finjan or third parties with knowledge regarding prior art systems and products
24 may reveal additional relevant prior art systems and products and/or further information
25 regarding the systems and products in these Contentions. PAN reserves the right to amend,
26 modify, and/or supplement these Contentions, based on further and subsequent investigation and
27 discovery.

28 PAN has received initial production of documents from third parties, including Sophos,

1 Trend Micro, and Check Point in response to PAN's subpoenas. PAN is reviewing these
 2 documents and will amend, modify, and/or supplement its Contentions as necessary and/or as
 3 further productions are made from these parties, including source code productions.

4 In addition to the prior art identified below and the accompanying invalidity claim charts,
 5 PAN also incorporates by reference any invalidity contentions, identified prior art, or
 6 invalidity claim charts disclosed at any date by any party to any other litigation or U.S. Patent &
 7 Trademark Office proceeding involving the '780, '731, '926, '633, '154, '408, and '494 Patents
 8 or any related patent. PAN also hereby incorporates by reference the prior art, invalidity
 9 grounds, and expert testimony submitted in connection with any petitions for *inter partes* review
 10 of the '780, '731, '926, '633, '154, '408, and '494 Patents.

11 For each Asserted Claim, PAN: (a) identifies each currently known item of prior art that
 12 either anticipates or renders obvious each asserted claim; (b) specifies whether each such item of
 13 prior art anticipates or renders obvious the applicable claims; and (c) submits charts for
 14 illustrative prior art references identifying exemplary reference portions where each element is
 15 disclosed or rendered obvious by the prior art.

16 Based on PAN's present understanding of the Asserted Claims and/or Finjan's apparent
 17 construction of the claims, as set forth in Finjan's Infringement Contentions, PAN has identified
 18 grounds for invalidating asserted claims based on indefiniteness, enablement, or written
 19 description under 35 U.S.C. § 112. PAN is not adopting Finjan's apparent constructions, nor is
 20 PAN agreeing that any of Finjan's apparent constructions are correct. PAN reserves all rights to
 21 advance claim construction positions different from Finjan's apparent constructions.

22 Moreover, Finjan's deficient Infringement Contentions fail to provide PAN with adequate
 23 notice as to Finjan's infringement theories. In light of the deficiencies in Finjan's Infringement
 24 Contentions, PAN reserves the right to amend, modify, and/or supplement these Contentions to
 25 further identify bases for invalidity under 35 U.S.C. § 112, ¶¶ 1, 2. PAN's Contentions shall not
 26 be construed as an admission that any claim construction advanced by PAN in this case is in any
 27 way inconsistent, flawed or erroneous. Nor should these Contentions prevent PAN from
 28 advancing claim construction and/or non-infringement positions in lieu of, in addition to, or as an

1 alternative basis for, its invalidity positions. Further, PAN's Contentions shall not be construed
 2 as an admission of or acquiescence to Finjan's purported construction of the claim language or of
 3 other positions advanced by Finjan during the course of this litigation.

4 Finjan also has failed to timely update its production of materials from its other cases.
 5 PAN incorporates the prior art, claims charts, and invalidity theories disclosed, listed and/or
 6 asserted by any entity during the course of other litigation (past, present/ongoing, or future) or
 7 patent office challenges (either reexaminations or IPRs). Finjan has failed to timely update its
 8 production of these materials, which has prejudiced PAN in its preparation of these contentions.
 9 PAN reserves the right to rely on any prior art reference, prior art combination, motivation to
 10 combine, invalidity theory, and/or materials disclosed in these other proceedings.

11 **A. Invalidity of the '780 Patent**

12 **1. Priority Date**

13 Finjan alleges that each of the Asserted Claims of the '780 Patent is entitled to a priority
 14 date of November 8, 1996. Finjan's Initial Disclosure of Asserted Claims and Infringement
 15 Contentions, at 20. Finjan apparently alleges that the Asserted Claims of the '780 Patent are
 16 entitled to the benefit of the filing date of a provisional application which was filed on
 17 November 8, 1996, rather than the filing date of the '780 Patent's parent application, which was
 18 filed on November 6, 1997, and which eventually matured into U.S. Patent No. 6,092,194 ("the
 19 '194 Patent"). The provisional application to which Finjan claims priority, however, does not
 20 disclose the subject matter claimed in the '780 Patent nor the subject matter disclosed in the non-
 21 asserted '194 Patent. Thus, based on the information presently available to PAN, the earliest date
 22 to which the '780 Patent may claim priority is November 6, 1997, the date on which the
 23 application which issued as the '194 Patent was filed, or March 30, 2000, the date on which the
 24 application which led to the '780 Patent was filed.

25 **2. Patent L.R. 3-3(a) Identification of Prior Art**

26 Subject to the reservations of rights above, PAN identifies prior art that anticipates and/or
 27 renders obvious one or more of the Asserted Claims of the '780 Patent. The prior art references
 28 identified are also relevant to show the state of the art and reasons and motivations for making

improvements, additions, modifications, and combinations.

In addition, PAN incorporates the prior art, claims charts, and invalidity theories disclosed, listed and/or asserted by any entity during the course of other litigation (past, present/ongoing, or future) or patent office challenges (either reexaminations or IPRs). Finjan has failed to timely update its production of these materials, which has prejudiced PAN in its preparation of these contentions. PAN reserves the right to rely on any prior art reference, prior art combination, motivation to combine, invalidity theory, and/or materials disclosed in these other proceedings. At least the following prior art references anticipate and/or render obvious the Asserted Claims of the '780 Patent, and/or illustrate the state of the art at the time of the alleged invention:

a. Patent Prior Art

Ref. No.	Publication No.	Short Name	Filing Date	Publication Date	Priority Date
1.	U.S. 6,263,442	"Mueller"	May 30, 1996	July 17, 2001	May 30, 1996
2.	U.S. 6,083,279	"Cuomo"	October 10, 1996	July 4, 2000	October 10, 1996
3.	U.S. 5,983,348	"Ji '348"	September 10, 1997	November 9, 1999	September 10, 1997
4.	U.S. 5,337,360	"Fischer"	January 5, 1994	August 9, 1994	January 5, 1994
5.	U.S. 5,815,709	"Waldo"	April 23, 1996	September 29, 1998	April 23, 1996
6.	U.S. 5,894,516	"Brandenburg"	July 10, 1996	April 13, 1999	July 10, 1996
7.	U.S. 6,253,323	"Cox"	November 1, 1996	June 26, 2001	November 1, 1996
8.	U.S. 6,367,012	Atkinson	December 6, 1996	April 2, 2002	December 6, 1996

b. Non-Patent Publication Prior Art

Ref. No.	Publication	Short Name	Publication Date
1.	Secure Mobile Code Management: Enabling Java for the Enterprise	Herbert	May 1997
2.	Sale Web Surfing with the Internet Component Download Service	Kirtland	July 1996
3.	Internet Component Download	Microsoft	January 1996
4.	Trust Management for the World Wide Web	Chu	June 13, 1997
5.	A Flexible Security Model for Using Internet Content	Islam	October 1997
6.	Blocking Applets at the Firewall	Martin	February 10, 1997

PAN additionally identifies and relies on each of the additional patent or publication references that describe or are otherwise related to the prior art systems identified below.

c. System or Product Prior Art

PAN sets forth numerous prior art products or systems in the table below. For such prior art products and systems, PAN has identified, based on its current knowledge, approximate dates on which such products were sold, on sale, made, known, and/or used in the U.S. PAN's investigation of prior art products and systems is ongoing. Further information and/or documents regarding such products and their sale, offer for sale, and use dates will be produced or disclosed as it is (they are) obtained in discovery or otherwise becomes available to PAN. PAN reserves the right to amend, modify, and/or supplement these Contentions based on further and subsequent investigation and discovery. Additionally, PAN reserves the right to rely on the documents identified below as standalone prior art references separate from the prior art system or product they describe.

PAN additionally identifies and relies on any system, product, or public knowledge or use that embodies or otherwise incorporates any of the prior art patents and publications listed above. PAN reserves the right to identify and rely on systems that represent different versions or are

otherwise related variations of the identified products and systems.

Ref No.	System Name	Short Name	Date Made, Known, Used, Sold, or On Sale
1.	InterScan AppletTrap	AppletTrap	March 23, 1999

(i) InterScan AppletTrap (“AppletTrap”)

AppletTrap was sold, on sale, made, known, and/or used at least by March 23, 1999. The features, operations, and functionality of AppletTrap are described throughout the Trend Micro, Inc. documentation produced in this case. These documents include:

- TFS00000001 – TFS00005934
- TM-FIN000001 – TM-FIN000563

d. 35 U.S.C. § 102(f)

PAN reserves the right to assert that the Asserted Claims are invalid under 35 U.S.C. § 102(f) in the event PAN obtains additional evidence that the inventors named in any of the Asserted Patents did not invent the subject matter claimed therein. Should PAN obtain such evidence, it will provide the name of the person(s) from whom and the circumstances under which the alleged invention or any part of it was derived.

e. 35 U.S.C. § 102(g)

PAN reserves the right to assert that the Asserted Claims are invalid under 35 U.S.C. § 102(g) in the event PAN obtains additional evidence that any of the inventions claimed in the Asserted Patents were made in the United States by another inventor who had not abandoned, suppressed or concealed it, prior to the alleged invention by the applicant of the Asserted Patents. Should PAN obtain such evidence, it will provide the identities of the persons or entities involved in and the circumstances surrounding the making the inventions before the patent applicants.

3. Patent L.R. 3-3(b) Anticipation and Obviousness

The references in Table 1, alone or in combination with the knowledge of one skilled in the art, anticipate or render obvious the Asserted Claims of the ’780 Patent.

Table 1: Prior Art References: Anticipation and Primary/Secondary Obviousness
References

Short Name	Prior Art Under	Priority Date	Exemplary Claim Chart
Mueller	102(e)	May 30, 1996	A-1
Cuomo	102(e)	October 10, 1996	A-2
Herbert	102(a)	May 1997	A-3
Ji '348	102(e)	September 10, 1997	A-4
Fischer	102(a)	January 5, 1994	A-5
Waldo	102(e)	April 23, 1996	A-6
Brandenburg	102(e)	July 10, 1996	A-7
Cox	102(e)	November 1, 1996	A-8
Kirtland	102(a)	July 1996	A-9
Microsoft	102(a)	January 1996	A-10

In addition, each of the references in Table 1 above and Table 2 below, either alone, in view of the knowledge of a POSITA, and/or in combination with one or more references in Table 1 or Table 2, renders obvious the Asserted Claims of the '780 Patent.

Table 2: Additional Prior Art References: Obviousness

Short Name	Prior Art Under	Priority Date
Islam	102(a)	October 1997
Chu	102(a)	June 13, 1997
Atkinson	102(e)	December 6, 1996
Martin	102(a)	February 10, 1997

In addition, PAN incorporates by reference each and every prior art reference of record in the prosecution of the '780 Patent and any related patent or application, the statements made

1 therein by the applicant, as well as the prior art discussed in the specification.

2 The cited portions of each prior art reference are exemplary and representative of the
3 content of the reference, and should be understood in the context of the reference as a whole, as
4 understood by one of ordinary skill in the art. To the extent a prior art reference is deemed not to
5 anticipate or render obvious a claim as noted in the attached charts for failing to disclose, teach,
6 or suggest one or more limitations of a claim, that claim would nonetheless have been obvious to
7 one of ordinary skill in the art at the time of the alleged invention over the reference itself or by
8 the combination of the reference with one or more other references disclosing the missing claim
9 limitations or the knowledge of a person having ordinary skill in the art.

10 **a. Prior Art Combinations**

11 All of the Asserted Claims of the '780 Patent are obvious based on one or more
12 combinations of the prior art references above. The sections below provide motivations to
13 combine the prior art references above. These obviousness combinations are provided in the
14 alternative to PAN's anticipation and single-reference obviousness contentions and are not to be
15 construed to suggest that any reference included in the combination is not itself anticipatory or
16 would not render the Asserted Claims obvious in light of the knowledge of a person having
17 ordinary skill in the art. PAN also hereby incorporates by reference the prior art, invalidity
18 grounds, and expert testimony submitted in connection with any petitions for *inter partes* review
19 of the '780 Patent.

20 **b. Motivation to Combine**

21 A POSITA would have been motivated to combine the preceding references for any
22 number of reasons, such as the following exemplary reasons. Teachings, suggestions,
23 motivations, and/or reasons to modify any of the references and/or to combine any two or more of
24 the references can come from many sources, including the prior art, common knowledge,
25 common sense, predictability, expectations, industry trends, design incentives or need, market
26 demand or pressure, market forces, obviousness to try, the nature of the problem faced, and/or
27 knowledge possessed by a POSITA.

28 Although a patent claim may be invalidated based on a teaching-suggestion-motivation

1 (“TSM”) rationale—*i.e.*, that some teaching, suggestion, or motivation in the prior art that would
 2 have led one of ordinary skill to modify the prior-art reference or to combine prior-art reference
 3 teachings to arrive at the claimed invention—the Supreme Court identified additional rationales
 4 in *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007). The following of these rationales apply
 5 here:

6 (A) the Asserted Claims combine prior-art elements according to known methods
 to yield predictable results;

7 (B) the Asserted Claims involve the simple substitution of one known element for
 8 another to obtain predictable results;

9 (C) the Asserted Claims involve the use of a known technique to improve similar
 devices (methods, or products) in the same way;

10 (D) the Asserted Claims apply a known technique to a known device (method, or
 11 product) ready for improvement to yield predictable results;

12 (E) the Asserted Claims involve combinations of prior-art references that would
 have been “obvious to try”—a person of ordinary skill in the art could have
 13 reached the Asserted Claims by choosing from a finite number of identified,
 predictable solutions, with a reasonable expectation of success;

14 (F) the Asserted Claims are simply variations of work from one field of endeavor
 15 or a different one that would have been prompted based on design incentives or
 other market forces because the variations were predictable to one of ordinary skill
 16 in the art.

17 *See KSR*, 550 U.S. at 415-18 (rejecting the Federal Circuit’s “rigid” application of the teaching,
 suggestion, or motivation to combine test, and instead espousing an “expansive and flexible”
 18 approach). Indeed, the Supreme Court held that a person of ordinary skill in the art is “a person
 19 of ordinary creativity, not an automaton” and “in many cases a person of ordinary skill in the art
 20 will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *KSR*, 550
 21 U.S. at 420-21.

22 Thus, even in the absence of a specific teaching, suggestion, or motivation to combine
 23 references, the Asserted Claims here are obvious and therefore invalid. Each of the cited
 24 references or devices is in the same field, making it obvious for someone of ordinary skill in the
 25 art to identify and combine elements from these references. One of ordinary skill in the art would
 26 have recognized that improvements could be achieved by combining or modifying prior-art
 27 references that described such improvements. Each of the above prior-art references describes
 28

1 devices or methods that were known to offer such improvements, and, accordingly, one of
2 ordinary skill in the art would have been motivated to combine or modify the references as
3 identified in each of the combinations above.

4 Indeed, given that the references are in the same field, one of ordinary skill would have
5 readily, with predictable results, taken teachings from one reference and applied them to other
6 references. As referenced above, multiple prior art references teach or suggest the concepts
7 claimed in the '780 Patent. To the extent Finjan argues that any concepts claimed in the
8 '780 Patent were not contained in any prior art reference, it would, at a minimum, have been
9 obvious to adapt each reference to include the concept or combine it with other references that
10 disclose the concept. In addition, each of the constituent techniques described here was well
11 known to those of ordinary skill in the art, and understood to be among a menu of available
12 design choices for computer and network security, including the prevention and identification of
13 malicious executables via a firewall or similar technology. This is one of many motivations to
14 combine the above references.

15 Furthermore, because common techniques such as fetching software components and
16 creating hash functions for the prevention and identification of malicious executables via a
17 firewall or similar technology were well known and studied extensively prior to the '780 Patent
18 priority date, common industry knowledge supplied a reason to combine the above references
19 with each other. Each combination would have produced no unexpected results and would
20 simply represent a known alternative to one of ordinary skill in the art. This is a further
21 motivation to combine any of the above references.

22 The below sections further address particular reasons to combine the above references.
23 The below should not be construed as an admission that there is any value to the alleged invention
24 of the '780 Patent. As discussed previously, these contentions are based largely on how Finjan is
25 apparently construing the Asserted Claims in its Initial Infringement Contentions, which is an
26 incorrect and overbroad interpretation of the alleged invention of the '780 Patent. Accordingly,
27 to the extent the below refers to benefits of certain elements or industry trends towards these
28 elements, this is not an admission that the alleged invention of the '780 Patent provides any

1 benefits—to the contrary, properly construed and compared to the prior art, the ’780 Patent
2 provides no benefits. Likewise, to the extent the below refers to substituting elements, this is not
3 an admission that the elements subject to the substitution are in any way similar, *e.g.*, perform the
4 same function, in the same way, to reach the same result.

5 The various elements of the Asserted Claims were well-known in the prior art at the time
6 of the alleged invention, and the combination was obvious to one of ordinary skill in the art. The
7 combination simply (a) combines prior-art elements according to known methods to yield
8 predictable results; (b) involves the simple substitution of one known element for another to
9 obtain predictable results; (c) involves the use of a known technique to improve similar devices
10 (methods, or products) in the same way; (d) applies a known technique to a known device
11 (method, or product) ready for improvement to yield predictable results; (e) involves
12 combinations of prior-art references that would have been “obvious to try”—a person of ordinary
13 skill in the art could have reached the Asserted Claims by choosing from a finite number of
14 identified, predictable solutions, with a reasonable expectation of success; and/or (f) would have
15 been prompted by known work, based on design incentives or other market forces, because such
16 variations were predictable to one of ordinary skill in the art.

17 Moreover, the Supreme Court has stated that a motivation to combine may be simply
18 “common sense” and that “familiar items may have obvious uses beyond their primary purposes,
19 and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents
20 together like pieces of a puzzle.” *KSR*, 550 U.S. at 420. Indeed, the Supreme Court held that it is
21 sufficient that a combination of elements was “obvious to try,” holding that, “[w]hen there is a
22 design need or market pressure to solve a problem and there are a finite number of identified,
23 predictable solutions, a person of ordinary skill has good reason to pursue the known options
24 within his or her technical grasp.” *Id.* at 421. Here, all the claim elements are common sense and
25 are easily fit together by one of ordinary skill in the art.

26 While not necessary, a motivation to combine may also be found in the references
27 themselves. One of ordinary skill in the art would have been motivated to combine a reference
28 that refers to, or otherwise explicitly invites combination with, another reference. Where the

1 references cited herein have such an explicit invitation to combine, that invitation would have
 2 motivated one of ordinary skill in the art to combine any such references.

3 **c. Exemplary Obviousness Combinations**

4 The accompanying claim charts explain how different portions of each prior art reference
 5 discloses each limitation of the Asserted Claims. If Finjan argues that any particular prior art
 6 reference lacks any feature, a POSITA as of the '780 Patent's priority date would at a minimum
 7 have been motivated to modify the reference to include the allegedly missing feature, or to
 8 combine it with other references that include that feature, as discussed in the previous section.

9 To the extent Finjan asserts that the prior art in Table 1 does not disclose these claim
 10 limitations, it would have been obvious to combine or modify each of the prior art references in
 11 Table 1 and/or Table 2 with one or more prior art references in Table 1 and/or Table 2 to create
 12 computer-based methods, systems and products for identifying, categorizing and preventing
 13 malicious Downloadables, as discussed in Mueller, Cuomo, Herbert, Ji '348, Fischer, Waldo,
 14 Brandenburg, Cox, Kirtland, and Microsoft.

15 To the extent that Finjan argues that any of these references do not satisfy the "obtaining a
 16 Downloadable" limitations, it would have been obvious to modify those references to allow for
 17 the obtaining of a Downloadable in some form for identification analysis to be performed on the
 18 Downloadable, as described in Mueller, Cuomo, Herbert, Ji '348, Fischer, Waldo, Brandenburg,
 19 Cox, Kirtland, and Microsoft. One of ordinary skill in the art would have been motivated to
 20 combine Mueller, Cuomo, Herbert, Ji '348, Fischer, Waldo, Brandenburg, Cox, Kirtland, and
 21 Microsoft, with one or more other references identified in Table 1 and/or 2 and would have
 22 reasonably expected that the combination would achieve the intended purpose. Each reference
 23 relates to computer and network security. A person of ordinary skill in the art looking to create
 24 improved computer security methods and products would look to consider solutions implemented
 25 in other computer security methods and products such as those disclosed in Mueller, Cuomo,
 26 Herbert, Ji '348, Fischer, Waldo, Brandenburg, Cox, Kirtland, Microsoft, and other references as
 27 described in PAN's Invalidity Contentions and associated claim charts. A person of ordinary skill
 28 in the art looking to solve this problem would review patents, patent publications and prior art

1 systems in the field of computer and network security such as Mueller, Cuomo, Herbert, Ji '348,
2 Fischer, Waldo, Brandenburg, Cox, Kirtland, Microsoft, and other references as described in
3 PAN's Invalidity Contentions and associated claim charts. One of ordinary skill in the art also
4 would have reasonably expected that such combination of Mueller, Cuomo, Herbert, Ji '348,
5 Fischer, Waldo, Brandenburg, Cox, Kirtland, Microsoft, Martin, and other references as described
6 in Table 1 and/or 2 and associated claim charts would achieve the desired structure and
7 functionality of obtaining incoming Downloadables, for such structures and mechanisms were
8 well known in the art and would have been obvious to one of ordinary skill in the art.

9 To the extent that Finjan argues that any of these references do not satisfy the "fetching"
10 limitations, it would have been obvious to modify those references to be able to fetch one or more
11 software components, and to be able to reference them in a number of ways, as described in
12 Mueller, Cuomo, Herbert, Ji '348, Fischer, Waldo, Brandenburg, Cox, Kirtland, and Microsoft.
13 One of ordinary skill in the art would have been motivated to combine Mueller, Cuomo, Herbert,
14 Ji '348, Fischer, Waldo, Brandenburg, Cox, Kirtland, and Microsoft, with one or more other
15 references identified in Table 1 and/or 2 and would have reasonably expected that the
16 combination would achieve the intended purpose. Each reference relates to computer and network
17 security. A person of ordinary skill in the art looking to create improved computer security
18 methods and products would look to consider solutions implemented in other computer security
19 methods and products such as those disclosed in Mueller, Cuomo, Herbert, Ji '348, Fischer,
20 Waldo, Brandenburg, Cox, Kirtland, Microsoft, and other references as described in PAN's
21 Invalidity Contentions and associated claim charts. A person of ordinary skill in the art looking to
22 solve this problem would review patents, patent publications and prior art systems in the field of
23 computer and network security such as Mueller, Cuomo, Herbert, Ji '348, Fischer, Waldo,
24 Brandenburg, Cox, Kirtland, Microsoft, and other references as described in PAN's Invalidity
25 Contentions and associated claim charts. One of ordinary skill in the art also would have
26 reasonably expected that such combination of Mueller, Cuomo, Herbert, Ji '348, Fischer, Waldo,
27 Brandenburg, Cox, Kirtland, Microsoft, Martin, and other references as described in Table 1
28 and/or 2 and associated claim charts would achieve the desired structure and functionality of

1 “fetching” Downloadables and other software components, for such structures and mechanisms
2 were well known in the art and would have been obvious to one of ordinary skill in the art.

3 To the extent that Finjan argues that any of these references do not satisfy the “hashing”
4 limitations, it would have been obvious to modify those references to allow for the hashing of a
5 Downloadable with fetched software components to generate a Downloadable ID, or substantially
6 similar process, because the process of hashing one or more software components via a
7 mathematical process to create a unique identification code was well known in the art and would
8 have been obvious to one of ordinary skill in the art, and was a well-known method in the field of
9 computer security as described in Mueller, Cuomo, Herbert, Ji ’348, Fischer, Waldo,
10 Brandenburg, Cox, Kirtland, and Microsoft. One of ordinary skill in the art would have been
11 motivated to combine Mueller, Cuomo, Herbert, Ji ’348, Fischer, Waldo, Brandenburg, Cox,
12 Kirtland, and Microsoft with one or more other references identified in Table 1 and/or Table 2
13 and would have reasonably expected that the combination would achieve the intended purpose.
14 Each reference relates to computer and network security. A person of ordinary skill in the art
15 looking to create improved computer security methods and products would look to consider
16 solutions implemented in other computer security methods and products such as those disclosed
17 in Mueller, Cuomo, Herbert, Ji ’348, Fischer, Waldo, Brandenburg, Cox, Kirtland, Microsoft and
18 other references as described in PAN’s Invalidity Contentions and associated claim charts. A
19 person of ordinary skill in the art looking to solve this problem would review patents, patent
20 publications and prior art systems in the field of computer and network security such as Mueller,
21 Cuomo, Herbert, Ji ’348, Fischer, Waldo, Brandenburg, Cox, Kirtland, Microsoft and other
22 references as described in PAN’s Invalidity Contentions and associated claim charts. One of
23 ordinary skill in the art also would have reasonably expected that such combination of Mueller,
24 Cuomo, Herbert, Ji ’348, Fischer, Waldo, Brandenburg, Cox, Kirtland, Microsoft and other
25 references as described in Table 1 and/or Table 2 and associated claim charts would achieve the
26 desired structure and functionality of performing a hashing function on a Downloadable and its
27 fetched software components to generate a Downloadable ID, for such structures and mechanisms
28 were well known in the art and would have been obvious to one of ordinary skill in the art.

1 To the extent that Finjan argues that any of these references do not satisfy limitations
2 related to different items which a Downloadable “includes” (such as an applet, active control, and
3 program script), it would have been obvious to modify those references to allow for a
4 Downloadable to include these features, as described in Mueller, Cuomo, Herbert, Ji ’348,
5 Fischer, Waldo, Brandenburg, Cox, Kirtland, Microsoft, Martin, Islam (*see, e.g.*, at 2, 10), Chu
6 (*see, e.g.* at 23, 30), and Atkinson (*see, e.g.* at 2:35-43). One of ordinary skill in the art would
7 have been motivated to combine Mueller, Cuomo, Herbert, Ji ’348, Fischer, Waldo, Brandenburg,
8 Cox, Kirtland, Microsoft, Martin, Islam (*see, e.g.*, at 2, 10), Chu (*see, e.g.* at 23, 30), and
9 Atkinson (*see, e.g.* at 2:35-43), with one or more other references identified in Table 1 and/or
10 Table 2 and would have reasonably expected that the combination would achieve the intended
11 purpose. Each reference relates to computer and network security. A person of ordinary skill in
12 the art looking to create improved computer security methods and products would look to
13 consider solutions implemented in other computer security methods and products such as those
14 disclosed in Mueller, Cuomo, Herbert, Ji ’348, Fischer, Waldo, Brandenburg, Cox, Kirtland,
15 Microsoft, Martin, Islam (*see, e.g.*, at 2, 10), Chu (*see, e.g.* at 23, 30), Atkinson (*see, e.g.* at 2:35-
16 43) and other references as described in PAN’s Invalidity Contentions and associated claim
17 charts. A person of ordinary skill in the art looking to solve this problem would review patents,
18 patent publications and prior art systems in the field of computer and network security such as
19 Mueller, Cuomo, Herbert, Ji ’348, Fischer, Waldo, Brandenburg, Cox, Kirtland, Microsoft,
20 Martin, Islam (*see, e.g.*, at 2, 10), Chu (*see, e.g.* at 23, 30), Atkinson (*see, e.g.* at 2:35-43) and
21 other references as described in PAN’s Invalidity Contentions and associated claim charts. One of
22 ordinary skill in the art also would have reasonably expected that such combination of Mueller,
23 Cuomo, Herbert, Ji ’348, Fischer, Waldo, Brandenburg, Cox, Kirtland, Microsoft, Martin, Islam
24 (*see, e.g.*, at 2, 10), Chu (*see, e.g.* at 23, 30), Atkinson (*see, e.g.* at 2:35-43) and other references
25 as described in Table 1 and/or Table 2 and associated claim charts would achieve the desired
26 structure and functionality of including commonly used types of files for carrying malware in a
27 Downloadable, for such structures and mechanisms were well known in the art and would have
28 been obvious to one of ordinary skill in the art.

PAN reserves the right to rely on additional combinations.

4. Patent L.R. 3-3(c) Invalidity Contentions Charts

Pursuant to Patent Local Rule 3-3(c), charts identifying specifically where and how in each alleged item of prior art each limitation of each asserted claim is found are attached as Exhibits A-1 to A-10. Where elements are disclosed at multiple locations within a single item of prior art, PAN has not necessarily identified every iteration of every disclosure.

5. Patent L.R. 3-3(d) Invalidity Based on 35 U.S.C. § 101, Indefiniteness Under 35 U.S.C. § 112(2), or Enablement or Written Description Under 35 U.S.C. § 112(1)

Based on PAN's present understanding of the Asserted Claims and/or PAN's apparent construction of the claims, as set forth in Finjan's Infringement Contentions, and subject to the reservation of rights above, PAN lists below the grounds upon which the Asserted Claims of the '780 Patent are invalid based on 35 U.S.C. § 101, indefiniteness, lack of written description, and/or lack of enablement under 35 U.S.C. § 112. To the extent PAN's identified grounds for invalidity are based on Finjan's apparent constructions, PAN is not adopting Finjan's apparent constructions, nor is PAN agreeing that any of Finjan's apparent constructions are correct. Moreover, Finjan's deficient Infringement Contentions fail to provide PAN with adequate notice as to Finjan's infringement theories. PAN reserves all rights to advance claim construction positions different from Finjan's apparent constructions.

PAN's contentions that the following claims are invalid under 35 U.S.C. § 112 are made in the alternative, and do not constitute, and should not be interpreted as, admissions regarding the construction or scope of the Asserted Claims, or that any of the Asserted Claims are not anticipated or rendered obvious by any prior art. Where PAN identifies a claim term in an independent claim as being invalid, PAN further contends any asserted dependent claim is invalid based on the presence of the same term.

In light of the deficiencies in Finjan's Infringement Contentions, PAN reserves the right to amend, modify, and/or supplement these Contentions to further identify bases for invalidity under 35 U.S.C. § 112. PAN's Contentions shall not be construed as an admission that any claim construction advanced by PAN in this case is in any way inconsistent, flawed or erroneous. Nor

1 should these Contentions prevent PAN from advancing claim construction and/or non-
 2 infringement positions in lieu of, or in addition to, invalidity positions. Further, PAN's
 3 Contentions shall not be construed as an admission of or acquiescence to Finjan's purported
 4 construction of the claim language or of other positions advanced by Finjan during the course of
 5 this litigation. PAN's Contentions under 35 U.S.C. § 112 may depend, in part, on the Court's
 6 claim construction, as well as Finjan's asserted claim scope. Consequently, PAN only identifies
 7 herein the issues under 35 U.S.C. § 112 of which it is presently aware based on PAN's present
 8 understanding of the asserted claims and/or Finjan's apparent construction of the claims, as set
 9 forth in Finjan's Infringement Contentions. PAN reserves all rights to advance claim
 10 construction positions different from Finjan's apparent constructions and to amend these
 11 contentions as it better understands Finjan's construction of the claims during the claim
 12 construction process.

13 **a. Unpatentable Subject Matter Under 35 U.S.C. § 101**

14 The '780 Patent claims are directed to a number of abstract ideas, such as, *e.g.*, of
 15 obtaining and hashing a Downloadable which includes multiple parts. The steps for completing
 16 the process described in the '780 Patent were conventional steps which do not contribute to patent
 17 eligible subject matter. The '780 Patent does not transform any patent ineligible abstract idea into
 18 a patent eligible application, and there is no inventive step present in the claims of the '780
 19 Patent. Additionally, claims 9, 10, 13, and 17 are directed to software per se. Accordingly, each
 20 of the asserted claims of the '780 Patent are invalid as directed to patent ineligible subject matter.

21 **b. Indefiniteness Under 35 U.S.C. § 112(2)**

22 "[A] patent is invalid for indefiniteness if its claims, read in light of the specification
 23 delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those
 24 skilled in the art about the scope of the invention." *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572
 25 U.S. 898, 901 (2014).

26 The following claim limitations of the Asserted Claims are invalid based on
 27 indefiniteness.

- 28 • "Downloadable"

- “means for obtaining a Downloadable that includes one or more references to software components required to be executed by the Downloadable”
- “means for fetching at least one software component identified by the one or more references”
- “means for performing a hashing function on the Downloadable and the fetched software components to generate a Downloadable ID”
- “ID generator”

c. Lack of Written Description Under 35 U.S.C. § 112(1)

To satisfy the written description requirement, the description must “clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.” *Ariad Pharm., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (internal citation omitted). The test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date. *Id.*

The test requires an objective inquiry into the four corners of the specification from the perspective of a POSITA. Based on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed. “Whether the written description requirement is satisfied is a fact-based inquiry that will depend on the nature of the claimed invention, and the knowledge of one skilled in the art at the time an invention is made and a patent application is filed.” *Carnegie Mellon Univ. v. Hoffmann La Roche Inc.*, 541 F.3d 1115, 1122 (Fed. Cir. 2008) (internal citation omitted). Actual “possession” or reduction to practice outside of the specification is not enough. Instead, the specification itself must demonstrate possession.

While the written description requirement does not demand any particular form of disclosure, a description that merely renders the invention obvious does not satisfy the requirement. *Lockwood v. Am. Airlines*, 107 F.3d 1565, 1571-72 (Fed. Cir. 1997).

The following claim limitations of the Asserted Claims are invalid for lack of written description:

- Finjan’s apparent interpretation of the asserted claims of the ’780 Patent is that they are broad enough to encompass any computing device that receives any file over a network and performs a hashing function on the received file. Accordingly, all asserted claims of the ’780 Patent lack written description support.

d. Lack of Enablement Under 35 U.S.C. § 112(1)

To satisfy the enablement requirement of 35 U.S.C § 112, the disclosure “must teach those skilled in the art how to make and use the full scope of the claimed invention without ‘undue experimentation.’” *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365 (Fed. Cir. 1997) (citations omitted). Moreover, “[i]t is the specification, not the knowledge of one skilled in the art, that must supply the novel aspects of [the] invention in order to constitute adequate enablement.” *Id.* at 1366. The Federal Circuit has enumerated several factors to consider in determining whether a disclosure would require “undue experimentation”: “(1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.” *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988).

The following claim limitations of the Asserted Claims are invalid for lack of enablement:

- Finjan’s apparent interpretation of the asserted claims of the ’780 Patent is that they are broad enough to encompass any computing device that receives any file over a network and performs a hashing function on the received file. Accordingly, all asserted claims of the ’780 Patent are invalid for lack of enablement.

B. Invalidity of the ’731 Patent

1. Priority Date

Finjan alleges that each of the Asserted Claims of the ’731 Patent are entitled to the priority date of November 8, 1996. Finjan’s Initial Disclosure of Asserted Claims and Infringement Contentions, at 20. Finjan apparently alleges that the Asserted Claims of the ’731 Patent are entitled to the benefit of the November 8, 1996 filing date of U.S. Provisional App. No. 60/030,639, which later matured into U.S. Patent No. 6,092,194. Neither the

'194 Patent, nor any of the other patents in the ancestry of the '731 Patent, however, discloses the subject matter claimed by the Asserted Claims of '731 Patent. Moreover, the '731 Patent does not properly claim priority to the U.S. Provisional App. No. 60/030,639. Thus, based on the information presently available to PAN, the earliest date to which the '731 Patent may claim priority is May 3, 2004, the date on which the application that issued as the '731 Patent was filed, or November 6, 1997, the date on which the application that later issued as the '194 Patent was filed.

2. Patent L.R. 3-3(a) Identification of Prior Art

Subject to the reservations of rights above, PAN identifies prior art that anticipates and/or renders obvious one or more of the Asserted Claims of the '731 Patent. The prior art references identified are also relevant to show the state of the art and reasons and motivations for making improvements, additions, modifications, and combinations.

In addition, PAN incorporates the prior art, claims charts, and invalidity theories disclosed, listed and/or asserted by any entity during the course of other litigation (past, present/ongoing, or future) or patent office challenges (either reexaminations or IPRs). Finjan has failed to timely update its production of these materials, which has prejudiced PAN in its preparation of these contentions. PAN reserves the right to rely on any prior art reference, prior art combination, motivation to combine, invalidity theory, and/or materials disclosed in these other proceedings. At least the following prior art references anticipate and/or render obvious the Asserted Claims of the '731 Patent, and/or illustrate the state of the art at the time of the alleged invention:

a. Patent Prior Art

Ref. No.	Publication No.	Short Name	Filing Date	Publication Date	Priority Date
1.	U.S. Patent No. 6,088,803	"Tso"	December 30, 1997	July 11, 2000	March 27, 1997
2.	U.S. Patent No. 5,623,600	"Ji '600"	September 26, 1995	April 22, 1997	September 26, 1995

Ref. No.	Publication No.	Short Name	Filing Date	Publication Date	Priority Date
3.	U.S. Patent No. 6,170,012	“Coss”	September 12, 1997	January 2, 2001	September 12, 1997
4.	U.S. Patent No. 5,983,348	“Ji ’348”	September 10, 1997	November 9, 1999	September 10, 1997
5.	U.S. Patent No. 6,275,938	“Bond”	August 28, 1997	August 14, 2001	August 28, 1997
6.	U.S. Patent No. 6,038,601	“Lambert”	July 21, 1997	March 14, 2000	July 21, 1997
7.	U.S. Pat. Pub. No. 2003/0167325	“Shah”	October 21, 2002	September 4, 2003	June 21, 1996

b. Non-Patent Publication Prior Art

Ref. No.	Publication	Short Name	Publication Date
1.	Proxy Servers and Databases for Managing Web-based Information	“Thomson”	May 1997
2.	Trust Management for the World Wide Web	“Chu”	June 13, 1997
3.	Computer Viruses and Artificial Intelligence	“Stang”	September 26, 1995
4.	A Hierarchical Internet Object Cache	“Chankhuthod”	January 1996

PAN additionally identifies and relies on each of the additional patent or publication references that describe or are otherwise related to the prior art systems identified below.

c. System or Product Prior Art

PAN sets forth numerous prior art products or systems in the table below. For such prior art products and systems, PAN has identified, based on its current knowledge, approximate dates on which such products were sold, on sale, made, known, and/or used in the U.S. PAN’s investigation of prior art products and systems is ongoing. Further information and/or documents regarding such products and their sale, offer for sale, and use dates will be produced or disclosed as it is (they are) obtained in discovery or otherwise becomes available to PAN. PAN reserves

the right to amend, modify, and/or supplement these Contentions based on further and subsequent investigation and discovery. Additionally, PAN reserves the right to rely on the documents identified below as standalone prior art references separate from the prior art system or product they describe.

PAN additionally identifies and relies on any system, product, or public knowledge or use that embodies or otherwise incorporates any of the prior art patents and publications listed above. PAN reserves the right to identify and rely on systems that represent different versions or are otherwise related variations of the identified products and systems.

Ref No.	System Name	Short Name	Date Made, Known, Used, Sold, or On Sale
1.	Squid System	Squid	July 1996
2.	VICEd System	VICEd	January 1997

(i) Squid System

Squid was sold, on sale, made, known, and/or used at least by July 1996. The features, operations, and functionality of Squid are described throughout the documentation produced in this case. These documents include:

- Beta version available at <http://squid.mirror.coloserv.net/archive/1.0.beta/1.0.beta1/ChangeLog>), initial release July 1996

(ii) VICEd System

VICEd was sold, on sale, made, known, and/or used at least by 1997. The features, operations, and functionality of VICEd are described throughout the documentation produced in this case. These documents include:

- J. S. Lee, J. Hsiang, and P. H. Tsang, “A Generic Virus Detection Agent on the Internet,” Proceedings of the Thirtieth Hawaii International Conference on System Science, Vol. 4, Jan. 1997, pp. 210-219.

d. 35 U.S.C. § 102(f)

PAN reserves the right to assert that the Asserted Claims are invalid under 35 U.S.C.

§ 102(f) in the event PAN obtains additional evidence that the inventors named in any of the Asserted Patents did not invent the subject matter claimed therein. Should PAN obtain such evidence, it will provide the name of the person(s) from whom and the circumstances under which the alleged invention or any part of it was derived.

e. 35 U.S.C. § 102(g)

PAN reserves the right to assert that the Asserted Claims are invalid under 35 U.S.C. § 102(g) in the event PAN obtains additional evidence that any of the inventions claimed in the Asserted Patents were made in the United States by another inventor who had not abandoned, suppressed or concealed it, prior to the alleged invention by the applicant of the Asserted Patents. Should PAN obtain such evidence, it will provide the identities of the persons or entities involved in and the circumstances surrounding the making the inventions before the patent applicants.

3. Patent L.R. 3-3(b) Anticipation and Obviousness

The references in Table 1, alone or in combination with the knowledge of one skilled in the art, anticipate or render obvious the Asserted Claims of the '731 Patent.

Table 1: Prior Art References: Anticipation and Primary/Secondary Obviousness

References

Short Name	Prior Art Under	Priority Date	Exemplary Claim Chart
Squid	102(a), (b), (g)	July 1996	Ex. G-1
Thomson	102(a), (b)	May 1997	Ex. G-2
Tso	102(e)	March 27, 1997	Ex. G-3
Chu	102(a), (b)	June 13, 1997	Ex. G-4
Ji '600	102(a), (b), (e)	September 26, 1995	Ex. G-5
Coss	102(e)	September 12, 1997	Ex. G-6
Ji '348	102(e)	September 10, 1997	Ex. G-7
Bond	102(e)	August 28, 1997	Ex. G-8
VICEd	102(a), (b), (g)	January 1997	Ex. G-9

In addition, each of the references in Table 1 above and Table 2 below, either alone, in

view of the knowledge of a POSITA, and/or in combination with one or more references in Table 1 or Table 2, renders obvious the Asserted Claims of the '731 Patent.

Table 2: Additional Prior Art References: Obviousness

Short Name	Prior Art Under	Priority Date
Shah	102(e)	June 21, 1996
Lambert	102(e)	July 21, 1997
Stang	102(a), (b)	September 26, 1995
Chankhunt-hod	102(a), (b)	January 1996

In addition, PAN incorporates by reference each and every prior art reference of record in the prosecution of the '731 Patent and any related patent or application, the statements made therein by the applicant, as well as the prior art discussed in the specification.

The cited portions of each prior art reference are exemplary and representative of the content of the reference, and should be understood in the context of the reference as a whole, as understood by one of ordinary skill in the art. To the extent a prior art reference is deemed not to anticipate or render obvious a claim as noted in the attached charts for failing to disclose, teach, or suggest one or more limitations of a claim, that claim would nonetheless have been obvious to one of ordinary skill in the art at the time of the alleged invention over the reference itself or by the combination of the reference with one or more other references disclosing the missing claim limitations or the knowledge of a person having ordinary skill in the art.

a. Prior Art Combinations

All of the Asserted Claims of the '731 Patent are obvious based on one or more combinations of the prior art references above. The sections below provide motivations to combine the prior art references above. These obviousness combinations are provided in the alternative to PAN's anticipation and single-reference obviousness contentions and are not to be construed to suggest that any reference included in the combination is not itself anticipatory or would not render the Asserted Claims obvious in light of the knowledge of a person having

1 ordinary skill in the art. PAN also hereby incorporates by reference the prior art, invalidity
 2 grounds, and expert testimony submitted in connection with any petitions for *inter partes* review
 3 of the '731 Patent.

4 **b. Motivation to Combine**

5 A POSITA would have been motivated to combine the preceding references for any
 6 number of reasons, such as the following exemplary reasons. Teachings, suggestions,
 7 motivations, and/or reasons to modify any of the references and/or to combine any two or more of
 8 the references can come from many sources, including the prior art, common knowledge,
 9 common sense, predictability, expectations, industry trends, design incentives or need, market
 10 demand or pressure, market forces, obviousness to try, the nature of the problem faced, and/or
 11 knowledge possessed by a POSITA.

12 Although a patent claim may be invalidated based on a teaching-suggestion-motivation
 13 (“TSM”) rationale—*i.e.*, that some teaching, suggestion, or motivation in the prior art that would
 14 have led one of ordinary skill to modify the prior-art reference or to combine prior-art reference
 15 teachings to arrive at the claimed invention—the Supreme Court identified additional rationales
 16 in *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007). The following of these rationales apply
 17 here:

18 (A) the Asserted Claims combine prior-art elements according to known methods
 19 to yield predictable results;

20 (B) the Asserted Claims involve the simple substitution of one known element for
 21 another to obtain predictable results;

22 (C) the Asserted Claims involve the use of a known technique to improve similar
 23 devices (methods, or products) in the same way;

24 (D) the Asserted Claims apply a known technique to a known device (method, or
 25 product) ready for improvement to yield predictable results;

26 (E) the Asserted Claims involve combinations of prior-art references that would
 27 have been “obvious to try”—a person of ordinary skill in the art could have
 28 reached the Asserted Claims by choosing from a finite number of identified,
 predictable solutions, with a reasonable expectation of success;

(F) the Asserted Claims are simply variations of work from one field of endeavor
 or a different one that would have been prompted based on design incentives or
 other market forces because the variations were predictable to one of ordinary skill
 in the art.

1 *See KSR*, 550 U.S. at 415-18 (rejecting the Federal Circuit’s “rigid” application of the teaching,
2 suggestion, or motivation to combine test, and instead espousing an “expansive and flexible”
3 approach). Indeed, the Supreme Court held that a person of ordinary skill in the art is “a person
4 of ordinary creativity, not an automaton” and “in many cases a person of ordinary skill in the art
5 will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *KSR*, 550
6 U.S. at 420-21.

7 Thus, even in the absence of a specific teaching, suggestion, or motivation to combine
8 references, the Asserted Claims here are obvious and therefore invalid. Each of the cited
9 references or devices is in the same field, making it obvious for someone of ordinary skill in the
10 art to identify and combine elements from these references. One of ordinary skill in the art would
11 have recognized that improvements could be achieved by combining or modifying prior-art
12 references that described such improvements. Each of the above prior-art references describes
13 devices or methods that were known to offer such improvements, and, accordingly, one of
14 ordinary skill in the art would have been motivated to combine or modify the references as
15 identified in each of the combinations above.

16 Indeed, given that the references are in the same field, one of ordinary skill would have
17 readily, with predictable results, taken teachings from one reference and applied them to other
18 references. As referenced above, multiple prior art references teach or suggest the concepts
19 claimed in the ’731 Patent. To the extent Finjan argues that any concepts claimed in the
20 ’731 Patent were not contained in any prior art reference, it would, at a minimum, have been
21 obvious to adapt each reference to include the concept or combine it with other references that
22 disclose the concept. In addition, each of the constituent techniques described here was well
23 known to those of ordinary skill in the art, and understood to be among a menu of available
24 design choices for improving network security. This is one of many motivations to combine the
25 above references.

26 Furthermore, because methods and systems related to a computer gateway for an intranet
27 of computers were well known and studied extensively prior to the ’731 Patent priority date,
28 common industry knowledge supplied a reason to combine the above references with each other.

1 Each combination would have produced no unexpected results and would simply represent a
2 known alternative to one of ordinary skill in the art. This is a further motivation to combine any
3 of the above references.

4 The below sections further address particular reasons to combine the above references.
5 The below should not be construed as an admission that there is any value to the alleged invention
6 of the '731 Patent. As discussed previously, these contentions are based largely on how Finjan is
7 apparently construing the Asserted Claims in its Initial Infringement Contentions, which is an
8 incorrect and overbroad interpretation of the alleged invention of the '731 Patent. Accordingly,
9 to the extent the below refers to benefits of certain elements or industry trends towards these
10 elements, this is not an admission that the alleged invention of the '731 Patent provides any
11 benefits—to the contrary, properly construed and compared to the prior art, the '731 Patent
12 provides no benefits. Likewise, to the extent the below refers to substituting elements, this is not
13 an admission that the elements subject to the substitution are in any way similar, *e.g.*, perform the
14 same function, in the same way, to reach the same result.

15 The various elements of the Asserted Claims were well-known in the prior art at the time
16 of the alleged invention, and the combination was obvious to one of ordinary skill in the art. The
17 combination simply (a) combines prior-art elements according to known methods to yield
18 predictable results; (b) involves the simple substitution of one known element for another to
19 obtain predictable results; (c) involves the use of a known technique to improve similar devices
20 (methods, or products) in the same way; (d) applies a known technique to a known device
21 (method, or product) ready for improvement to yield predictable results; (e) involves
22 combinations of prior-art references that would have been “obvious to try”—a person of ordinary
23 skill in the art could have reached the Asserted Claims by choosing from a finite number of
24 identified, predictable solutions, with a reasonable expectation of success; and/or (f) would have
25 been prompted by known work, based on design incentives or other market forces, because such
26 variations were predictable to one of ordinary skill in the art.

27 Moreover, the Supreme Court has stated that a motivation to combine may be simply
28 “common sense” and that “familiar items may have obvious uses beyond their primary purposes,

1 and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents
 2 together like pieces of a puzzle.” *KSR*, 550 U.S. at 420. Indeed, the Supreme Court held that it is
 3 sufficient that a combination of elements was “obvious to try,” holding that, “[w]hen there is a
 4 design need or market pressure to solve a problem and there are a finite number of identified,
 5 predictable solutions, a person of ordinary skill has good reason to pursue the known options
 6 within his or her technical grasp.” *Id.* at 421. Here, all the claim elements are common sense and
 7 are easily fit together by one of ordinary skill in the art.

8 While not necessary, a motivation to combine may also be found in the references
 9 themselves. One of ordinary skill in the art would have been motivated to combine a reference
 10 that refers to, or otherwise explicitly invites combination with, another reference. Where the
 11 references cited herein have such an explicit invitation to combine, that invitation would have
 12 motivated one of ordinary skill in the art to combine any such references.

13 c. Exemplary Obviousness Combinations

14 The accompanying claim charts explain how different portions of each prior art reference
 15 discloses each limitation of the Asserted Claims. If Finjan argues that any particular prior art
 16 reference lacks any feature, a POSITA as of the ’731 Patent’s priority date would at a minimum
 17 have been motivated to modify the reference to include the allegedly missing feature, or to
 18 combine it with other references that include that feature, as discussed in the previous section.

19 To the extent Finjan asserts that the prior art in Table 1 does not disclose these claim
 20 limitations, it would have been obvious to combine or modify each of the prior art references in
 21 Table 1 and Table 2 with one or more prior art references in Table 1 and/or Table 2 to create
 22 computer-based methods, systems and products for retrieving, scanning, and storing files as well
 23 as deriving and storing corresponding security profiles, as discussed in Thomson, Tso, Chu,
 24 Ji ’600, Coss, Ji ’348, Bond, Stang (*see, e.g.*, Stang at 237, 239, 240, 241, 242, 243, 246, 247,
 25 248), Chankhunthod (*see, e.g.*, Chankhunthod at 4.), Squid, and VICEd. Exemplary
 26 combinations are provided below but do not limit the potential invalidating combinations
 27 disclosed in these contentions or that PAN intends to rely on.

28 To the extent that Finjan argues that the prior art references are missing the scanning

1 related elements, it would have been obvious to modify those reference to derive and/or cache a
 2 security profile comprising a list of computer commands a corresponding file is programmed to
 3 perform, as described in Thomson, Tso, Chu, Ji '600, Coss, Ji '348, Bond, Stang (*see, e.g.*, Stang
 4 at 239, 240, 241, 242, 243, 246, 247, 248), and Chankhunthod (*see, e.g.*, Chankhunthod at 3, 6,
 5 11). One of ordinary skill in the art would have been motivated to combine Thomson, Tso, Chu,
 6 Ji '600, Coss, Ji '348, Bond, Stang and/or Chankhunthod with one or more other references
 7 identified in Table 1 and would have reasonably expected that the combination would achieve the
 8 intended purpose. Each reference relates to computer and network security. A person of ordinary
 9 skill in the art looking to create improved computer security methods and products would look to
 10 consider solutions implemented in other computer security methods and products such as those
 11 disclosed in at least Thomson, Tso, Chu, Ji '600, Coss, Ji '348, Bond, Stang and/or
 12 Chankhunthod, and other references as described in PAN's Invalidity Contentions and associated
 13 claim charts. A person of ordinary skill in the art looking to solve this problem would review
 14 patents, patent publications and prior art systems in the field of computer and network security
 15 such as Thomson, Tso, Chu, Ji '600, Coss, Ji '348, Bond, Stang and/or Chankhunthod and other
 16 references as described in PAN's Invalidity Contentions and associated claim charts.

17 One of ordinary skill in the art also would have reasonably expected that such
 18 combination of Thomson, Tso, Chu, Ji '600, Coss, Ji '348, Bond, Stang and/or Chankhunthod
 19 and other references as described in Table 1 and associated claim charts would achieve the
 20 desired structure and functionality of scanning a file, for such structures and mechanisms were
 21 well known in the art and would have been obvious to one of ordinary skill in the art.

22 To the extent that Finjan argues that the prior art references are missing the security
 23 profile related elements, it would have been obvious to modify those reference to derive and/or
 24 cache a security profile comprising a list of computer commands a corresponding file is
 25 programmed to perform, as described in Thomson, Tso, Chu, Ji '600, Coss, Ji '348, Bond, and
 26 Stang (*see e.g.*, Stang at 239, 240, 241, 242, 243, 246, 247, 248.) One of ordinary skill in the art
 27 would have been motivated to combine Thomson, Tso, Chu, Ji '600, Coss, Ji '348, Bond, and/or
 28 Stang with one or more other references identified in Table 1 and would have reasonably

1 expected that the combination would achieve the intended purpose. Each reference relates to
2 computer and network security. A person of ordinary skill in the art looking to create improved
3 computer security methods and products would look to consider solutions implemented in other
4 computer security methods and products such as those disclosed in at least Thomson, Tso, Chu,
5 Ji '600, Coss, Ji '348, Bond, and/or Stang and other references as described in PAN's Invalidity
6 Contentions and associated claim charts. A person of ordinary skill in the art looking to solve this
7 problem would review patents, patent publications and prior art systems in the field of computer
8 and network security such as Thomson, Tso, Chu, Ji '600, Coss, Ji '348, Bond, and/or Stang and
9 other references as described in PAN's Invalidity Contentions and associated claim charts.

10 One of ordinary skill in the art also would have reasonably expected that such
11 combination of Thomson, Tso, Chu, Ji '600, Coss, Ji '348, Bond, and/or Stang and other
12 references as described in Table 1 and associated claim charts would achieve the desired structure
13 and functionality of a security profile comprising a list of computer commands that a
14 corresponding file is programmed to perform, deriving a security profile, and storing a security
15 profile within a security profile cache, for such structures and mechanisms were well known in
16 the art and would have been obvious to one of ordinary skill in the art.

17 To the extent that Finjan argues that the prior art references are missing the file cache
18 related elements, it would have been obvious to modify those reference to include a file cache for
19 storing files that have been scanned by the scanner for future access, wherein each of the stored
20 files is indexed by an identifier, as described in Thomson, Tso, Chu, Ji '600, and Chankhunthod
21 (*see, e.g.*, Chankhunthod at 3, 6, and 11). One of ordinary skill in the art would have been
22 motivated to combine Thomson, Tso, Chu, Ji '600 and/or Chankhunthod with one or more other
23 references identified in Table 1 or Table 2 and would have reasonably expected that the
24 combination would achieve the intended purpose. Each reference relates to computer and network
25 security. A person of ordinary skill in the art looking to create improved computer security
26 methods and products would look to consider solutions implemented in other computer security
27 methods and products such as those disclosed in at least Thomson, Tso, Chu, Ji '600, and/or
28 Chankhunthod and other references as described in PAN's Invalidity Contentions and associated

1 claim charts. A person of ordinary skill in the art looking to solve this problem would review
2 patents, patent publications and prior art systems in the field of computer and network security
3 such as Thomson, Tso, Chu, Ji '600, and/or Chankhunthod and other references as described in
4 PAN's Invalidity Contentions and associated claim charts.

5 One of ordinary skill in the art also would have reasonably expected that such
6 combination of Thomson, Tso, Chu, Ji '600, and/or Chankhunthod and other references as
7 described in Table 1 and associated claim charts would achieve the desired structure and
8 functionality of a file cache for storing files for future access, wherein each of the security
9 profiles is indexed by a file identifier associated with a corresponding file, for such structures and
10 mechanisms were well known in the art and would have been obvious to one of ordinary skill in
11 the art.

12 To the extent that Finjan argues that the prior art references are missing the security policy
13 cache for storing security policies, it would have been obvious to modify those references to
14 include a security policy cache for storing security policies, where the security policies include a
15 list of restrictions for files, as described in Thomson, Tso, Chu, Ji '600, Coss, Ji '348, Bond,
16 Stang (*see e.g.*, Stang at 237, 239, 240, 241), and Chankhunthod (*see, e.g.*, Chankhunthod at 3, 6,
17 and 11). One of ordinary skill in the art would have been motivated to combine Thomson, Tso,
18 Chu, Ji '600, Coss, Bond, Stang, and/or Chankhunthod with one or more other references
19 identified in Table 1 and would have reasonably expected that the combination would achieve the
20 intended purpose. Each reference relates to computer and network security. A person of ordinary
21 skill in the art looking to create improved computer security methods and products would look to
22 consider solutions implemented in other computer security methods and products such as those
23 disclosed in at least Thomson, Tso, Chu, Ji '600, Coss, Ji '348, Bond, Stang, and/or
24 Chankhunthod and other references as described in PAN's Invalidity Contentions and associated
25 claim charts. A person of ordinary skill in the art looking to solve this problem would review
26 patents, patent publications and prior art systems in the field of computer and network security
27 such as Thomson, Tso, Chu, Ji '600, Coss, Bond, Stang and/or Chankhunthod and other
28 references as described in PAN's Invalidity Contentions and associated claim charts.

One of ordinary skill in the art also would have reasonably expected that such combination of Thomson, Tso, Chu, Ji '600, Coss, Ji '348, Bond, Stang and/or Chankhunthod and other references as described in Table 1 and associated claim charts would achieve the desired structure and functionality of a security policy cache for storing security policies, for such structures and mechanisms were well known in the art and would have been obvious to one of ordinary skill in the art.

To the extent that Finjan argues that any of the prior art references are missing the hash value related elements, it would have been obvious to modify those references to have a file identifier include a hash value derived from a corresponding file, as described in Coss and Chankhunthod (*see e.g.*, Chankhunthod at 4). One of ordinary skill in the art would have been motivated to combine Coss and/or Chankhunthod with one or more other references identified in Table 1 and would have reasonably expected that the combination would achieve the intended purpose. Each reference relates to computer and network security. A person of ordinary skill in the art looking to create improved computer security methods and products would look to consider solutions implemented in other computer security methods and products such as those disclosed in at least Coss and/or Chankhunthod and other references as described in PAN's Invalidity Contentions and associated claim charts. A person of ordinary skill in the art looking to solve this problem would review patents, patent publications and prior art systems in the field of computer and network security such as Coss and/or Chankhunthod and other references as described in PAN's Invalidity Contentions and associated claim charts.

One of ordinary skill in the art also would have reasonably expected that such combination of Coss and/or Chankhunthod and other references as described in Table 1 and associated claim charts would achieve the desired structure and functionality of using a hash value as a file identifier to index the files, for such structures and mechanisms were well known in the art and would have been obvious to one of ordinary skill in the art.

4. Patent L.R. 3-3(c) Invalidity Contentions Charts

Pursuant to Patent Local Rule 3-3(c), charts identifying specifically where and how in each alleged item of prior art each limitation of each asserted claim is found are attached as

1 Exhibits G-1 to G-8. Where elements are disclosed at multiple locations within a single item of
 2 prior art, PAN has not necessarily identified every iteration of every disclosure.

3 **5. Patent L.R. 3-3(d) Invalidity Based on 35 U.S.C. § 101, Indefiniteness**
 4 **Under 35 U.S.C. § 112(2), or Enablement or Written Description**
 5 **Under 35 U.S.C. § 112(1)**

6 Based on PAN's present understanding of the Asserted Claims and/or PAN's apparent
 7 construction of the claims, as set forth in Finjan's Infringement Contentions, and subject to the
 8 reservation of rights above, PAN lists below the grounds upon which the Asserted Claims of the
 9 '731 Patent are invalid based on 35 U.S.C. § 101, indefiniteness, lack of written description,
 10 and/or lack of enablement under 35 U.S.C. § 112. To the extent PAN's identified grounds for
 11 invalidity are based on Finjan's apparent constructions, PAN is not adopting Finjan's apparent
 12 constructions, nor is PAN agreeing that any of Finjan's apparent constructions are correct.
 13 Moreover, Finjan's deficient Infringement Contentions fail to provide PAN with adequate notice
 14 as to Finjan's infringement theories. PAN reserves all rights to advance claim construction
 15 positions different from Finjan's apparent constructions.

16 PAN's contentions that the following claims are invalid under 35 U.S.C. § 112 are made
 17 in the alternative, and do not constitute, and should not be interpreted as, admissions regarding
 18 the construction or scope of the Asserted Claims, or that any of the Asserted Claims are not
 19 anticipated or rendered obvious by any prior art. Where PAN identifies a claim term in an
 20 independent claim as being invalid, PAN further contends any asserted dependent claim is invalid
 21 based on the presence of the same term.

22 In light of the deficiencies in Finjan's Infringement Contentions, PAN reserves the right to
 23 amend, modify, and/or supplement these Contentions to further identify bases for invalidity under
 24 35 U.S.C. § 112. PAN's Contentions shall not be construed as an admission that any claim
 25 construction advanced by PAN in this case is in any way inconsistent, flawed or erroneous. Nor
 26 should these Contentions prevent PAN from advancing claim construction and/or non-
 27 infringement positions in lieu of, or in addition to, invalidity positions. Further, PAN's
 28 Contentions shall not be construed as an admission of or acquiescence to Finjan's purported
 construction of the claim language or of other positions advanced by Finjan during the course of

1 this litigation. PAN's Contentions under 35 U.S.C. § 112 may depend, in part, on the Court's
 2 claim construction, as well as Finjan's asserted claim scope. Consequently, PAN only identifies
 3 herein the issues under 35 U.S.C. § 112 of which it is presently aware based on PAN's present
 4 understanding of the asserted claims and/or Finjan's apparent construction of the claims, as set
 5 forth in Finjan's Infringement Contentions. PAN reserves all rights to advance claim
 6 construction positions different from Finjan's apparent constructions and to amend these
 7 contentions as it better understands Finjan's construction of the claims during the claim
 8 construction process.

9 **a. Unpatentable Subject Matter Under 35 U.S.C. § 101**

10 The Asserted Claims of the '731 Patent are directed to non-statutory subject matter, under
 11 35 U.S.C. § 101, because the claims are directed to merely scanning a file, deriving a security
 12 profile, storing the file, and storing the security profile, which is an abstract concept. The
 13 recitation of generic computer components does not amount to significantly more than the
 14 abstract idea itself. *See CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed.
 15 Cir. 2011) (reasoning that the use of the Internet to verify a credit card transaction does not
 16 meaningfully add to the abstract idea of verifying the transaction). Additionally, claims 1-3 are
 17 directed to software per se. Therefore, the Asserted Claims of the '731 Patent are not directed to
 18 patent-eligible subject matter under 35 U.S.C. §101, and are invalid.

19 **b. Indefiniteness Under 35 U.S.C. § 112(2)**

20 “[A] patent is invalid for indefiniteness if its claims, read in light of the specification
 21 delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those
 22 skilled in the art about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572
 23 U.S. 898, 901 (2014).

24 The following claim limitations of the Asserted Claims are invalid based on
 25 indefiniteness.

- 26 • “a file identifier”
- 27 • “the file identifiers”
- 28 • “scanning the retrieved file to determine computer commands that the file is

1 programmed to perform”

- 2 • “its security profile”
- 3 • “without the need to perform said scanning”
- 4 • “scanner”

5 **c. Lack of Written Description Under 35 U.S.C. § 112(1)**

6 To satisfy the written description requirement, the description must “clearly allow persons
7 of ordinary skill in the art to recognize that [the inventor] invented what is claimed.” *Ariad*
8 *Pharm., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (internal citation omitted).
9 The test for sufficiency is whether the disclosure of the application relied upon reasonably
10 conveys to those skilled in the art that the inventor had possession of the claimed subject matter
11 as of the filing date. *Id.*

12 The test requires an objective inquiry into the four corners of the specification from the
13 perspective of a POSITA. Based on that inquiry, the specification must describe an invention
14 understandable to that skilled artisan and show that the inventor actually invented the invention
15 claimed. “Whether the written description requirement is satisfied is a fact-based inquiry that will
16 depend on the nature of the claimed invention, and the knowledge of one skilled in the art at the
17 time an invention is made and a patent application is filed.” *Carnegie Mellon Univ. v. Hoffmann*
18 *La Roche Inc.*, 541 F.3d 1115, 1122 (Fed. Cir. 2008) (internal citation omitted). Actual
19 “possession” or reduction to practice outside of the specification is not enough. Instead, the
20 specification itself must demonstrate possession.

21 While the written description requirement does not demand any particular form of
22 disclosure, a description that merely renders the invention obvious does not satisfy the
23 requirement. *Lockwood v. Am. Airlines*, 107 F.3d 1565, 1571-72 (Fed. Cir. 1997). Finjan’s
24 apparent construction of “to ensure that duplicate files are not scanned” is not adequately
25 described in the ’731 patent, and therefore these claims are invalid for lack of written description
26 support. The same goes for related claims reciting “without the need to perform said scanning”.

27 **d. Lack of Enablement Under 35 U.S.C. § 112(1)**

28 To satisfy the enablement requirement of 35 U.S.C § 112, the disclosure “must teach those

1 skilled in the art how to make and use the full scope of the claimed invention without ‘undue
 2 experimentation.’” *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365 (Fed. Cir. 1997)
 3 (citations omitted). Moreover, “[i]t is the specification, not the knowledge of one skilled in the
 4 art, that must supply the novel aspects of [the] invention in order to constitute adequate
 5 enablement.” *Id.* at 1366. The Federal Circuit has enumerated several factors to consider in
 6 determining whether a disclosure would require “undue experimentation”: “(1) the quantity of
 7 experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or
 8 absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the
 9 relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the
 10 breadth of the claims.” *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). Finjan’s apparent
 11 construction of “to ensure that duplicate files are not scanned” is not adequately described in the
 12 ’731 patent, and therefore these claims are invalid for lack of enablement. The same goes for
 13 related claims reciting “without the need to perform said scanning”.

14 C. Invalidity of the ’926 Patent

15 1. Priority Date

16 Finjan alleged that each of the Asserted Claims of the ’926 Patent is entitled to a priority
 17 date of November 8, 1996. Finjan’s Initial Disclosure of Asserted Claims and Infringement
 18 Contentions, at 20. Finjan seems to allege based on this that the Asserted Claims of the ’926
 19 Patent are entitled to the benefit of a provisional application which was filed well before the ’926
 20 Patent was filed on March 7, 2006. The ’926 Patent on its face claims priority to November 6,
 21 1997—the filing date of U.S. Patent No. 6,092,194—at the earliest. The ’926 Patent issued from
 22 a series of continuation applications which began with the parent application to the ’926, which
 23 was filed on May 17, 2001, and which ultimately matured into U.S. Patent No. 7,058,822 (“the
 24 ’822 Patent”). The un-asserted ’822 Patent claims priority to a provisional application filed on
 25 May 17, 2000. Simultaneously, the ’822 Patent appears to claim priority through two separate
 26 continuation in part applications, which ultimately issued as the un-asserted U.S. Patent No.
 27 6,480,962, and asserted ’780 Patent. The subject matter claimed in the ’822 Patent, and by
 28 extension the ’926 Patent, is not disclosed in the ’780 Patent, nor in the ’962 Patent. Therefore,

the chain of priority for the '926 Patent cannot go beyond its parent '822 Patent. Thus, based on the information presently available to PAN, the earliest date to which the '926 Patent may claim priority is May 17, 2000, the date in which the provisional application which led to the '822 Patent was filed, or alternatively the '822 Patent's filing date of May 17, 2001, or the '926 Patent's filing date of March 7, 2006. However, as described below, the Asserted Claims are invalid even under Finjan's alleged priority date.

2. Patent L.R. 3-3(a) Identification of Prior Art

Subject to the reservations of rights above, PAN identifies prior art that anticipates and/or renders obvious one or more of the Asserted Claims of the '926 Patent. The prior art references identified are also relevant to show the state of the art and reasons and motivations for making improvements, additions, modifications, and combinations.

In addition, PAN incorporates the prior art, claims charts, and invalidity theories disclosed, listed and/or asserted by any entity during the course of other litigation (past, present/ongoing, or future) or patent office challenges (either reexaminations or IPRs). Finjan has failed to timely update its production of these materials, which has prejudiced PAN in its preparation of these contentions. PAN reserves the right to rely on any prior art reference, prior art combination, motivation to combine, invalidity theory, and/or materials disclosed in these other proceedings. At least the following prior art references anticipate and/or render obvious the Asserted Claims of the '926 Patent, and/or illustrate the state of the art at the time of the alleged invention:

a. Patent Prior Art

Ref. No.	Publication No.	Short Name	Filing Date	Publication Date	Priority Date
1.	U.S. 5,757,915	Aucsmith	August 25, 1995	May 26, 1998	August 25, 1995
2.	U.S. 5,983,348	Ji '348	September 10, 1997	November 9, 1999	September 10, 1997
3.	W.O. 98/21683	Touboul '683	November 6, 1997	May 22, 1998	May 22, 1998

Ref. No.	Publication No.	Short Name	Filing Date	Publication Date	Priority Date
4.	W.O. 99/35583	Touboul '583	December 16, 1998	July 15, 1999	July 15, 1999
5.	U.S. 6,367,012	Atkinson	December 6, 1996	April 2, 2002	December 6, 1996
6.	U.S. 6,067,575	McManis	December 8, 1995	May 23, 2000	December 8, 1995
7.	U.S. 6,128,774	Necula	October 28, 1997	October 3, 2000	October 28, 1997
8.	U.S. 6,092,147	Levy '147	April 15, 1997	July 18, 2000	April 15, 1997
9.	U.S. 6,622,247	Issak '247	December 19, 1997	September 16, 2003	December 19, 1997
10.	U.S. 6,253,370	Abadi '370	December 1, 1997	January 26, 2001	December 1, 1997
11.	U.S. 5,283,830	Hinsley '830	September 30, 1992	February 1, 1994	September 30, 1992
12.	U.S. 6,357,008	Nachenberg '008	September 23, 1997	March 12, 2002	September 23, 1997

b. Non-Patent Publication Prior Art

Ref. No.	Publication	Short Name	Publication Date
1.	MiSFIT: A Freely Available Tool for Building Safe Extensible Systems	MiSFIT	1996
2.	Trust Management for the World Wide Web	Chu	June 13, 1997
3.	Encapsulating Mobile Objects	Härtig	1997
4.	A Flexible Security Model for Using Internet Content	Islam	October 1997
5.	An Immune System for Cyberspace	Kephart	1997
6.	MIME Encapsulation	Bahreman	June 13, 1996

Ref. No.	Publication	Short Name	Publication Date
7.	Blocking Applets at the Firewall	Martin	February 10, 1997
8.	Dynamic Detection and Classification of Computer Viruses Using General Behavior Patterns	Swimmer	September 1995
9.	Poison Java	Chen	August 1999

PAN additionally identifies and relies on each of the additional patent or publication references that describe or are otherwise related to the prior art systems identified below.

c. System or Product Prior Art

PAN sets forth numerous prior art products or systems in the table below. For such prior art products and systems, PAN has identified, based on its current knowledge, approximate dates on which such products were sold, on sale, made, known, and/or used in the U.S. PAN's investigation of prior art products and systems is ongoing. Further information and/or documents regarding such products and their sale, offer for sale, and use dates will be produced or disclosed as it is (they are) obtained in discovery or otherwise becomes available to PAN. PAN reserves the right to amend, modify, and/or supplement these Contentions based on further and subsequent investigation and discovery. Additionally, PAN reserves the right to rely on the documents identified below as standalone prior art references separate from the prior art system or product they describe.

PAN additionally identifies and relies on any system, product, or public knowledge or use that embodies or otherwise incorporates any of the prior art patents and publications listed above. PAN reserves the right to identify and rely on systems that represent different versions or are otherwise related variations of the identified products and systems.

Ref No.	System Name	Short Name	Date Made, Known, Used, Sold, or On Sale
1.	InterScan AppletTrap	AppletTrap	March 23, 1999

(i) InterScan AppletTrap (“AppletTrap”)

AppletTrap was sold, on sale, made, known, and/or used at least by March 23, 1999. The features, operations, and functionality of AppletTrap are described throughout the Trend Micro, Inc. documentation produced in this case. These documents include:

- TFS00000001 – TFS00005934
- TM-FIN000001 – TM-FIN000563

d. 35 U.S.C. § 102(f)

PAN reserves the right to assert that the Asserted Claims are invalid under 35 U.S.C. § 102(f) in the event PAN obtains additional evidence that the inventors named in any of the Asserted Patents did not invent the subject matter claimed therein. Should PAN obtain such evidence, it will provide the name of the person(s) from whom and the circumstances under which the alleged invention or any part of it was derived.

e. 35 U.S.C. § 102(g)

PAN reserves the right to assert that the Asserted Claims are invalid under 35 U.S.C. § 102(g) in the event PAN obtains additional evidence that any of the inventions claimed in the Asserted Patents were made in the United States by another inventor who had not abandoned, suppressed or concealed it, prior to the alleged invention by the applicant of the Asserted Patents. Should PAN obtain such evidence, it will provide the identities of the persons or entities involved in and the circumstances surrounding the making the inventions before the patent applicants.

3. Patent L.R. 3-3(b) Anticipation and Obviousness

The references in Table 1, alone or in combination with the knowledge of one skilled in the art, anticipate or render obvious the Asserted Claims of the ’926 Patent.

Table 1: Prior Art References: Anticipation and Primary/Secondary Obviousness

References

Short Name	Prior Art Under	Priority Date	Exemplary Claim Chart
AppletTrap	102(a)	March 23, 1999	B-1
Aucsmith	102(e)	August 25, 1995	B-2

Short Name	Prior Art Under	Priority Date	Exemplary Claim Chart
Ji '348	102(e)	September 10, 1997	B-3
Touboul '583	102(a)	July 15, 1999	B-4
MiSFIT	102(a)	1996	B-5
Touboul '683	102(a)	May 22, 1998	B-6
Atkinson	102(e)	December 6, 1996	B-7
McManis	102(e)	December 8, 1995	B-8
Chu	102(a)	June 13, 1997	B-9
Härtig	102(a)	1997	B-10
Islam	102(a)	October 1997	B-11
Kephart	102(a)	1997	B-12
Necula	102(e)	October 28, 1997	B-13
Chen	102(a)	August 1999	B-14

In addition, each of the references in Table 1 above and Table 2 below, either alone, in view of the knowledge of a POSITA, and/or in combination with one or more references in Table 1 or Table 2, renders obvious the Asserted Claims of the '926 Patent.

Table 2: Additional Prior Art References: Obviousness

Short Name	Prior Art Under	Priority Date
Levy '147	102(e)	April 15, 1997
Isaak '247	102(e)	December 19, 1997
Abadi '370	102(e)	December 1, 1997
Hinsley '830	102(e)	September 30, 1992
Nachenberg '008	102(e)	September 23, 1997
Bahreman	102(a)	June 13, 1996
Martin	102(a)	February 10, 1997

Short Name	Prior Art Under	Priority Date
Swimmer	102(a)	September 1995

In addition, PAN incorporates by reference each and every prior art reference of record in the prosecution of the '926 Patent and any related patent or application, the statements made therein by the applicant, as well as the prior art discussed in the specification.

The cited portions of each prior art reference are exemplary and representative of the content of the reference, and should be understood in the context of the reference as a whole, as understood by one of ordinary skill in the art. To the extent a prior art reference is deemed not to anticipate or render obvious a claim as noted in the attached charts for failing to disclose, teach, or suggest one or more limitations of a claim, that claim would nonetheless have been obvious to one of ordinary skill in the art at the time of the alleged invention over the reference itself or by the combination of the reference with one or more other references disclosing the missing claim limitations or the knowledge of a person having ordinary skill in the art.

a. Prior Art Combinations

All of the Asserted Claims of the '926 Patent are obvious based on one or more combinations of the prior art references above. The sections below provide motivations to combine the prior art references above. These obviousness combinations are provided in the alternative to PAN's anticipation and single-reference obviousness contentions and are not to be construed to suggest that any reference included in the combination is not itself anticipatory or would not render the Asserted Claims obvious in light of the knowledge of a person having ordinary skill in the art. PAN also hereby incorporates by reference the prior art, invalidity grounds, and expert testimony submitted in connection with any petitions for *inter partes* review of the '926 Patent.

b. Motivation to Combine

A POSITA would have been motivated to combine the preceding references for any number of reasons, such as the following exemplary reasons. Teachings, suggestions,

1 motivations, and/or reasons to modify any of the references and/or to combine any two or more of
 2 the references can come from many sources, including the prior art, common knowledge,
 3 common sense, predictability, expectations, industry trends, design incentives or need, market
 4 demand or pressure, market forces, obviousness to try, the nature of the problem faced, and/or
 5 knowledge possessed by a POSITA.

6 Although a patent claim may be invalidated based on a teaching-suggestion-motivation
 7 (“TSM”) rationale—*i.e.*, that some teaching, suggestion, or motivation in the prior art that would
 8 have led one of ordinary skill to modify the prior-art reference or to combine prior-art reference
 9 teachings to arrive at the claimed invention—the Supreme Court identified additional rationales
 10 in *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007). The following of these rationales apply
 11 here:

12 (A) the Asserted Claims combine prior-art elements according to known methods
 to yield predictable results;

13 (B) the Asserted Claims involve the simple substitution of one known element for
 14 another to obtain predictable results;

15 (C) the Asserted Claims involve the use of a known technique to improve similar
 devices (methods, or products) in the same way;

16 (D) the Asserted Claims apply a known technique to a known device (method, or
 17 product) ready for improvement to yield predictable results;

18 (E) the Asserted Claims involve combinations of prior-art references that would
 19 have been “obvious to try”—a person of ordinary skill in the art could have
 reached the Asserted Claims by choosing from a finite number of identified,
 predictable solutions, with a reasonable expectation of success;

20 (F) the Asserted Claims are simply variations of work from one field of endeavor
 21 or a different one that would have been prompted based on design incentives or
 other market forces because the variations were predictable to one of ordinary skill
 22 in the art.

23 *See KSR*, 550 U.S. at 415-18 (rejecting the Federal Circuit’s “rigid” application of the teaching,
 24 suggestion, or motivation to combine test, and instead espousing an “expansive and flexible”
 25 approach). Indeed, the Supreme Court held that a person of ordinary skill in the art is “a person
 26 of ordinary creativity, not an automaton” and “in many cases a person of ordinary skill in the art
 27 will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *KSR*, 550
 28 U.S. at 420-21.

1 Thus, even in the absence of a specific teaching, suggestion, or motivation to combine
2 references, the Asserted Claims here are obvious and therefore invalid. Each of the cited
3 references or devices is in the same field, making it obvious for someone of ordinary skill in the
4 art to identify and combine elements from these references. One of ordinary skill in the art would
5 have recognized that improvements could be achieved by combining or modifying prior-art
6 references that described such improvements. Each of the above prior-art references describes
7 devices or methods that were known to offer such improvements, and, accordingly, one of
8 ordinary skill in the art would have been motivated to combine or modify the references as
9 identified in each of the combinations above.

10 Indeed, given that the references are in the same field, one of ordinary skill would have
11 readily, with predictable results, taken teachings from one reference and applied them to other
12 references. As referenced above, multiple prior art references teach or suggest the concepts
13 claimed in the '926 Patent. To the extent Finjan argues that any concepts claimed in the
14 '926 Patent were not contained in any prior art reference, it would, at a minimum, have been
15 obvious to adapt each reference to include the concept or combine it with other references that
16 disclose the concept. In addition, each of the constituent techniques described here was well
17 known to those of ordinary skill in the art, and understood to be among a menu of available
18 design choices for developing methods of computer security via obtaining and hashing a
19 Downloadable, creating a security profile for the Downloadable, and creating and transmitting an
20 appended Downloadable or a security profile with a representation of the Downloadable,
21 including through a variety of Downloadable types and with various features common to the
22 security profile. This is one of many motivations to combine the above references.

23 Furthermore, because computer security techniques using features such as firewalls,
24 security profiles, and the obtaining and transfer of Downloadables and security profiles were well
25 known and studied extensively prior to the 926 Patent priority date, common industry knowledge
26 supplied a reason to combine the above references with each other. Each combination would
27 have produced no unexpected results and would simply represent a known alternative to one of
28 ordinary skill in the art. This is a further motivation to combine any of the above references.

1 The below sections further address particular reasons to combine the above references.
2 The below should not be construed as an admission that there is any value to the alleged invention
3 of the '926 Patent. As discussed previously, these contentions are based largely on how Finjan is
4 apparently construing the Asserted Claims in its Initial Infringement Contentions, which is an
5 incorrect and overbroad interpretation of the alleged invention of the '926 Patent. Accordingly,
6 to the extent the below refers to benefits of certain elements or industry trends towards these
7 elements, this is not an admission that the alleged invention of the '926 Patent provides any
8 benefits—to the contrary, properly construed and compared to the prior art, the '926 Patent
9 provides no benefits. Likewise, to the extent the below refers to substituting elements, this is not
10 an admission that the elements subject to the substitution are in any way similar, *e.g.*, perform the
11 same function, in the same way, to reach the same result.

12 The various elements of the Asserted Claims were well-known in the prior art at the time
13 of the alleged invention, and the combination was obvious to one of ordinary skill in the art. The
14 combination simply (a) combines prior-art elements according to known methods to yield
15 predictable results; (b) involves the simple substitution of one known element for another to
16 obtain predictable results; (c) involves the use of a known technique to improve similar devices
17 (methods, or products) in the same way; (d) applies a known technique to a known device
18 (method, or product) ready for improvement to yield predictable results; (e) involves
19 combinations of prior-art references that would have been “obvious to try”—a person of ordinary
20 skill in the art could have reached the Asserted Claims by choosing from a finite number of
21 identified, predictable solutions, with a reasonable expectation of success; and/or (f) would have
22 been prompted by known work, based on design incentives or other market forces, because such
23 variations were predictable to one of ordinary skill in the art.

24 Moreover, the Supreme Court has stated that a motivation to combine may be simply
25 “common sense” and that “familiar items may have obvious uses beyond their primary purposes,
26 and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents
27 together like pieces of a puzzle.” *KSR*, 550 U.S. at 420. Indeed, the Supreme Court held that it is
28 sufficient that a combination of elements was “obvious to try,” holding that, “[w]hen there is a

1 design need or market pressure to solve a problem and there are a finite number of identified,
 2 predictable solutions, a person of ordinary skill has good reason to pursue the known options
 3 within his or her technical grasp.” *Id.* at 421. Here, all the claim elements are common sense and
 4 are easily fit together by one of ordinary skill in the art.

5 While not necessary, a motivation to combine may also be found in the references
 6 themselves. One of ordinary skill in the art would have been motivated to combine a reference
 7 that refers to, or otherwise explicitly invites combination with, another reference. Where the
 8 references cited herein have such an explicit invitation to combine, that invitation would have
 9 motivated one of ordinary skill in the art to combine any such references.

10 **a. Exemplary Obviousness Combinations**

11 The accompanying claim charts explain how different portions of each prior art reference
 12 discloses each limitation of the Asserted Claims. If Finjan argues that any particular prior art
 13 reference lacks any feature, a POSITA as of the ’926 Patent’s priority date would at a minimum
 14 have been motivated to modify the reference to include the allegedly missing feature, or to
 15 combine it with other references that include that feature, as discussed in the previous section.

16 To the extent Finjan asserts that the prior art in Table 1 does not disclose these claim
 17 limitations, it would have been obvious to combine or modify each of the prior art references in
 18 Table 1 and Table 2 with one or more prior art references in Table 1 and/or Table 2 to create
 19 computer-based methods, systems and products for identifying, categorizing, and transmitting
 20 Downloadables along with their security profiles in and appended fashion, as discussed in
 21 AppletTrap, Aucsmith, Ji ’348, Touboul ’583, MiSFIT, Touboul ’683, Atkinson, McManis, Chu,
 22 Härtig, Islam, Kephart, Necula, and Chen. Exemplary combinations are provided below but do
 23 not limit the potential invalidating combinations disclosed in these contentions or that PAN
 24 intends to rely on.

25 To the extent that Finjan argues that any of these references do not satisfy the “receiving
 26 an incoming Downloadable” limitations, it would have been obvious to modify those references
 27 to allow for the receiving of a Downloadable in some form, as described in AppletTrap,
 28 Aucsmith, Ji ’348, Touboul ’583, MiSFIT, Touboul ’683, Atkinson, McManis, Chu, Härtig,

1 Islam, Kephart, Necula, and Chen. One of ordinary skill in the art would have been motivated to
 2 combine AppletTrap, Aucsmith, Ji '348, Touboul '583, MiSFIT, Touboul '683, Atkinson,
 3 McManis, Chu, Härtig, Islam, Kephart, Necula, and Chen with one or more other references
 4 identified in Table 1 and/or Table 2 and would have reasonably expected that the combination
 5 would achieve the intended purpose. Each reference relates to computer and network security. A
 6 person of ordinary skill in the art looking to create improved computer security methods and
 7 products would look to consider solutions implemented in other computer security methods and
 8 products such as those disclosed in AppletTrap, Aucsmith, Ji '348, Touboul '583, MiSFIT,
 9 Touboul '683, Atkinson, McManis, Chu, Härtig, Islam, Kephart, Necula, Chen and other
 10 references as described in PAN's Invalidity Contentions and associated claim charts. A person of
 11 ordinary skill in the art looking to solve this problem would review patents, patent publications
 12 and prior art systems in the field of computer and network security such as AppletTrap,
 13 Aucsmith, Ji '348, Touboul '583, MiSFIT, Touboul '683, Atkinson, McManis, Chu, Härtig,
 14 Islam, Kephart, Necula, Chen and other references as described in PAN's Invalidity Contentions
 15 and associated claim charts. One of ordinary skill in the art also would have reasonably expected
 16 that such combination of AppletTrap, Aucsmith, Ji '348, Touboul '583, MiSFIT, Touboul '683,
 17 Atkinson, McManis, Chu, Härtig, Islam, Kephart, Necula, Chen and other references as described
 18 in Table 1 and associated claim charts would achieve the desired structure and functionality of
 19 receiving incoming Downloadables, for such structures and mechanisms were well known in the
 20 art and would have been obvious to one of ordinary skill in the art.

21 To the extent that Finjan argues that any of these references do not satisfy the "performing
 22 a hashing function on the incoming Downloadable" limitations, it would have been obvious to
 23 modify those references to allow for the performance of mathematical operations to create a hash
 24 of an incoming Downloadable, as described in AppletTrap, Aucsmith, Ji '348, Touboul '583,
 25 MiSFIT, Touboul '683, Atkinson, McManis, Chu, Härtig, Islam, Kephart, Necula, and Chen. One
 26 of ordinary skill in the art would have been motivated to combine AppletTrap, Aucsmith, Ji '348,
 27 Touboul '583, MiSFIT, Touboul '683, Atkinson, McManis, Chu, Härtig, Islam, Kephart, Necula,
 28 and Chen with one or more other references identified in Table 1 and/or Table 2 and would have

1 reasonably expected that the combination would achieve the intended purpose. Each reference
 2 relates to computer and network security. A person of ordinary skill in the art looking to create
 3 improved computer security methods and products would look to consider solutions implemented
 4 in other computer security methods and products such as those disclosed in AppletTrap,
 5 Aucsmith, Ji '348, Touboul '583, MiSFIT, Touboul '683, Atkinson, McManis, Chu, Härtig,
 6 Islam, Kephart, Necula, Chen and other references as described in PAN's Invalidity Contentions
 7 and associated claim charts. A person of ordinary skill in the art looking to solve this problem
 8 would review patents, patent publications and prior art systems in the field of computer and
 9 network security such as AppletTrap, Aucsmith, Ji '348, Touboul '583, MiSFIT, Touboul '683,
 10 Atkinson, McManis, Chu, Härtig, Islam, Kephart, Necula, Chen other references as described in
 11 PAN's Invalidity Contentions and associated claim charts. One of ordinary skill in the art also
 12 would have reasonably expected that such combination of AppletTrap, Aucsmith, Ji '348,
 13 Touboul '583, MiSFIT, Touboul '683, Atkinson, McManis, Chu, Härtig, Islam, Kephart, Necula,
 14 Chen other references as described in Table 1 and associated claim charts would achieve the
 15 desired structure and functionality of performing a hashing function on an incoming
 16 Downloadable to compute a Downloadable ID, for such structures and mechanisms were well
 17 known in the art and would have been obvious to one of ordinary skill in the art.

18 To the extent that Finjan argues that any of these references do not satisfy the "retrieving
 19 security profile data" limitations, it would have been obvious to modify those references to allow
 20 for retrieval of security profile data from an obtained Downloadable, as described in AppletTrap,
 21 Aucsmith, Ji '348, Touboul '583, MiSFIT, Touboul '683, Atkinson, McManis, Chu, Härtig,
 22 Islam, Kephart, Necula, and Chen. One of ordinary skill in the art would have been motivated to
 23 combine AppletTrap, Aucsmith, Ji '348, Touboul '583, MiSFIT, Touboul '683, Atkinson,
 24 McManis, Chu, Härtig, Islam, Kephart, Necula, and Chen with one or more other references
 25 identified in Table 1 and/or Table 2 and would have reasonably expected that the combination
 26 would achieve the intended purpose. Each reference relates to computer and network security. A
 27 person of ordinary skill in the art looking to create improved computer security methods and
 28 products would look to consider solutions implemented in other computer security methods and

1 products such as those disclosed in AppletTrap, Aucsmith, Ji '348, Touboul '583, MiSFIT,
 2 Touboul '683, Atkinson, McManis, Chu, Härtig, Islam, Kephart, Necula, Chen and other
 3 references as described in PAN's Invalidity Contentions and associated claim charts. A person of
 4 ordinary skill in the art looking to solve this problem would review patents, patent publications
 5 and prior art systems in the field of computer and network security such as AppletTrap,
 6 Aucsmith, Ji '348, Touboul '583, MiSFIT, Touboul '683, Atkinson, McManis, Chu, Härtig,
 7 Islam, Kephart, Necula, Chen and other references as described in PAN's Invalidity Contentions
 8 and associated claim charts. One of ordinary skill in the art also would have reasonably expected
 9 that such combination of AppletTrap, Aucsmith, Ji '348, Touboul '583, MiSFIT, Touboul '683,
 10 Atkinson, McManis, Chu, Härtig, Islam, Kephart, Necula and other references as described in
 11 Table 1 and associated claim charts would achieve the desired structure and functionality of
 12 retrieving security profile data, for such structures and mechanisms were well known in the art
 13 and would have been obvious to one of ordinary skill in the art.

14 To the extent that Finjan argues that any of these references do not satisfy the "appending"
 15 and "transmitting" limitations, including the transmission of a "representation" of a
 16 Downloadable, it would have been obvious to modify those references to allow for the appending
 17 and transmission of a Downloadable, security profile, and a "representation" of either, as
 18 described in AppletTrap, Aucsmith, Ji '348, Touboul '583, MiSFIT, Touboul '683, Atkinson,
 19 McManis, Chu, Härtig, Islam, Kephart, Necula, Chen, Levy '147 (*see, e.g.*, 6:28-50), Isaak '247
 20 (*see, e.g.*, 1:16-25, 3:6-12, 4:59-65, Fig. 6), Abadi '370 (*see, e.g.*, 6:51-7:5, 3:47-65), Bahreman
 21 (*see, e.g.* at 3), and Hinsley '830 (*see, e.g.*, 2:26-45). One of ordinary skill in the art would have
 22 been motivated to combine AppletTrap, Aucsmith, Ji '348, Touboul '583, MiSFIT, Touboul '683,
 23 Atkinson, McManis, Chu, Härtig, Islam, Kephart, Necula, Chen, Levy '147 (*see, e.g.*, 6:28-50),
 24 Isaak '247 (*see, e.g.*, 1:16-25, 3:6-12, 4:59-65, Fig. 6), Abadi '370 (*see, e.g.*, 6:51-7:5, 3:47-65),
 25 Bahreman (*see, e.g.* at 3), and Hinsley '830 (*see, e.g.*, 2:26-45) with one or more other references
 26 identified in Table 1 and/or Table 2 and would have reasonably expected that the combination
 27 would achieve the intended purpose. Each reference relates to computer and network security. A
 28 person of ordinary skill in the art looking to create improved computer security methods and

1 products would look to consider solutions implemented in other computer security methods and
 2 products such as those disclosed in AppletTrap, Aucsmith, Ji '348, Touboul '583, MiSFIT,
 3 Touboul '683, Atkinson, McManis, Chu, Härtig, Islam, Kephart, Necula, Chen, Levy '147 (*see*,
 4 *e.g.*, 6:28-50), Isaak '247 (*see, e.g.*, 1:16-25, 3:6-12, 4:59-65, Fig. 6), Abadi '370 (*see, e.g.*, 6:51-
 5 7:5, 3:47-65), Bahreman (*see, e.g.* at 3), and Hinsley '830 (*see, e.g.*, 2:26-45) and other references
 6 as described in PAN's Invalidity Contentions and associated claim charts. A person of ordinary
 7 skill in the art looking to solve this problem would review patents, patent publications and prior
 8 art systems in the field of computer and network security such as AppletTrap, Aucsmith, Ji '348,
 9 Touboul '583, MiSFIT, Touboul '683, Atkinson, McManis, Chu, Härtig, Islam, Kephart, Necula,
 10 Chen and other references as described in PAN's Invalidity Contentions and associated claim
 11 charts. One of ordinary skill in the art also would have reasonably expected that such combination
 12 of AppletTrap, Aucsmith, Ji '348, Touboul '583, MiSFIT, Touboul '683, Atkinson, McManis,
 13 Chu, Härtig, Islam, Kephart, Necula, Chen and other references as described in Table 1 and
 14 associated claim charts would achieve the desired structure and functionality of appending and
 15 transmitting Downloadables, associated security profiles and a representation of either, for such
 16 structures and mechanisms were well known in the art and would have been obvious to one of
 17 ordinary skill in the art.

18 To the extent that Finjan argues that any of these references do not satisfy limitations
 19 related to different items which a Downloadable "includes" (such as an applet, active control, and
 20 program script), it would have been obvious to modify those references to allow for a
 21 Downloadable to include these features, as described in AppletTrap, Aucsmith, Ji '348, Touboul
 22 '583, MiSFIT, Touboul '683, Atkinson, McManis, Chu, Härtig, Islam, Kephart, Necula, and
 23 Martin. One of ordinary skill in the art would have been motivated to combine AppletTrap,
 24 Aucsmith, Ji '348, Touboul '583, MiSFIT, Touboul '683, Atkinson, McManis, Chu, Härtig,
 25 Islam, Kephart, Necula, Chen and Martin with one or more other references identified in Table 1
 26 and/or Table 2 and would have reasonably expected that the combination would achieve the
 27 intended purpose. Each reference relates to computer and network security. A person of ordinary
 28 skill in the art looking to create improved computer security methods and products would look to

1 consider solutions implemented in other computer security methods and products such as those
2 disclosed in AppletTrap, Aucsmith, Ji '348, Touboul '583, MiSFIT, Touboul '683, Atkinson,
3 McManis, Chu, Härtig, Islam, Kephart, Necula, Chen, Martin and other references as described in
4 PAN's Invalidity Contentions and associated claim charts. A person of ordinary skill in the art
5 looking to solve this problem would review patents, patent publications and prior art systems in
6 the field of computer and network security such as AppletTrap, Aucsmith, Ji '348, Touboul '583,
7 MiSFIT, Touboul '683, Atkinson, McManis, Chu, Härtig, Islam, Kephart, Necula, Chen, Martin
8 and other references as described in PAN's Invalidity Contentions and associated claim charts.
9 One of ordinary skill in the art also would have reasonably expected that such combination of
10 AppletTrap, Aucsmith, Ji '348, Touboul '583, MiSFIT, Touboul '683, Atkinson, McManis, Chu,
11 Härtig, Islam, Kephart, Necula, Chen, Martin and other references as described in Table 1 and
12 associated claim charts would achieve the desired structure and functionality of including
13 commonly used types of files for carrying malware in a Downloadable, for such structures and
14 mechanisms were well known in the art and would have been obvious to one of ordinary skill in
15 the art.

16 To the extent that Finjan argues that any of these references do not satisfy limitations
17 related to wherein suspicious computer operations include calls made to an operating system, a
18 file system, a network system, and to memory, it would have been obvious to modify those
19 references to allow for a Downloadable to include these features, as described in AppletTrap,
20 Aucsmith, Ji '348, Touboul '583, MiSFIT, Touboul '683, Atkinson, McManis, Chu, Härtig,
21 Islam, Kephart, Necula, and Swimmer. One of ordinary skill in the art would have been
22 motivated to combine AppletTrap, Aucsmith, Ji '348, Touboul '583, MiSFIT, Touboul '683,
23 Atkinson, McManis, Chu, Härtig, Islam, Kephart, Necula, Chen, and Swimmer with one or more
24 other references identified in Table 1 and/or Table 2 and would have reasonably expected that the
25 combination would achieve the intended purpose. Each reference relates to computer and network
26 security. A person of ordinary skill in the art looking to create improved computer security
27 methods and products would look to consider solutions implemented in other computer security
28 methods and products such as those disclosed in AppletTrap, Aucsmith, Ji '348, Touboul '583,

1 MiSFIT, Touboul '683, Atkinson, McManis, Chu, Härtig, Islam, Kephart, Necula, Chen,
 2 Swimmer and other references as described in PAN's Invalidity Contentions and associated claim
 3 charts. A person of ordinary skill in the art looking to solve this problem would review patents,
 4 patent publications and prior art systems in the field of computer and network security such as
 5 AppletTrap, Aucsmith, Ji '348, Touboul '583, MiSFIT, Touboul '683, Atkinson, McManis, Chu,
 6 Härtig, Islam, Kephart, Necula '774, Chen, Swimmer and other references as described in PAN's
 7 Invalidity Contentions and associated claim charts. One of ordinary skill in the art also would
 8 have reasonably expected that such combination of AppletTrap, Aucsmith, Ji '348, Touboul '583,
 9 MiSFIT, Touboul '683, Atkinson, McManis, Chu, Härtig, Islam, Kephart, Necula, Chen,
 10 Swimmer and other references as described in Table 1 and associated claim charts would achieve
 11 the desired structure and functionality of including suspicious computer operations which include
 12 calls made to an operating system, a file system, a network system, and to memory (common and
 13 well-known types of malicious attacks), for such structures and mechanisms were well known in
 14 the art and would have been obvious to one of ordinary skill in the art.

15 To the extent that Finjan argues that any of these references do not satisfy limitations
 16 related to wherein the Downloadable security profile data includes a URL from where the
 17 Downloadable originated, it would have been obvious to modify those references to allow for a
 18 Downloadable to include these features, as described in AppletTrap, Aucsmith, Ji '348, Touboul
 19 '583, MiSFIT, Touboul '683, Atkinson, McManis, Chu, Härtig, Islam, Kephart, and Necula. One
 20 of ordinary skill in the art would have been motivated to combine AppletTrap, Aucsmith, Ji '348,
 21 Touboul '583, MiSFIT, Touboul '683, Atkinson, McManis, Chu, Härtig, Islam, Kephart, and
 22 Necula with one or more other references identified in Table 1 and/or Table 2 and would have
 23 reasonably expected that the combination would achieve the intended purpose. Each reference
 24 relates to computer and network security. A person of ordinary skill in the art looking to create
 25 improved computer security methods and products would look to consider solutions implemented
 26 in other computer security methods and products such as those disclosed in AppletTrap,
 27 Aucsmith, Ji '348, Touboul '583, MiSFIT, Touboul '683, Atkinson, McManis, Chu, Härtig,
 28 Islam, Kephart, Necula and other references as described in PAN's Invalidity Contentions and

1 associated claim charts. A person of ordinary skill in the art looking to solve this problem would
2 review patents, patent publications and prior art systems in the field of computer and network
3 security such as AppletTrap, Aucsmith, Ji '348, Touboul '583, MiSFIT, Touboul '683, Atkinson,
4 McManis, Chu, Härtig, Islam, Kephart, Necula and other references as described in PAN's
5 Invalidity Contentions and associated claim charts. One of ordinary skill in the art also would
6 have reasonably expected that such combination of AppletTrap, Aucsmith, Ji '348, Touboul '583,
7 MiSFIT, Touboul '683, Atkinson, McManis, Chu, Härtig, Islam, Kephart, Necula and other
8 references as described in Table 1 and associated claim charts would achieve the desired structure
9 and functionality of including suspicious computer operations which include a URL as a means of
10 designating the origin of a Downloadable, for such structures and mechanisms were well known
11 in the art and would have been obvious to one of ordinary skill in the art.

12 To the extent that Finjan argues that any of these references do not satisfy limitations
13 related to wherein the Downloadable security profile data includes a digital certificate, it would
14 have been obvious to modify those references to allow for a Downloadable to include these
15 features, as described in AppletTrap, Aucsmith, Ji '348, Touboul '583, MiSFIT, Touboul '683,
16 Atkinson, McManis, Chu, Härtig, Islam, Kephart, Necula, and Chen. One of ordinary skill in the
17 art would have been motivated to combine AppletTrap, Aucsmith, Ji '348, Touboul '583,
18 MiSFIT, Touboul '683, Atkinson, McManis, Chu, Härtig, Islam, Kephart, Necula, and Chen with
19 one or more other references identified in Table 1 and/or Table 2 and would have reasonably
20 expected that the combination would achieve the intended purpose. Each reference relates to
21 computer and network security. A person of ordinary skill in the art looking to create improved
22 computer security methods and products would look to consider solutions implemented in other
23 computer security methods and products such as those disclosed in AppletTrap, Aucsmith, Ji
24 '348, Touboul '583, MiSFIT, Touboul '683, Atkinson, McManis, Chu, Härtig, Islam, Kephart,
25 Necula, Chen and other references as described in PAN's Invalidity Contentions and associated
26 claim charts. A person of ordinary skill in the art looking to solve this problem would review
27 patents, patent publications and prior art systems in the field of computer and network security
28 such as AppletTrap, Aucsmith, Ji '348, Touboul '583, MiSFIT, Touboul '683, Atkinson,

McManis, Chu, Härtig, Islam, Kephart, Necula, Chen and other references as described in PAN's Invalidity Contentions and associated claim charts. One of ordinary skill in the art also would have reasonably expected that such combination of AppletTrap, Aucsmith, Ji '348, Touboul '583, MiSFIT, Touboul '683, Atkinson, McManis, Chu, Härtig, Islam, Kephart, Necula, Chen and other references as described in Table 1 and associated claim charts would achieve the desired structure and functionality of including Downloadable security profile data which includes a digital certificate, for such structures and mechanisms were well known in the art and would have been obvious to one of ordinary skill in the art.

PAN reserves the right to rely on additional combinations.

4. Patent L.R. 3-3(c) Invalidity Contentions Charts

Pursuant to Patent Local Rule 3-3(c), charts identifying specifically where and how in each alleged item of prior art each limitation of each asserted claim is found are attached as Exhibits B-1 to B-14. Where elements are disclosed at multiple locations within a single item of prior art, PAN has not necessarily identified every iteration of every disclosure.

5. Patent L.R. 3-3(d) Invalidity Based on 35 U.S.C. § 101, Indefiniteness Under 35 U.S.C. § 112(2), or Enablement or Written Description Under 35 U.S.C. § 112(1)

Based on PAN's present understanding of the Asserted Claims and/or PAN's apparent construction of the claims, as set forth in Finjan's Infringement Contentions, and subject to the reservation of rights above, PAN lists below the grounds upon which the Asserted Claims of the '780 Patent are invalid based on 35 U.S.C. § 101, indefiniteness, lack of written description, and/or lack of enablement under 35 U.S.C. § 112. To the extent PAN's identified grounds for invalidity are based on Finjan's apparent constructions, PAN is not adopting Finjan's apparent constructions, nor is PAN agreeing that any of Finjan's apparent constructions are correct. Moreover, Finjan's deficient Infringement Contentions fail to provide PAN with adequate notice as to Finjan's infringement theories. PAN reserves all rights to advance claim construction positions different from Finjan's apparent constructions.

PAN's contentions that the following claims are invalid under 35 U.S.C. § 112 are made in the alternative, and do not constitute, and should not be interpreted as, admissions regarding

1 the construction or scope of the Asserted Claims, or that any of the Asserted Claims are not
 2 anticipated or rendered obvious by any prior art. Where PAN identifies a claim term in an
 3 independent claim as being invalid, PAN further contends any asserted dependent claim is invalid
 4 based on the presence of the same term.

5 In light of the deficiencies in Finjan's Infringement Contentions, PAN reserves the right to
 6 amend, modify, and/or supplement these Contentions to further identify bases for invalidity under
 7 35 U.S.C. § 112. PAN's Contentions shall not be construed as an admission that any claim
 8 construction advanced by PAN in this case is in any way inconsistent, flawed or erroneous. Nor
 9 should these Contentions prevent PAN from advancing claim construction and/or non-
 10 infringement positions in lieu of, or in addition to, invalidity positions. Further, PAN's
 11 Contentions shall not be construed as an admission of or acquiescence to Finjan's purported
 12 construction of the claim language or of other positions advanced by Finjan during the course of
 13 this litigation. PAN's Contentions under 35 U.S.C. § 112 may depend, in part, on the Court's
 14 claim construction, as well as Finjan's asserted claim scope. Consequently, PAN only identifies
 15 herein the issues under 35 U.S.C. § 112 of which it is presently aware based on PAN's present
 16 understanding of the asserted claims and/or Finjan's apparent construction of the claims, as set
 17 forth in Finjan's Infringement Contentions. PAN reserves all rights to advance claim
 18 construction positions different from Finjan's apparent constructions and to amend these
 19 contentions as it better understands Finjan's construction of the claims during the claim
 20 construction process.

21 **a. Unpatentable Subject Matter Under 35 U.S.C. § 101**

22 The Asserted Claims of the '926 Patent are directed to non-statutory subject matter, under
 23 35 U.S.C. § 101, because the claims are directed to merely creating a file identifier, looking up
 24 data based on the identifier, and appending the data to the file, which is an abstract concept. The
 25 recitation of generic computer components does not amount to significantly more than the
 26 abstract idea itself. *See CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed.
 27 Cir. 2011) (reasoning that the use of the Internet to verify a credit card transaction does not
 28 meaningfully add to the abstract idea of verifying the transaction). Additionally, claims 8-14 and

22-28 are directed to software per se. Therefore, the Asserted Claims of the '926 Patent are not directed to patent-eligible subject matter under 35 U.S.C. §101, and are invalid.

b. Indefiniteness Under 35 U.S.C. § 112(2)

“[A] patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014).

The following claim limitations of the Asserted Claims are invalid based on indefiniteness.

- “Downloadable”
- “Downloadable identifier”
- “receiver”
- “database manager”
- “file appender”
- “transmitter”

c. Lack of Written Description Under 35 U.S.C. § 112(1)

To satisfy the written description requirement, the description must “clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.” *Ariad Pharm., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (internal citation omitted). The test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date. *Id.*

The test requires an objective inquiry into the four corners of the specification from the perspective of a POSITA. Based on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed. “Whether the written description requirement is satisfied is a fact-based inquiry that will depend on the nature of the claimed invention, and the knowledge of one skilled in the art at the time an invention is made and a patent application is filed.” *Carnegie Mellon Univ. v. Hoffmann*

1 *La Roche Inc.*, 541 F.3d 1115, 1122 (Fed. Cir. 2008) (internal citation omitted). Actual
 2 “possession” or reduction to practice outside of the specification is not enough. Instead, the
 3 specification itself must demonstrate possession.

4 While the written description requirement does not demand any particular form of
 5 disclosure, a description that merely renders the invention obvious does not satisfy the
 6 requirement. *Lockwood v. Am. Airlines*, 107 F.3d 1565, 1571-72 (Fed. Cir. 1997).

7 The following claim limitations of the Asserted Claims are invalid for lack of written
 8 description:

- 9 • Finjan’s apparent construction of “append” to mean “link” is not adequately
 10 described in the ’926 patent, and therefore these claims are invalid for lack of
 11 written description support. The same goes for related claims directed to
 12 transporting a “representation” of a retrieved Downloadable along with security
 13 profile data.

14 **d. Lack of Enablement Under 35 U.S.C. § 112(1)**

15 To satisfy the enablement requirement of 35 U.S.C § 112, the disclosure “must teach those
 16 skilled in the art how to make and use the full scope of the claimed invention without ‘undue
 17 experimentation.’” *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365 (Fed. Cir. 1997)
 18 (citations omitted). Moreover, “[i]t is the specification, not the knowledge of one skilled in the
 19 art, that must supply the novel aspects of [the] invention in order to constitute adequate
 20 enablement.” *Id.* at 1366. The Federal Circuit has enumerated several factors to consider in
 21 determining whether a disclosure would require “undue experimentation”: “(1) the quantity of
 22 experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or
 23 absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the
 24 relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the
 25 breadth of the claims.” *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988).

26 The following claim limitations of the Asserted Claims are invalid for lack of enablement:

- 27 • Finjan’s apparent construction of “append” to mean “link” is not adequately
 28 described in the ’926 patent, and therefore these claims are invalid for lack of

enablement. The same goes for related claims directed to transporting a
“representation” of a retrieved Downloadable along with security profile data.

D. Invalidity of the '633 Patent

1. Priority Date

Finjan alleges that the Asserted Claim of the '633 Patent is entitled to the priority date of January 29, 1997. Finjan's Initial Disclosure of Asserted Claims and Infringement Contentions, at 20. Finjan apparently alleges that the Asserted Claim of the '633 Patent is entitled to the benefit of the filing date of the nonprovisional application that later matured into U.S. Patent No. 6,167,520, which was filed on January 29, 1997. Neither the '520 Patent, nor any of the other patents in the ancestry of the '633 Patent, however, discloses the subject matter claimed by the Asserted Claim of '633 Patent. Thus, based on the information presently available to PAN, the earliest date to which the '633 Patent may claim priority is June 22, 2005, the date on which the application that issued as the '633 Patent was filed, or May 17, 2001, the date on which the application that later issued as the '822 Patent was filed, or May 17, 2000, the date of provisional application No. 60/205,591.

2. Patent L.R. 3-3(a) Identification of Prior Art

Subject to the reservations of rights above, PAN identifies prior art that anticipates and/or renders obvious the Asserted Claim of the '633 Patent. The prior art references identified are also relevant to show the state of the art and reasons and motivations for making improvements, additions, modifications, and combinations.

In addition, PAN incorporates the prior art, claims charts, and invalidity theories disclosed, listed and/or asserted by any entity during the course of other litigation (past, present/ongoing, or future) or patent office challenges (either reexaminations or IPRs). Finjan has failed to timely update its production of these materials, which has prejudiced PAN in its preparation of these contentions. PAN reserves the right to rely on any prior art reference, prior art combination, motivation to combine, invalidity theory, and/or materials disclosed in these other proceedings. At least the following prior art references anticipate and/or render obvious the

1 Asserted Claim of the '633 Patent, and/or illustrate the state of the art at the time of the alleged
2 invention:

3 **a. Patent Prior Art**

4 Ref. No.	Publication No.	Short Name	Filing Date	Publication Date	Priority Date
5 1.	U.S. Patent No. 6,253,370	"Abadi"	December 1, 1997	June 26, 2001	December 1, 1997
6 2.	U.S. Patent No. 5,440,723	"Arnold"	January 19, 1993	August 8, 1995	January 19, 1993
7 3.	U.S. Patent No. 6,275,938	"Bond"	August 28, 1997	August 14, 2001	August 28, 1997
8 4.	U.S. Patent No. 6,065,118	"Bull"	September 24, 1996	May 6, 2000	September 24, 1996
9 5.	U.S. Patent No. 5,974,549	"Golan"	March 27, 1997	October 26, 1999	March 27, 1997
10 6.	WO 98/31124	"Hanson"	January 10, 1997	July 16, 1998	January 10, 1997
11 7.	U.S. Patent No. 5,983,348	"Ji '348"	September 10, 1997	November 9, 1999	September 10, 1997
12 8.	U.S. Patent No. 5,623,600	"Ji '600"	September 26, 1995	April 22, 1997	September 26, 1995
13 9.	U.S. Patent No. 5,940,590	"Lynne"	May 31, 1997	August 17, 1999	May 31, 1997
14 10.	U.S. Patent No. 6,088,803	"Tso"	March 27, 1997	July 11, 2000	March 27, 1997
15 11.	U.S. Patent No. 5,987,610	"Franczek"	February 12, 1998	November 16, 1999	February 12, 1998

16 **b. Non-Patent Publication Prior Art**

17 Ref. No.	Publication	Short Name	Publication Date
18 1.	Ülfar Erlingsson, Fred B. Schneider, "SASI Enforcement of Security Policy: A Retrospective," NSPW '99: Proceedings of the 1999 workshop on New security paradigms, 87-95 (Sept. 1999)	"Erlingsson"	September 1999

Ref. No.	Publication	Short Name	Publication Date
2.	Brant Hashii et al. "Securing Systems Against External Programs," IEEE Internet Computing, 35-45 (Nov./Dec. 1998)	"Hashii"	November/December 1998
3.	Andrew Herbert, "Secure Mobile Code Management; Enabling Java for the Enterprise" (May, 1997)	"Herbert"	May 1997
4.	Dahlia Malkhi, Michael Reiter, and Avi Rubin, "The Design and Implementation of a Java Playground," DIMACS Technical Report 97-64, September, 1997	"Malkhi"	September 1997
5.	Raju Pandey, Brant Hashii, "Providing Fine-Grained Access Control for Mobile Programs Through Binary Editing," DARPA, Technical Report TR-98-08 (1998)	"Pandey"	1998
6.	David M. Martin Jr., Sivaramakrishnan Rajagopalan, Aviel D. Rubin, "Blocking Java Applets at the Firewall," Proceedings of the 1997 Symposium on Network and Distributed System Security (Feb. 10-11, 1997), IEEE, pp. 16-26	"Rubin"	February 1997
7.	Insik Shin and John C. Mitchell, "Java Bytecode Modification and Applet Security," Stanford CS Tech Report, 1998	"Shin"	1998
8.	Emin Gun Sirer, Robert Grimm, Arthur J. Gregory, and Brian N. Bershad, "Design and implementation of a distributed virtual machine for networked computers," SOSP '99 Proceedings of the Seventeenth ACM Symposium on Operating Systems Principles, 202-216 (Dec. 1999)	"Sirer"	December 1999

PAN additionally identifies and relies on each of the additional patent or publication references that describe or are otherwise related to the prior art systems identified below.

c. System or Product Prior Art

PAN sets forth numerous prior art products or systems in the table below. For such prior art products and systems, PAN has identified, based on its current knowledge, approximate dates on which such products were sold, on sale, made, known, and/or used in the U.S. PAN's investigation of prior art products and systems is ongoing. Further information and/or documents regarding such products and their sale, offer for sale, and use dates will be produced or disclosed

as it is (they are) obtained in discovery or otherwise becomes available to PAN. PAN reserves the right to amend, modify, and/or supplement these Contentions based on further and subsequent investigation and discovery. Additionally, PAN reserves the right to rely on the documents identified below as standalone prior art references separate from the prior art system or product they describe.

PAN additionally identifies and relies on any system, product, or public knowledge or use that embodies or otherwise incorporates any of the prior art patents and publications listed above. PAN reserves the right to identify and rely on systems that represent different versions or are otherwise related variations of the identified products and systems.

Ref No.	System Name	Short Name	Date Made, Known, Used, Sold, or On Sale
1.	InterScan VirusWall	“VirusWall”	1996
2.	InterScan AppletTrap	“AppletTrap”	March 1999
3.	Janus System	“Janus System”	1999

(i) InterScan VirusWall

VirusWall was sold, on sale, made, known, and/or used at least by 1996. The features, operations, and functionality of VirusWall are described throughout the VirusWall documentation produced in this case. These documents include:

- TFS00000001 – TFS00005934
- TM-FIN000001 – TM-FIN000563

(ii) InterScan AppletTrap

AppletTrap was sold, on sale, made, known, and/or used at least by March 1999. The features, operations, and functionality of AppletTrap are described throughout the AppletTrap documentation produced in this case. These documents include:

- TFS00000001 – TFS00005934
- TM-FIN000001 – TM-FIN000563

(iii) Janus System

Janus System was sold, on sale, made, known, and/or used at least by 1999. The features, operations, and functionality of Janus System are described throughout the Janus System documentation produced in this case. These documents include:

- David A. Wagner, “Janus: an Approach for Confinement of Untrusted Applications,” EECS Dept., University of California, Berkeley, Technical Report No. UCB/CSD-99-1056 (1999)

d. 35 U.S.C. § 102(f)

PAN reserves the right to assert that the Asserted Claim are invalid under 35 U.S.C. § 102(f) in the event PAN obtains additional evidence that the inventors named in any of the Asserted Patents did not invent the subject matter claimed therein. Should PAN obtain such evidence, it will provide the name of the person(s) from whom and the circumstances under which the alleged invention or any part of it was derived.

e. 35 U.S.C. § 102(g)

PAN reserves the right to assert that the Asserted Claim is invalid under 35 U.S.C. § 102(g) in the event PAN obtains additional evidence that any of the inventions claimed in the Asserted Patents were made in the United States by another inventor who had not abandoned, suppressed or concealed it, prior to the alleged invention by the applicant of the Asserted Patents. Should PAN obtain such evidence, it will provide the identities of the persons or entities involved in and the circumstances surrounding the making the inventions before the patent applicants.

3. Patent L.R. 3-3(b) Anticipation and Obviousness

The references in Table 1, alone or in combination with the knowledge of one skilled in the art, anticipate or render obvious the Asserted Claim of the '633 Patent.

Table 1: Prior Art References: Anticipation and Primary/Secondary Obviousness

References

Short Name	Prior Art Under	Priority Date	Exemplary Claim Chart
Abadi	102(a), (b), (e)	December 1, 1997	D-1

Short Name	Prior Art Under	Priority Date	Exemplary Claim Chart
AppletTrap	102(a), (b)	March 1999	D-2
Arnold	102(a), (b)	January 19, 1993	D-3
Bond	102(a), (b), (e)	August 28, 1997	D-4
Bull	102(a), (b), (e)	September 24, 1996	D-5
Erlingsson	102(a), (b)	September 1999	D-6
Golan	102(a), (b), (e)	March 27, 1997	D-7
Hanson	102(a), (b)	January 10, 1997	D-8
Hashii	102(a), (b)	November/December 1998	D-9
Herbert	102(a), (b)	May 1997	D-10
Ji '348	102(a), (b), (e)	September 10, 1997	D-11
Lynne	102(a), (b), (e)	May 31, 1997	D-12
Malkhi	102(a), (b)	September 1997	D-13
Pandey	102(a), (b)	1998	D-14
Rubin	102(a), (b)	February 1997	D-15
Shin	102(a), (b)	1998	D-16
Sirer	102(a), (b)	December 1999	D-17
Tso	102(a), (b), (e)	March 27, 1997	D-18
VirusWall	102(a), (b)	1996	D-19
Janus System	102(a), (b)	1999	D-20

In addition, each of the references in Table 1 above and Table 2 below, either alone, in view of the knowledge of a POSITA, and/or in combination with one or more references in Table 1 or Table 2, renders obvious the Asserted Claim of the '633 Patent.

Table 2: Additional Prior Art References: Obviousness

Short Name	Prior Art Under	Priority Date
Ji '600	102(a), (b), (e)	September 26, 1995
Franczek	102(a), (b), (e)	February 12, 1998

In addition, PAN incorporates by reference each and every prior art reference of record in the prosecution of the '633 Patent and any related patent or application, the statements made therein by the applicant, as well as the prior art discussed in the specification.

The cited portions of each prior art reference are exemplary and representative of the content of the reference, and should be understood in the context of the reference as a whole, as understood by one of ordinary skill in the art. To the extent a prior art reference is deemed not to anticipate or render obvious a claim as noted in the attached charts for failing to disclose, teach, or suggest one or more limitations of a claim, that claim would nonetheless have been obvious to one of ordinary skill in the art at the time of the alleged invention over the reference itself or by the combination of the reference with one or more other references disclosing the missing claim limitations or the knowledge of a person having ordinary skill in the art.

a. Prior Art Combinations

The Asserted Claim of the '633 Patent is obvious based on one or more combinations of the prior art references above. The sections below provide motivations to combine the prior art references above. These obviousness combinations are provided in the alternative to PAN's anticipation and single-reference obviousness contentions and are not to be construed to suggest that any reference included in the combination is not itself anticipatory or would not render the Asserted Claim obvious in light of the knowledge of a person having ordinary skill in the art. PAN also hereby incorporates by reference the prior art, invalidity grounds, and expert testimony submitted in connection with any petitions for *inter partes* review of the '633 Patent.

b. Motivation to Combine

A POSITA would have been motivated to combine the preceding references for any number of reasons, such as the following exemplary reasons. Teachings, suggestions,

1 motivations, and/or reasons to modify any of the references and/or to combine any two or more of
 2 the references can come from many sources, including the prior art, common knowledge,
 3 common sense, predictability, expectations, industry trends, design incentives or need, market
 4 demand or pressure, market forces, obviousness to try, the nature of the problem faced, and/or
 5 knowledge possessed by a POSITA.

6 Although a patent claim may be invalidated based on a teaching-suggestion-motivation
 7 (“TSM”) rationale—*i.e.*, that some teaching, suggestion, or motivation in the prior art that would
 8 have led one of ordinary skill to modify the prior-art reference or to combine prior-art reference
 9 teachings to arrive at the claimed invention—the Supreme Court identified additional rationales
 10 in *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007). The following of these rationales apply
 11 here:

12 (A) the Asserted Claim combines prior-art elements according to known methods
 to yield predictable results;

13 (B) the Asserted Claim involves the simple substitution of one known element for
 14 another to obtain predictable results;

15 (C) the Asserted Claim involves the use of a known technique to improve similar
 devices (methods, or products) in the same way;

16 (D) the Asserted Claim applies a known technique to a known device (method, or
 17 product) ready for improvement to yield predictable results;

18 (E) the Asserted Claim involves combinations of prior-art references that would
 have been “obvious to try”—a person of ordinary skill in the art could have
 19 reached the Asserted Claim by choosing from a finite number of identified,
 predictable solutions, with a reasonable expectation of success;

20 (F) the Asserted Claim is simply variations of work from one field of endeavor or
 21 a different one that would have been prompted based on design incentives or other
 market forces because the variations were predictable to one of ordinary skill in
 22 the art.

23 *See KSR*, 550 U.S. at 415-18 (rejecting the Federal Circuit’s “rigid” application of the teaching,
 suggestion, or motivation to combine test, and instead espousing an “expansive and flexible”
 24 approach). Indeed, the Supreme Court held that a person of ordinary skill in the art is “a person
 25 of ordinary creativity, not an automaton” and “in many cases a person of ordinary skill in the art
 26 will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *KSR*, 550
 27 U.S. at 420-21.
 28

1 Thus, even in the absence of a specific teaching, suggestion, or motivation to combine
2 references, the Asserted Claim here is obvious and therefore invalid. Each of the cited references
3 or devices is in the same field, making it obvious for someone of ordinary skill in the art to
4 identify and combine elements from these references. One of ordinary skill in the art would have
5 recognized that improvements could be achieved by combining or modifying prior-art references
6 that described such improvements. Each of the above prior-art references describes devices or
7 methods that were known to offer such improvements, and, accordingly, one of ordinary skill in
8 the art would have been motivated to combine or modify the references as identified in each of
9 the combinations above.

10 Indeed, given that the references are in the same field, one of ordinary skill would have
11 readily, with predictable results, taken teachings from one reference and applied them to other
12 references. As referenced above, multiple prior art references teach or suggest the concepts
13 claimed in the '633 Patent. To the extent Finjan argues that any concepts claimed in the
14 '633 Patent were not contained in any prior art reference, it would, at a minimum, have been
15 obvious to adapt each reference to include the concept or combine it with other references that
16 disclose the concept. In addition, each of the constituent techniques described here was well
17 known to those of ordinary skill in the art, and understood to be among a menu of available
18 design choices for improving network security. This is one of many motivations to combine the
19 above references.

20 Furthermore, because methods and systems related to a computer gateway for an intranet
21 of computers were well known and studied extensively prior to the '633 Patent priority date,
22 common industry knowledge supplied a reason to combine the above references with each other.
23 Each combination would have produced no unexpected results and would simply represent a
24 known alternative to one of ordinary skill in the art. This is a further motivation to combine any
25 of the above references.

26 The below sections further address particular reasons to combine the above references.
27 The below should not be construed as an admission that there is any value to the alleged invention
28 of the '633 Patent. As discussed previously, these contentions are based largely on how Finjan is

1 apparently construing the Asserted Claim in its Initial Infringement Contentions, which is an
2 incorrect and overbroad interpretation of the alleged invention of the '633 Patent. Accordingly,
3 to the extent the below refers to benefits of certain elements or industry trends towards these
4 elements, this is not an admission that the alleged invention of the '633 Patent provides any
5 benefits—to the contrary, properly construed and compared to the prior art, the '633 Patent
6 provides no benefits. Likewise, to the extent the below refers to substituting elements, this is not
7 an admission that the elements subject to the substitution are in any way similar, *e.g.*, perform the
8 same function, in the same way, to reach the same result.

9 The various elements of the Asserted Claim were well-known in the prior art at the time
10 of the alleged invention, and the combination was obvious to one of ordinary skill in the art. The
11 combination simply (a) combines prior-art elements according to known methods to yield
12 predictable results; (b) involves the simple substitution of one known element for another to
13 obtain predictable results; (c) involves the use of a known technique to improve similar devices
14 (methods, or products) in the same way; (d) applies a known technique to a known device
15 (method, or product) ready for improvement to yield predictable results; (e) involves
16 combinations of prior-art references that would have been “obvious to try”—a person of ordinary
17 skill in the art could have reached the Asserted Claim by choosing from a finite number of
18 identified, predictable solutions, with a reasonable expectation of success; and/or (f) would have
19 been prompted by known work, based on design incentives or other market forces, because such
20 variations were predictable to one of ordinary skill in the art.

21 Moreover, the Supreme Court has stated that a motivation to combine may be simply
22 “common sense” and that “familiar items may have obvious uses beyond their primary purposes,
23 and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents
24 together like pieces of a puzzle.” *KSR*, 550 U.S. at 420. Indeed, the Supreme Court held that it is
25 sufficient that a combination of elements was “obvious to try,” holding that, “[w]hen there is a
26 design need or market pressure to solve a problem and there are a finite number of identified,
27 predictable solutions, a person of ordinary skill has good reason to pursue the known options
28 within his or her technical grasp.” *Id.* at 421. Here, all the claim elements are common sense and

1 are easily fit together by one of ordinary skill in the art.

2 While not necessary, a motivation to combine may also be found in the references
3 themselves. One of ordinary skill in the art would have been motivated to combine a reference
4 that refers to, or otherwise explicitly invites combination with, another reference. Where the
5 references cited herein have such an explicit invitation to combine, that invitation would have
6 motivated one of ordinary skill in the art to combine any such references.

7 **c. Exemplary Obviousness Combinations**

8 The accompanying claim charts explain how different portions of each prior art reference
9 discloses each limitation of the Asserted Claim. If Finjan argues that any particular prior art
10 reference lacks any feature, a POSITA as of the '633 Patent's priority date would at a minimum
11 have been motivated to modify the reference to include the allegedly missing feature, or to
12 combine it with other references that include that feature, as discussed in the previous section.

13 To the extent Finjan asserts that the prior art in Table 1 does not disclose these claim
14 limitations, it would have been obvious to combine or modify each of the prior art references in
15 Table 1 and Table 2 with one or more prior art references in Table 1 and/or Table 2 to create
16 computer-based methods, systems and products wherein the system comprises distinct software
17 modules, wherein the distinct software modules comprise an information recommunicator and a
18 mobile code executor, and causes mobile protection code to be executed by the mobile code
19 executor at a downloadable-information destination such that one or more operations of the
20 executable code at the destination, if attempted, will be processed by the mobile protection code,
21 as discussed in Abadi, AppletTrap, Arnold, Bond, Bull, Erlingsson, Golan, Hanson, Hashii,
22 Herbert, Ji '348, Lynne, Malkhi, Pandey, Rubin, Shin, Sirer, Tso, VirusWall, and/or the Janus
23 System. Exemplary combinations are provided below but do not limit the potential invalidating
24 combinations disclosed in these contentions or that PAN intends to rely on.

25 To the extent that Finjan argues that the prior art references are missing the causing
26 mobile protection code to be executed by the mobile code executor at a downloadable-
27 information destination element, it would have been obvious to modify those references as
28 described in Abadi, AppletTrap, Arnold, Bond, Bull, Erlingsson, Golan, Hanson, Hashii, Herbert,

1 Ji '348, Lynne, Malkhi, Pandey, Rubin, Shin, Sirer, Tso, VirusWall, and/or the Janus System.
2 One of ordinary skill in the art would have been motivated to combine Abadi, AppletTrap,
3 Arnold, Bond, Bull, Erlingsson, Golan, Hanson, Hashii, Herbert, Ji '348, Lynne, Malkhi, Pandey,
4 Rubin, Shin, Sirer, Tso, VirusWall, and/or the Janus System with one or more other references
5 identified in Table 1 and would have reasonably expected that the combination would achieve the
6 intended purpose. Each reference relates to computer and network security. A person of ordinary
7 skill in the art looking to create improved computer security methods and products would look to
8 consider solutions implemented in other computer security methods and products such as those
9 disclosed in at least Abadi, AppletTrap, Arnold, Bond, Bull, Erlingsson, Golan, Hanson, Hashii,
10 Herbert, Ji '348, Lynne, Malkhi, Pandey, Rubin, Shin, Sirer, Tso, VirusWall, and/or the Janus
11 System and other references as described in PAN's Invalidity Contentions and associated claim
12 charts. A person of ordinary skill in the art looking to solve this problem would review patents,
13 patent publications and prior art systems in the field of computer and network security such as
14 Abadi, AppletTrap, Arnold, Bond, Bull, Erlingsson, Golan, Hanson, Hashii, Herbert, Ji '348,
15 Lynne, Malkhi, Pandey, Rubin, Shin, Sirer, Tso, VirusWall, and/or the Janus System and other
16 references as described in PAN's Invalidity Contentions and associated claim charts.

17 One of ordinary skill in the art also would have reasonably expected that such
18 combination of Abadi, AppletTrap, Arnold, Bond, Bull, Erlingsson, Golan, Hanson, Hashii,
19 Herbert, Ji '348, Lynne, Malkhi, Pandey, Rubin, Shin, Sirer, Tso, VirusWall, and/or the Janus
20 System and other references as described in Table 1 and associated claim charts would achieve
21 the desired structure and functionality of causing mobile protection code to be executed by the
22 mobile code executor at a downloadable-information destination because such a combination
23 would constitute combining prior art elements according to known methods to yield predictable
24 results, and a simple substitution of one known element for another to obtain predictable results.
25 Such a combination also would have been simply applying a known technique to a known method
26 ready for improvement to yield predictable results and would have been obvious to try.

27 PAN reserves the right to rely on additional combinations.
28

1 **4. Patent L.R. 3-3(c) Invalidity Contentions Charts**

2 Pursuant to Patent Local Rule 3-3(c), charts identifying specifically where and how in
3 each alleged item of prior art each limitation of each asserted claim is found are attached as
4 Exhibits D-1 to D-20. Where elements are disclosed at multiple locations within a single item of
5 prior art, PAN has not necessarily identified every iteration of every disclosure.

6 **5. Patent L.R. 3-3(d) Invalidity Based on 35 U.S.C. § 101, Indefiniteness**
7 **Under 35 U.S.C. § 112(2), or Enablement or Written Description**
8 **Under 35 U.S.C. § 112(1)**

9 Based on PAN's present understanding of the Asserted Claim and/or PAN's apparent
10 construction of the claims, as set forth in Finjan's Infringement Contentions, and subject to the
11 reservation of rights above, PAN lists below the grounds upon which the Asserted Claim of the
12 '633 Patent is invalid based on 35 U.S.C. § 101, indefiniteness, lack of written description, and/or
13 lack of enablement under 35 U.S.C. § 112. To the extent PAN's identified grounds for invalidity
14 are based on Finjan's apparent constructions, PAN is not adopting Finjan's apparent
15 constructions, nor is PAN agreeing that any of Finjan's apparent constructions are correct.
16 Moreover, Finjan's deficient Infringement Contentions fail to provide PAN with adequate notice
17 as to Finjan's infringement theories. PAN reserves all rights to advance claim construction
18 positions different from Finjan's apparent constructions.

19 PAN's contentions that the following claims are invalid under 35 U.S.C. § 112 are made
20 in the alternative, and do not constitute, and should not be interpreted as, admissions regarding
21 the construction or scope of the Asserted Claim, or that the Asserted Claim is not anticipated or
22 rendered obvious by any prior art. Where PAN identifies a claim term in an independent claim as
23 being invalid, PAN further contends any asserted dependent claim is invalid based on the
24 presence of the same term.

25 In light of the deficiencies in Finjan's Infringement Contentions, PAN reserves the right to
26 amend, modify, and/or supplement these Contentions to further identify bases for invalidity under
27 35 U.S.C. § 112. PAN's Contentions shall not be construed as an admission that any claim
28 construction advanced by PAN in this case is in any way inconsistent, flawed or erroneous. Nor
should these Contentions prevent PAN from advancing claim construction and/or non-

1 infringement positions in lieu of, or in addition to, invalidity positions. Further, PAN's
 2 Contentions shall not be construed as an admission of or acquiescence to Finjan's purported
 3 construction of the claim language or of other positions advanced by Finjan during the course of
 4 this litigation. PAN's Contentions under 35 U.S.C. § 112 may depend, in part, on the Court's
 5 claim construction, as well as Finjan's asserted claim scope. Consequently, PAN only identifies
 6 herein the issues under 35 U.S.C. § 112 of which it is presently aware based on PAN's present
 7 understanding of the asserted claims and/or Finjan's apparent construction of the claims, as set
 8 forth in Finjan's Infringement Contentions. PAN reserves all rights to advance claim
 9 construction positions different from Finjan's apparent constructions and to amend these
 10 contentions as it better understands Finjan's construction of the claims during the claim
 11 construction process.

12 **a. Unpatentable Subject Matter Under 35 U.S.C. § 101**

13 The Asserted Claim of the '633 Patent is directed to non-statutory subject matter, under 35
 14 U.S.C. § 101, because the claims are directed to merely determining if some receiving
 15 information has executable code and providing mobile protection code in response thereto, which
 16 is an abstract concept. The recitation of generic computer components does not amount to
 17 significantly more than the abstract idea itself. *See CyberSource Corp. v. Retail Decisions, Inc.*,
 18 654 F.3d 1366, 1370 (Fed. Cir. 2011) (reasoning that the use of the Internet to verify a credit card
 19 transaction does not meaningfully add to the abstract idea of verifying the transaction).
 20 Therefore, the Asserted Claim of the '633 Patent is not directed to patent-eligible subject matter
 21 under 35 U.S.C. § 101, and is invalid.

22 **b. Indefiniteness Under 35 U.S.C. § 112(2)**

23 “[A] patent is invalid for indefiniteness if its claims, read in light of the specification
 24 delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those
 25 skilled in the art about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572
 26 U.S. 898, 901 (2014).

27 The following claim limitations of the Asserted Claim are invalid based on indefiniteness.

- 28 • “downloadable-information”

- “downloadable information-destination”
- “mobile protection code”
- Claim 14 is indefinite for claiming mixed statutory classes (i.e., both apparatus and method). *See IPXL Holdings v. Amazon.com, Inc.*, 430 F.3d 1377 (Fed. Cir. 2005):
 - “A computer program product, comprising a computer usable medium having a computer readable program code therein, the computer readable program code adapted to be executed for computer security, the method comprising: providing a system, . . .”

c. Lack of Written Description Under 35 U.S.C. § 112(1)

To satisfy the written description requirement, the description must “clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.” *Ariad Pharm., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (internal citation omitted). The test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date. *Id.*

The test requires an objective inquiry into the four corners of the specification from the perspective of a POSITA. Based on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed. “Whether the written description requirement is satisfied is a fact-based inquiry that will depend on the nature of the claimed invention, and the knowledge of one skilled in the art at the time an invention is made and a patent application is filed.” *Carnegie Mellon Univ. v. Hoffmann La Roche Inc.*, 541 F.3d 1115, 1122 (Fed. Cir. 2008) (internal citation omitted). Actual “possession” or reduction to practice outside of the specification is not enough. Instead, the specification itself must demonstrate possession.

While the written description requirement does not demand any particular form of disclosure, a description that merely renders the invention obvious does not satisfy the requirement. *Lockwood v. Am. Airlines*, 107 F.3d 1565, 1571-72 (Fed. Cir. 1997).

1 Finjan’s apparent claim constructions render the Asserted Claim extremely broad in scope
 2 and well beyond the purported inventions described in the ’633 Patent. Finjan is attempting to
 3 construe the ’633 Patent in an idiosyncratic manner that is entirely inconsistent with the written
 4 specifications and prosecution histories of the ’633 Patent as well as with the understanding of
 5 one of ordinary skill in the art at the time the applications that issued as the ’633 Patent were
 6 filed. These allegations are inconsistent with the plain language of the claims, the supporting
 7 description, and the prosecution history.

8 The following claim limitations of the Asserted Claim are invalid for lack of written
 9 description:

- 10 • “mobile protection code”
- 11 • “downloadable information-destination”

12 **d. Lack of Enablement Under 35 U.S.C. § 112(1)**

13 To satisfy the enablement requirement of 35 U.S.C § 112, the disclosure “must teach those
 14 skilled in the art how to make and use the full scope of the claimed invention without ‘undue
 15 experimentation.’” *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365 (Fed. Cir. 1997)
 16 (citations omitted). Moreover, “[i]t is the specification, not the knowledge of one skilled in the
 17 art, that must supply the novel aspects of [the] invention in order to constitute adequate
 18 enablement.” *Id.* at 1366. The Federal Circuit has enumerated several factors to consider in
 19 determining whether a disclosure would require “undue experimentation”: “(1) the quantity of
 20 experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or
 21 absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the
 22 relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the
 23 breadth of the claims.” *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988).

24 Finjan’s apparent claim constructions render the Asserted Claim extremely broad in scope
 25 and well beyond the purported inventions described in the ’633 Patent. Finjan is attempting to
 26 construe the ’633 Patent in an idiosyncratic manner that is entirely inconsistent with the written
 27 specifications and prosecution histories of the ’633 Patent as well as with the understanding of
 28 one of ordinary skill in the art at the time the applications that issued as the ’633 Patent were

1 filed. These allegations are inconsistent with the plain language of the claims, the supporting
2 description, and the prosecution history.

3 The following claim limitations of the Asserted Claim are invalid for lack of enablement:

- 4 • “mobile protection code”
- 5 • “downloadable information-destination”

6 **E. Invalidity of the ’154 Patent**

7 **1. Priority Date**

8 Finjan alleges that the Asserted Claim of the ’154 Patent is entitled to the priority date of
9 December 12, 2005. Finjan’s Initial Disclosure of Asserted Claims and Infringement
10 Contentions, at 20. Finjan apparently alleges that the Asserted Claims of the ’154 Patent are
11 entitled to the benefit of the filing date of the application that matured into U.S. Patent No.
12 7,757,289, which was filed on December 12, 2005. Finjan, however, failed to properly claim
13 priority to this patent when it filed the application for the ’154 patent. Finjan’s certificate of
14 correction where it claimed that the entire delayed claim to priority was “unintentional” is
15 insufficient to reset the priority date for the ’154 patent to December 12, 2005. Thus, based on
16 the information presently available to PAN, the earliest date to which the ’154 patent may claim
17 priority is June 14, 2010.

18 **2. Patent L.R. 3-3(a) Identification of Prior Art**

19 Subject to the reservations of rights above, PAN identifies prior art that anticipates and/or
20 renders obvious the Asserted Claim of the ’154 Patent. The prior art references identified are also
21 relevant to show the state of the art and reasons and motivations for making improvements,
22 additions, modifications, and combinations.

23 In addition, PAN incorporates the prior art, claims charts, and invalidity theories
24 disclosed, listed and/or asserted by any entity during the course of other litigation (past,
25 present/ongoing, or future) or patent office challenges (either reexaminations or IPRs). Finjan has
26 failed to timely update its production of these materials, which has prejudiced PAN in its
27 preparation of these contentions. PAN reserves the right to rely on any prior art reference, prior
28 art combination, motivation to combine, invalidity theory, and/or materials disclosed in these

other proceedings. At least the following prior art references anticipate and/or render obvious the Asserted Claim of the '154 Patent, and/or illustrate the state of the art at the time of the alleged invention:

a. Patent Prior Art

Ref. No.	Publication No.	Short Name	Filing Date	Publication Date	Priority Date
1.	U.S. Pat. Pub. No. 2005/0108562	"Khazan"	June 18, 2003	May 19, 2005	June 18, 2003
2.	U.S. Pat. No. 5,974,549	"Gilad"	March 27, 1997	October 26, 1999	March 27, 1997
3.	U.S. Pat. No. 5,983,348	"Ji 348"	September 10, 1997	November 9, 1999	September 10, 1997
4.	U.S. Pat. No. 5,623,600	"Ji 600"	September 26, 1995	April 22, 1997	September 26, 1995
5.	U.S. Pat. No. 7,487,540	"Shipp"	August 23, 2004	February 3, 2009	April 25, 2003
6.	U.S. Pat. No. 7,694,328	"Joshi"	October 21, 2004	April 6, 2010	October 21, 2003
7.	U.S. Pat. No. 8,225,392	"Dubrovsky"	July 15, 2005	July 17, 2012	July 15, 2005
8.	U.S. Pat. No. 7,865,961	"Hasegawa"	June 28, 2004	January 4, 2011	February 23, 2004
9.	U.S. Pat. No. 8,244,910	"Davis"	July 14, 2004	August 14, 2012	July 14, 2004
10.	U.S. Pat. No. 8,281,401	"Pennington"	January 24, 2006	October 2, 2012	January 25, 2005
11.	U.S. Pat. Pub. No. 2007/0113282	"Ross"	November 17, 2005	May 17, 2007	November 17, 2005
12.	U.S. Pat. Pub. No. 2009/0193497	"Kikuchi"	November 25, 2008	July 30, 2009	January 25, 2008
13.	U.S. Pat. No. 8,424,090	"Kang"	March 25, 2009	April 16, 2013	July 23, 2008
14.	U.S. Pat. No. 8,522,350	"Davenport"	November 19, 2009	August 27, 2013	November 19, 2008

Ref. No.	Publication No.	Short Name	Filing Date	Publication Date	Priority Date
15.	U.S. Pat. Pub. No. 2008/0083012	“Yu”	June 20, 2007	April 3, 2008	June 20, 2007
16.	U.S. Pat. Pub. No. 2002/0066022	“Calder”	November 29, 2000	May 30, 2002	November 29, 2000
17.	U.S. Pat. No. 7,437,362	“Ben-Natan”	November 25, 2003	October 13, 2008	November 25, 2003
18.	U.S. Pat. No. 8,220,055	“Kennedy”	February 6, 2004	July 10, 2012	February 6, 2004

b. Non-Patent Publication Prior Art

Ref. No.	Publication	Short Name	Publication Date
1.	“Mobile Code Security by Java Bytecode Instrumentation,” 2001	“Chander”	2001
2.	“Flexible Policy-Directed Code Safety,” 1998 Data Fellows Corp.	“Evans”	May 1999
3.	“Java Bytecode Modication and Applet Security”	“Shin”	1998
4.	“Design and implementation of a distributed virtual machine for networked computers”	“Sirer”	December 1999

PAN additionally identifies and relies on each of the additional patent or publication references that describe or are otherwise related to the prior art systems identified below.

c. System or Product Prior Art

PAN sets forth numerous prior art products or systems in the table below. For such prior art products and systems, PAN has identified, based on its current knowledge, approximate dates on which such products were sold, on sale, made, known, and/or used in the U.S. PAN’s investigation of prior art products and systems is ongoing. Further information and/or documents regarding such products and their sale, offer for sale, and use dates will be produced or disclosed as it is (they are) obtained in discovery or otherwise becomes available to PAN. PAN reserves the right to amend, modify, and/or supplement these Contentions based on further and subsequent

investigation and discovery. Additionally, PAN reserves the right to rely on the documents identified below as standalone prior art references separate from the prior art system or product they describe.

PAN additionally identifies and relies on any system, product, or public knowledge or use that embodies or otherwise incorporates any of the prior art patents and publications listed above. PAN reserves the right to identify and rely on systems that represent different versions or are otherwise related variations of the identified products and systems.

Ref No.	System Name	Short Name	Date Made, Known, Used, Sold, or On Sale
1.	InterScan VirusWall	“VirusWall”	1996
2.	InterScan AppletTrap	“AppletTrap”	March 1999
3.	Check Point Firewall-1	“Firewall-1”	1999
4.	Janus System	“Janus System”	1999

(i) InterScan VirusWall

VirusWall was sold, on sale, made, known, and/or used at least by 1996. The features, operations, and functionality of VirusWall are described throughout the VirusWall documentation produced in this case. These documents include:

- TFS00000001 – TFS00005934
- TM-FIN000001 – TM-FIN000563

(ii) InterScan AppletTrap

AppletTrap was sold, on sale, made, known, and/or used at least by March 1999. The features, operations, and functionality of AppletTrap are described throughout the AppletTrap documentation produced in this case. These documents include:

- TFS00000001 – TFS00005934
- TM-FIN000001 – TM-FIN000563

(iii) Check Point Firewall-1

The first version of Firewall-1 was sold, on sale, made, known, and/or used at least by

1993 and other versions were available before 2005. PAN is in progress of obtaining additional information regarding Firewall-1 from Check Point and will update its contentions with respect to Firewall-1.

(iv) Janus System

Janus System was sold, on sale, made, known, and/or used at least by 1999. The features, operations, and functionality of Janus System are described throughout the Janus System documentation produced in this case. These documents include:

- David A. Wagner, “Janus: an Approach for Confinement of Untrusted Applications,” EECS Dept., University of California, Berkeley, Technical Report No. UCB/CSD-99-1056 (1999).

d. 35 U.S.C. § 102(f)

PAN reserves the right to assert that the Asserted Claim are invalid under 35 U.S.C. § 102(f) in the event PAN obtains additional evidence that the inventors named in any of the Asserted Patents did not invent the subject matter claimed therein. Should PAN obtain such evidence, it will provide the name of the person(s) from whom and the circumstances under which the alleged invention or any part of it was derived.

e. 35 U.S.C. § 102(g)

PAN reserves the right to assert that the Asserted Claim is invalid under 35 U.S.C. § 102(g) in the event PAN obtains additional evidence that any of the inventions claimed in the Asserted Patents were made in the United States by another inventor who had not abandoned, suppressed or concealed it, prior to the alleged invention by the applicant of the Asserted Patents. Should PAN obtain such evidence, it will provide the identities of the persons or entities involved in and the circumstances surrounding the making the inventions before the patent applicants.

3. Patent L.R. 3-3(b) Anticipation and Obviousness

The references in Table 1, alone or in combination with the knowledge of one skilled in the art, anticipate or render obvious the Asserted Claim of the '154 Patent.

Table 1: Prior Art References: Anticipation and Primary/Secondary Obviousness

References

Short Name	Prior Art Under	Priority Date	Exemplary Claim Chart
AppletTrap	102(a), (b)	March 1999	F-1
Ross	102(e)	November 17, 2005	F-2
Janus System	102(a), (b)	1999	F-3
Chander	102(a), (b)	2001	F-4
Shipp	102(e)	April 25, 2003	F-5
Sirer	102(a), (b)	December 1999	F-6
Davis	102(a), (e)	July 14, 2004	F-7
Khazan	102(a), (b), (e)	June 18, 2003	F-8

In addition, each of the references in Table 1 above and Table 2 below, either alone, in view of the knowledge of a POSITA, and/or in combination with one or more references in Table 1 or Table 2, renders obvious the Asserted Claim of the '154 Patent.

Table 2: Additional Prior Art References: Obviousness

Short Name	Prior Art Under	Priority Date
InterScan VirusWall	102(a), (b)	1996
Check Point Firewall-1	102(a), (b)	1999
Gilad	102(a), (b), (e)	March 27, 1997
Ji 348	102(a), (b), (e)	September 10, 1997
Ji 600	102(a), (b), (e)	September 26, 1995
Joshi	102(e)	October 21, 2004
Dubrovsky	102(e)	July 15, 2005
Hasegawa	102(e)	June 28, 2004
Pennington	102(e)	January 24, 2006
Kikuchi	102(e)	November 25, 2008
Kang	102(e)	March 25, 2009

Short Name	Prior Art Under	Priority Date
Davenport	102(e)	November 19, 2009
Yu	102(e)	June 20, 2007
Calder	102(a), (b), (e)	November 29, 2000
Ben-Natan	102(a), (b), (e)	November 25, 2003
Kennedy	102(e)	February 6, 2004
Evans	102(a), (b)	May 1999
Shin	102(a), (b)	1998

In addition, PAN incorporates by reference each and every prior art reference of record in the prosecution of the '154 Patent and any related patent or application, the statements made therein by the applicant, as well as the prior art discussed in the specification.

The cited portions of each prior art reference are exemplary and representative of the content of the reference, and should be understood in the context of the reference as a whole, as understood by one of ordinary skill in the art. To the extent a prior art reference is deemed not to anticipate or render obvious a claim as noted in the attached charts for failing to disclose, teach, or suggest one or more limitations of a claim, that claim would nonetheless have been obvious to one of ordinary skill in the art at the time of the alleged invention over the reference itself or by the combination of the reference with one or more other references disclosing the missing claim limitations or the knowledge of a person having ordinary skill in the art.

a. Prior Art Combinations

The Asserted Claim of the '154 Patent is obvious based on one or more combinations of the prior art references above. The sections below provide motivations to combine the prior art references above. These obviousness combinations are provided in the alternative to PAN's anticipation and single-reference obviousness contentions and are not to be construed to suggest that any reference included in the combination is not itself anticipatory or would not render the Asserted Claim obvious in light of the knowledge of a person having ordinary skill in the art. PAN also hereby incorporates by reference the prior art, invalidity grounds, and expert testimony

submitted in connection with any petitions for *inter partes* review of the '154 Patent.

b. Motivation to Combine

A POSITA would have been motivated to combine the preceding references for any number of reasons, such as the following exemplary reasons. Teachings, suggestions, motivations, and/or reasons to modify any of the references and/or to combine any two or more of the references can come from many sources, including the prior art, common knowledge, common sense, predictability, expectations, industry trends, design incentives or need, market demand or pressure, market forces, obviousness to try, the nature of the problem faced, and/or knowledge possessed by a POSITA.

Although a patent claim may be invalidated based on a teaching-suggestion-motivation (“TSM”) rationale—*i.e.*, that some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior-art reference or to combine prior-art reference teachings to arrive at the claimed invention—the Supreme Court identified additional rationales in *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007). The following of these rationales apply here:

(A) the Asserted Claim combines prior-art elements according to known methods to yield predictable results;

(B) the Asserted Claim involves the simple substitution of one known element for another to obtain predictable results;

(C) the Asserted Claim involves the use of a known technique to improve similar devices (methods, or products) in the same way;

(D) the Asserted Claim applies a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) the Asserted Claim involves combinations of prior-art references that would have been “obvious to try”—a person of ordinary skill in the art could have reached the Asserted Claim by choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) the Asserted Claim is simply variations of work from one field of endeavor or a different one that would have been prompted based on design incentives or other market forces because the variations were predictable to one of ordinary skill in the art.

See KSR, 550 U.S. at 415-18 (rejecting the Federal Circuit’s “rigid” application of the teaching, suggestion, or motivation to combine test, and instead espousing an “expansive and flexible”

1 approach). Indeed, the Supreme Court held that a person of ordinary skill in the art is “a person
2 of ordinary creativity, not an automaton” and “in many cases a person of ordinary skill in the art
3 will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *KSR*, 550
4 U.S. at 420-21.

5 Thus, even in the absence of a specific teaching, suggestion, or motivation to combine
6 references, the Asserted Claim here is obvious and therefore invalid. Each of the cited references
7 or devices is in the same field, making it obvious for someone of ordinary skill in the art to
8 identify and combine elements from these references. One of ordinary skill in the art would have
9 recognized that improvements could be achieved by combining or modifying prior-art references
10 that described such improvements. Each of the above prior-art references describes devices or
11 methods that were known to offer such improvements, and, accordingly, one of ordinary skill in
12 the art would have been motivated to combine or modify the references as identified in each of
13 the combinations above.

14 Indeed, given that the references are in the same field, one of ordinary skill would have
15 readily, with predictable results, taken teachings from one reference and applied them to other
16 references. As referenced above, multiple prior art references teach or suggest the concepts
17 claimed in the ’154 Patent. To the extent Finjan argues that any concepts claimed in the
18 ’154 Patent were not contained in any prior art reference, it would, at a minimum, have been
19 obvious to adapt each reference to include the concept or combine it with other references that
20 disclose the concept. In addition, each of the constituent techniques described here was well
21 known to those of ordinary skill in the art, and understood to be among a menu of available
22 design choices for improving network security. This is one of many motivations to combine the
23 above references.

24 Furthermore, because methods and systems related to a computer gateway for an intranet
25 of computers were well known and studied extensively prior to the ’154 Patent priority date,
26 common industry knowledge supplied a reason to combine the above references with each other.
27 Each combination would have produced no unexpected results and would simply represent a
28 known alternative to one of ordinary skill in the art. This is a further motivation to combine any

1 of the above references.

2 The below sections further address particular reasons to combine the above references.
3 The below should not be construed as an admission that there is any value to the alleged invention
4 of the '154 Patent. As discussed previously, these contentions are based largely on how Finjan is
5 apparently construing the Asserted Claim in its Initial Infringement Contentions, which is an
6 incorrect and overbroad interpretation of the alleged invention of the '154 Patent. Accordingly,
7 to the extent the below refers to benefits of certain elements or industry trends towards these
8 elements, this is not an admission that the alleged invention of the '154 Patent provides any
9 benefits—to the contrary, properly construed and compared to the prior art, the '154 Patent
10 provides no benefits. Likewise, to the extent the below refers to substituting elements, this is not
11 an admission that the elements subject to the substitution are in any way similar, *e.g.*, perform the
12 same function, in the same way, to reach the same result.

13 The various elements of the Asserted Claim were well-known in the prior art at the time
14 of the alleged invention, and the combination was obvious to one of ordinary skill in the art. The
15 combination simply (a) combines prior-art elements according to known methods to yield
16 predictable results; (b) involves the simple substitution of one known element for another to
17 obtain predictable results; (c) involves the use of a known technique to improve similar devices
18 (methods, or products) in the same way; (d) applies a known technique to a known device
19 (method, or product) ready for improvement to yield predictable results; (e) involves
20 combinations of prior-art references that would have been “obvious to try”—a person of ordinary
21 skill in the art could have reached the Asserted Claim by choosing from a finite number of
22 identified, predictable solutions, with a reasonable expectation of success; and/or (f) would have
23 been prompted by known work, based on design incentives or other market forces, because such
24 variations were predictable to one of ordinary skill in the art.

25 Moreover, the Supreme Court has stated that a motivation to combine may be simply
26 “common sense” and that “familiar items may have obvious uses beyond their primary purposes,
27 and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents
28 together like pieces of a puzzle.” *KSR*, 550 U.S. at 420. Indeed, the Supreme Court held that it is

1 sufficient that a combination of elements was “obvious to try,” holding that, “[w]hen there is a
 2 design need or market pressure to solve a problem and there are a finite number of identified,
 3 predictable solutions, a person of ordinary skill has good reason to pursue the known options
 4 within his or her technical grasp.” *Id.* at 421. Here, all the claim elements are common sense and
 5 are easily fit together by one of ordinary skill in the art.

6 While not necessary, a motivation to combine may also be found in the references
 7 themselves. One of ordinary skill in the art would have been motivated to combine a reference
 8 that refers to, or otherwise explicitly invites combination with, another reference. Where the
 9 references cited herein have such an explicit invitation to combine, that invitation would have
 10 motivated one of ordinary skill in the art to combine any such references.

11 **c. Exemplary Obviousness Combinations**

12 The accompanying claim charts explain how different portions of each prior art reference
 13 discloses each limitation of the Asserted Claim. If Finjan argues that any particular prior art
 14 reference lacks any feature, a POSITA as of the ’154 Patent’s priority date would at a minimum
 15 have been motivated to modify the reference to include the allegedly missing feature, or to
 16 combine it with other references that include that feature, as discussed in the previous section.

17 To the extent Finjan asserts that the prior art in Table 1 does not disclose these claim
 18 limitations, it would have been obvious to combine or modify each of the prior art references in
 19 Table 1 and Table 2 with one or more prior art references in Table 1 and/or Table 2 to create
 20 computer-based methods, systems and products. Exemplary combinations are provided below
 21 but do not limit the potential invalidating combinations disclosed in these contentions or that
 22 PAN intends to rely on.

23 For example, to the extent Finjan argues that any of AppletTrap, Ross, Janus System,
 24 Chander, Shipp, Sirer, Khazan, and/or Davis do not disclose or suggest the use of modified inputs
 25 as recited in the asserted claims, it would have been obvious to modify the techniques and/or
 26 systems described in these references with the teachings of any of these references or the
 27 references listed in Table 2. For example, this feature is taught in Ben-Natan (*see, e.g.*, 10:37-
 28 48), Davenport (*see, e.g.*, 2:9:38), Calder, and Golan (*see, e.g.*, Abstract, 2:12-27, 6:63-7:9). To

the extent Finjan argues that any of AppletTrap, Ross, Janus System, Chander, Shipp, Sirer, Khazan, and/or Davis do not disclose or suggest the use of modified inputs as recited in the asserted claims, it would have been obvious to modify the techniques and/or systems described in these references with the teachings of any of these references or the references listed in Table 2. For example, this feature is taught in Golan (*see, e.g.*, Abstract, 2:12-27, 6:63-7:9, 9:1-13) and Calder. To the extent Finjan argues that any of AppletTrap, Ross, Janus System, Chander, Shipp, Sirer, Khazan, and/or Davis do not disclose or suggest the use of a security computer, it would have been obvious to modify the techniques and/or systems described in these references with the teachings of any of these references or the references listed in Table 2. For example, this feature is taught in Tso (*see, e.g.*, 3:2-10), Calder, and Golan (*see, e.g.*, Abstract, 2:12-27, 6:63-7:9, 9:1-13).

PAN reserves the right to rely on additional combinations.

4. Patent L.R. 3-3(c) Invalidity Contentions Charts

Pursuant to Patent Local Rule 3-3(c), charts identifying specifically where and how in each alleged item of prior art each limitation of each asserted claim is found are attached as Exhibits F-1 to F-8. Where elements are disclosed at multiple locations within a single item of prior art, PAN has not necessarily identified every iteration of every disclosure.

5. Patent L.R. 3-3(d) Invalidity Based on 35 U.S.C. § 101, Indefiniteness Under 35 U.S.C. § 112(2), or Enablement or Written Description Under 35 U.S.C. § 112(1)

Based on PAN's present understanding of the Asserted Claim and/or PAN's apparent construction of the claims, as set forth in Finjan's Infringement Contentions, and subject to the reservation of rights above, PAN lists below the grounds upon which the Asserted Claim of the '154 Patent is invalid based on 35 U.S.C. § 101, indefiniteness, lack of written description, and/or lack of enablement under 35 U.S.C. § 112. To the extent PAN's identified grounds for invalidity are based on Finjan's apparent constructions, PAN is not adopting Finjan's apparent constructions, nor is PAN agreeing that any of Finjan's apparent constructions are correct. Moreover, Finjan's deficient Infringement Contentions fail to provide PAN with adequate notice as to Finjan's infringement theories. PAN reserves all rights to advance claim construction

positions different from Finjan's apparent constructions.

PAN's contentions that the following claims are invalid under 35 U.S.C. § 112 are made in the alternative, and do not constitute, and should not be interpreted as, admissions regarding the construction or scope of the Asserted Claim, or that the Asserted Claim is not anticipated or rendered obvious by any prior art. Where PAN identifies a claim term in an independent claim as being invalid, PAN further contends any asserted dependent claim is invalid based on the presence of the same term.

In light of the deficiencies in Finjan's Infringement Contentions, PAN reserves the right to amend, modify, and/or supplement these Contentions to further identify bases for invalidity under 35 U.S.C. § 112. PAN's Contentions shall not be construed as an admission that any claim construction advanced by PAN in this case is in any way inconsistent, flawed or erroneous. Nor should these Contentions prevent PAN from advancing claim construction and/or non-infringement positions in lieu of, or in addition to, invalidity positions. Further, PAN's Contentions shall not be construed as an admission of or acquiescence to Finjan's purported construction of the claim language or of other positions advanced by Finjan during the course of this litigation. PAN's Contentions under 35 U.S.C. § 112 may depend, in part, on the Court's claim construction, as well as Finjan's asserted claim scope. Consequently, PAN only identifies herein the issues under 35 U.S.C. § 112 of which it is presently aware based on PAN's present understanding of the asserted claims and/or Finjan's apparent construction of the claims, as set forth in Finjan's Infringement Contentions. PAN reserves all rights to advance claim construction positions different from Finjan's apparent constructions and to amend these contentions as it better understands Finjan's construction of the claims during the claim construction process.

a. Unpatentable Subject Matter Under 35 U.S.C. § 101

The Asserted Claims of the '154 Patent re directed to non-statutory subject matter, under 35 U.S.C. § 101, because the claims are directed to merely determining if some receiving information has executable code and providing mobile protection code in response thereto, which is an abstract concept. The recitation of generic computer components does not amount to

1 significantly more than the abstract idea itself. *See CyberSource Corp. v. Retail Decisions, Inc.*,
 2 654 F.3d 1366, 1370 (Fed. Cir. 2011) (reasoning that the use of the Internet to verify a credit card
 3 transaction does not meaningfully add to the abstract idea of verifying the transaction).
 4 Additionally, claims 1, 2, 7, and 7 are directed to software per se. Therefore, the Asserted Claim
 5 of the '154 Patent is not directed to patent-eligible subject matter under 35 U.S.C. §101, and is
 6 invalid.

7 **b. Indefiniteness Under 35 U.S.C. § 112(2)**

8 “[A] patent is invalid for indefiniteness if its claims, read in light of the specification
 9 delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those
 10 skilled in the art about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572
 11 U.S. 898, 901 (2014). Under Finjan’s apparent interpretation of the asserted claims, the recited
 12 “content received over a network” is the same thing as the “input” that is used with the “first
 13 function call” and the “second function call.” Yet the claims require that the “content” includes
 14 the “input.” Finjan’s contradiction in its application of the asserted claims cause them to be
 15 indefinite. Additionally, the following claim limitations of the Asserted Claim are invalid based
 16 on indefiniteness.

- 17 • “safe”
- 18 • “content”
- 19 • “input”
- 20 • “content processor”
- 21 • “transmitter”
- 22 • “receiver”

23 **c. Lack of Written Description Under 35 U.S.C. § 112(1)**

24 To satisfy the written description requirement, the description must “clearly allow persons
 25 of ordinary skill in the art to recognize that [the inventor] invented what is claimed.” *Ariad*
 26 *Pharm., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (internal citation omitted).
 27 The test for sufficiency is whether the disclosure of the application relied upon reasonably
 28 conveys to those skilled in the art that the inventor had possession of the claimed subject matter

1 as of the filing date. *Id.*

2 The test requires an objective inquiry into the four corners of the specification from the
3 perspective of a POSITA. Based on that inquiry, the specification must describe an invention
4 understandable to that skilled artisan and show that the inventor actually invented the invention
5 claimed. “Whether the written description requirement is satisfied is a fact-based inquiry that will
6 depend on the nature of the claimed invention, and the knowledge of one skilled in the art at the
7 time an invention is made and a patent application is filed.” *Carnegie Mellon Univ. v. Hoffmann*
8 *La Roche Inc.*, 541 F.3d 1115, 1122 (Fed. Cir. 2008) (internal citation omitted). Actual
9 “possession” or reduction to practice outside of the specification is not enough. Instead, the
10 specification itself must demonstrate possession.

11 While the written description requirement does not demand any particular form of
12 disclosure, a description that merely renders the invention obvious does not satisfy the
13 requirement. *Lockwood v. Am. Airlines*, 107 F.3d 1565, 1571-72 (Fed. Cir. 1997). Under
14 Finjan’s apparent interpretation of the Asserted Claims, they are invalid for lacking written
15 description support. Finjan seems to interpret the claims as encompassing receiving “content”
16 that is also “input” for the “first function” and the “second function” that are called with the
17 “input.” But this concept is not disclosed anywhere in the specification.

18 **d. Lack of Enablement Under 35 U.S.C. § 112(1)**

19 To satisfy the enablement requirement of 35 U.S.C § 112, the disclosure “must teach those
20 skilled in the art how to make and use the full scope of the claimed invention without ‘undue
21 experimentation.’” *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365 (Fed. Cir. 1997)
22 (citations omitted). Moreover, “[i]t is the specification, not the knowledge of one skilled in the
23 art, that must supply the novel aspects of [the] invention in order to constitute adequate
24 enablement.” *Id.* at 1366. The Federal Circuit has enumerated several factors to consider in
25 determining whether a disclosure would require “undue experimentation”: “(1) the quantity of
26 experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or
27 absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the
28 relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the

breadth of the claims.” *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988).

Under Finjan’s apparent interpretation of the asserted claims, they are invalid for lacking enablement. Finjan seems to interpret the claims as encompassing receiving “content” that is also “input” for the “first function” and the “second function” that are called with the “input.” But the specification fails to provide any explanation for how a person of ordinary skill in the art could implement a system where the received “content” includes and is the same thing as the “input” used to call the “first function” and the “second function.”

F. Invalidity of the ’408 Patent

1. Priority Date

Finjan alleges that each of the Asserted Claims of the ’408 Patent is entitled to the priority date of August 30, 2004, the filing date of Appl. No. 10/930,884. PAN agrees that the Asserted Claims of the ’408 Patent are not entitled to an earlier priority date.

2. Patent L.R. 3-3(a) Identification of Prior Art

Subject to the reservations of rights above, PAN identifies prior art that anticipates and/or renders obvious the Asserted Claims of the ’408 Patent. The prior art references identified are also relevant to show the state of the art and reasons and motivations for making improvements, additions, modifications, and combinations.

In addition, PAN incorporates the prior art, claims charts, and invalidity theories disclosed, listed and/or asserted by any entity during the course of other litigation (past, present/ongoing, or future) or patent office challenges (either reexaminations or IPRs). Finjan has failed to timely update its production of these materials, which has prejudiced PAN in its preparation of these contentions. PAN reserves the right to rely on any prior art reference, prior art combination, motivation to combine, invalidity theory, and/or materials disclosed in these other proceedings. At least the following prior art references anticipate and/or render obvious the Asserted Claims of the ’408 Patent, and/or illustrate the state of the art at the time of the alleged invention:

a. Patent Prior Art

Ref. No.	Publication No.	Short Name	Filing Date	Publication Date	Priority Date
1.	U.S. Patent No. 6,636,945	“Chandnani”	July 14, 2000	December 22, 2009	July 14, 2000
2.	U.S. Provisional Application No. 60/156,872	“Huang”	September 30, 1999	November 22, 2005	September 30, 1999
3.	U.S. Patent No. 5,860,011	“Kolawa”	February 29, 1996	January 12, 1999	February 29, 1996
4.	U.S. Patent No. 7,398,553	“Li”	October 30, 2000	July 8, 2008	October 30, 2000
5.	U.S. Patent 6,128,774	“Necula”	October 28, 1997	October 3, 2000	October 28, 1997
6.	U.S. Patent No. 7,284,274	“Walls”	January 18, 2001	October 16, 2007	January 18, 2001
7.	U.S. Patent Application 2005/0198692 A1	“Zurko”	March 2, 2004	September 8, 2005	March 2, 2004
8.	U.S. Patent No. 6,571,338	“Shaio”	December 20, 1995	May 27, 2003	December 20, 1995
9.	U.S. Patent No. 6,269,447	“Maloney”	July 19, 1999	July 31, 2001	July 21, 1998

b. Non-Patent Publication Prior Art

Ref. No.	Publication	Short Name	Publication Date
1.	Matt Bishop, “A Taxonomy of UNIX System and Network Vulnerabilities,” May 1995	“Bishop”	May 1995
2.	“F-SCRIPT F-Secure Script Viruses Script Viruses Detector and Eliminator Version 1.6,” 1998 Data Fellows Corp.	“F-Script”	1998
3.	Thomas Reps, Tim Teitelbaum, Alan Demers, “Incremental Context-Dependent Analysis for Language-Based Editors,” 1983	“Reps”	1983

PAN additionally identifies and relies on each of the additional patent or publication

references that describe or are otherwise related to the prior art systems identified below.

c. System or Product Prior Art

PAN sets forth numerous prior art products or systems in the table below. For such prior art products and systems, PAN has identified, based on its current knowledge, approximate dates on which such products were sold, on sale, made, known, and/or used in the U.S. PAN's investigation of prior art products and systems is ongoing. Further information and/or documents regarding such products and their sale, offer for sale, and use dates will be produced or disclosed as it is (they are) obtained in discovery or otherwise becomes available to PAN. PAN reserves the right to amend, modify, and/or supplement these Contentions based on further and subsequent investigation and discovery. Additionally, PAN reserves the right to rely on the documents identified below as standalone prior art references separate from the prior art system or product they describe.

PAN additionally identifies and relies on any system, product, or public knowledge or use that embodies or otherwise incorporates any of the prior art patents and publications listed above. PAN reserves the right to identify and rely on systems that represent different versions or are otherwise related variations of the identified products and systems.

Ref No.	System Name	Short Name	Date Made, Known, Used, Sold, or On Sale
1.	Privoxy System	"Privoxy"	January 31, 2004
2.	JSLint	"JSLint"	March 17, 2003
3.	Bison	"Bison"	1988
4.	Flex	"Flex"	March 1995

(i) Privoxy

Privoxy was sold, on sale, made, known, and/or used at least by January 31, 2004. The features, operations, and functionality of Privoxy are described throughout the Privoxy documentation produced in this case. These documents include:

- 1 • Privoxy 3.0.3 User Manual, doc/webserver/user-manual, available as part of
- 2 privoxy_3.0.3.orig.tar.gz (downloaded from
- 3 <https://sourceforge.net/projects/ijbswa/files/Debian/3.0.3%20%28stable%29%20woody>)
- 4 (PAN_FIN00118281)project.h (PAN_FIN00103579 to PAN_FIN00103603) (native also
- 5 available as part of privoxy_3.0.3.orig.tar.gz)
- 6 • filters.c (PAN_FIN00103532 to PAN_FIN00103559) (native also available as part of
- 7 privoxy_3.0.3.orig.tar.gz)
- 8 • pcrs.c (PAN_FIN00103560 to PAN_FIN00103575) (native available as part of
- 9 privoxy_3.0.3.orig.tar.gz)
- 10 • pcrs.h (PAN_FIN00103576 to PAN_FIN00103578) (native available as part of
- 11 privoxy_3.0.3.orig.tar.gz)

12 (ii) JSLint

13 JSLint was sold, on sale, made, known, and/or used at least by March 17, 2003. The

14 features, operations, and functionality of JSLint are described throughout the JSLint

15 documentation produced in this case. These documents include:

- 16 • JSLINT, The JavaScript Verifier (PAN_FIN00103666 to PAN_FIN00103671)
- 17 • fulljsling.js (PAN_FIN00103638 to PAN_FIN00103664)
- 18 • JavaScript Lint (PAN_FIN00103665)
- 19 • Top Down Operator Precedence (PAN_FIN00103672 to PAN_FIN00103685)

20 (iii) Bison

21 Bison was sold, on sale, made, known, and/or used at least by 1988. The features,

22 operations, and functionality of Bison are described throughout the Bison documentation

23 produced in this case. These documents include:

- 24 • Bison 3.7.6 Manual (PAN_FIN00103687 to PAN_FIN00104010)
- 25 • Bison 1.35 Manual (PAN_FIN00142988 to PAN_FIN00143074)
- 26 • Bison 1.35 Table of Contents (PAN_FIN00142987)
- 27 • Flex and Bison (PAN_FIN00118282 to PAN_FIN00118291)
- 28

(iv) Flex

Flex was sold, on sale, made, known, and/or used at least by March 1995. The features, operations, and functionality of Flex are described throughout the Flex documentation produced in this case. These documents include:

- Flex Manual (PAN_FIN00104011 to PAN_FIN00104048)
- Flex and Bison (PAN_FIN00118282 to PAN_FIN00118291)

d. 35 U.S.C. § 102(f)

PAN reserves the right to assert that the Asserted Claims are invalid under 35 U.S.C. § 102(f) in the event PAN obtains additional evidence that the inventors named in any of the Asserted Patents did not invent the subject matter claimed therein. Should PAN obtain such evidence, it will provide the name of the person(s) from whom and the circumstances under which the alleged invention or any part of it was derived.

e. 35 U.S.C. § 102(g)

PAN reserves the right to assert that the Asserted Claims are invalid under 35 U.S.C. § 102(g) in the event PAN obtains additional evidence that any of the inventions claimed in the Asserted Patents were made in the United States by another inventor who had not abandoned, suppressed or concealed it, prior to the alleged invention by the applicant of the Asserted Patents. Should PAN obtain such evidence, it will provide the identities of the persons or entities involved in and the circumstances surrounding the making the inventions before the patent applicants.

3. Patent L.R. 3-3(b) Anticipation and Obviousness

The references in Table 1, alone or in combination with the knowledge of one skilled in the art, anticipate or render obvious the Asserted Claims of the '408 Patent.

Table 1: Prior Art References: Anticipation and Primary/Secondary Obviousness**References**

Short Name	Prior Art Under	Priority Date	Exemplary Claim Chart
Bishop	102(a), (b)	May 1995	E-11
Chandnani	102(a), (b), (e)	July 14, 2000	E-8

Short Name	Prior Art Under	Priority Date	Exemplary Claim Chart
F-Script	102(a), (b)	1998	E-10
Huang	102(a), (b), (e)	September 30, 1999	E-9
JSLint	102(a), (b)	2002	E-2
Kolawa	102(a), (b), (e)	February 29, 1996	E-7
Li	102(a), (b), (e)	October 30, 2000	E-5
Necula	102(a), (b), (e)	October 28, 1997	E-6
Privoxy	102(a)	January 31, 2004	E-1
Reps	102(a), (b)	1983	E-12
Walls	102(a), (b), (e)	January 18, 2001	E-13
Zurko	102(a), (e)	March 2, 2004	E-4

In addition, each of the references in Table 1 above and Table 2 below, either alone, in view of the knowledge of a POSITA, and/or in combination with one or more references in Table 1 or Table 2, renders obvious the Asserted Claims of the '408 Patent.

Table 2: Additional Prior Art References: Obviousness

Short Name	Prior Art Under	Priority Date
Shaio	102(a), (e)	December 20, 1995
Maloney	102(a), (e)	July 21, 1998

In addition, PAN incorporates by reference each and every prior art reference of record in the prosecution of the '408 Patent and any related patent or application, the statements made therein by the applicant, as well as the prior art discussed in the specification.

The cited portions of each prior art reference are exemplary and representative of the content of the reference, and should be understood in the context of the reference as a whole, as understood by one of ordinary skill in the art. To the extent a prior art reference is deemed not to anticipate or render obvious a claim as noted in the attached charts for failing to disclose, teach,

1 or suggest one or more limitations of a claim, that claim would nonetheless have been obvious to
 2 one of ordinary skill in the art at the time of the alleged invention over the reference itself or by
 3 the combination of the reference with one or more other references disclosing the missing claim
 4 limitations or the knowledge of a person having ordinary skill in the art.

5 **a. Prior Art Combinations**

6 All of the Asserted Claims of the '408 Patent are obvious based on one or more
 7 combinations of the prior art references above. The sections below provide motivations to
 8 combine the prior art references above. These obviousness combinations are provided in the
 9 alternative to PAN's anticipation and single-reference obviousness contentions and are not to be
 10 construed to suggest that any reference included in the combination is not itself anticipatory or
 11 would not render the Asserted Claims obvious in light of the knowledge of a person having
 12 ordinary skill in the art. PAN also hereby incorporates by reference the prior art, invalidity
 13 grounds, and expert testimony submitted in connection with any petitions for *inter partes* review
 14 of the '408 Patent.

15 **b. Motivation to Combine**

16 A POSITA would have been motivated to combine the preceding references for any
 17 number of reasons, such as the following exemplary reasons. Teachings, suggestions,
 18 motivations, and/or reasons to modify any of the references and/or to combine any two or more of
 19 the references can come from many sources, including the prior art, common knowledge,
 20 common sense, predictability, expectations, industry trends, design incentives or need, market
 21 demand or pressure, market forces, obviousness to try, the nature of the problem faced, and/or
 22 knowledge possessed by a POSITA.

23 Although a patent claim may be invalidated based on a teaching-suggestion-motivation
 24 ("TSM") rationale—*i.e.*, that some teaching, suggestion, or motivation in the prior art that would
 25 have led one of ordinary skill to modify the prior-art reference or to combine prior-art reference
 26 teachings to arrive at the claimed invention—the Supreme Court identified additional rationales
 27 in *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007). The following of these rationales apply
 28 here:

1 (A) the Asserted Claims combine prior-art elements according to known methods
2 to yield predictable results;

3 (B) the Asserted Claims involve the simple substitution of one known element for
4 another to obtain predictable results;

5 (C) the Asserted Claims involve the use of a known technique to improve similar
6 devices (methods, or products) in the same way;

7 (D) the Asserted Claims apply a known technique to a known device (method, or
8 product) ready for improvement to yield predictable results;

9 (E) the Asserted Claims involve combinations of prior-art references that would
10 have been “obvious to try”—a person of ordinary skill in the art could have
11 reached the Asserted Claims by choosing from a finite number of identified,
12 predictable solutions, with a reasonable expectation of success;

13 (F) the Asserted Claims are simply variations of work from one field of endeavor
14 or a different one that would have been prompted based on design incentives or
15 other market forces because the variations were predictable to one of ordinary skill
16 in the art.

17 *See KSR*, 550 U.S. at 415-18 (rejecting the Federal Circuit’s “rigid” application of the teaching,
18 suggestion, or motivation to combine test, and instead espousing an “expansive and flexible”
19 approach). Indeed, the Supreme Court held that a person of ordinary skill in the art is “a person
20 of ordinary creativity, not an automaton” and “in many cases a person of ordinary skill in the art
21 will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *KSR*, 550
22 U.S. at 420-21.

23 Thus, even in the absence of a specific teaching, suggestion, or motivation to combine
24 references, the Asserted Claims here are obvious and therefore invalid. Each of the cited
25 references or devices is in the same field, making it obvious for someone of ordinary skill in the
26 art to identify and combine elements from these references. One of ordinary skill in the art would
27 have recognized that improvements could be achieved by combining or modifying prior-art
28 references that described such improvements. Each of the above prior-art references describes
29 devices or methods that were known to offer such improvements, and, accordingly, one of
30 ordinary skill in the art would have been motivated to combine or modify the references as
31 identified in each of the combinations above.

32 Indeed, given that the references are in the same field, one of ordinary skill would have
33 readily, with predictable results, taken teachings from one reference and applied them to other

1 references. As referenced above, multiple prior art references teach or suggest the concepts
2 claimed in the '408 Patent. To the extent Finjan argues that any concepts claimed in the
3 '408 Patent were not contained in any prior art reference, it would, at a minimum, have been
4 obvious to adapt each reference to include the concept or combine it with other references that
5 disclose the concept. In addition, each of the constituent techniques described here was well
6 known to those of ordinary skill in the art, and understood to be among a menu of available
7 design choices for improving network security. This is one of many motivations to combine the
8 above references.

9 Furthermore, because methods and systems related to a computer gateway for an intranet
10 of computers were well known and studied extensively prior to the '408 Patent priority date,
11 common industry knowledge supplied a reason to combine the above references with each other.
12 Each combination would have produced no unexpected results and would simply represent a
13 known alternative to one of ordinary skill in the art. This is a further motivation to combine any
14 of the above references.

15 The below sections further address particular reasons to combine the above references.
16 The below should not be construed as an admission that there is any value to the alleged invention
17 of the '408 Patent. As discussed previously, these contentions are based largely on how Finjan is
18 apparently construing the Asserted Claims in its Initial Infringement Contentions, which is an
19 incorrect and overbroad interpretation of the alleged invention of the '408 Patent. Accordingly,
20 to the extent the below refers to benefits of certain elements or industry trends towards these
21 elements, this is not an admission that the alleged invention of the '408 Patent provides any
22 benefits—to the contrary, properly construed and compared to the prior art, the '408 Patent
23 provides no benefits. Likewise, to the extent the below refers to substituting elements, this is not
24 an admission that the elements subject to the substitution are in any way similar, *e.g.*, perform the
25 same function, in the same way, to reach the same result.

26 The various elements of the Asserted Claims were well-known in the prior art at the time
27 of the alleged invention, and the combination was obvious to one of ordinary skill in the art. The
28 combination simply (a) combines prior-art elements according to known methods to yield

1 predictable results; (b) involves the simple substitution of one known element for another to
 2 obtain predictable results; (c) involves the use of a known technique to improve similar devices
 3 (methods, or products) in the same way; (d) applies a known technique to a known device
 4 (method, or product) ready for improvement to yield predictable results; (e) involves
 5 combinations of prior-art references that would have been “obvious to try”—a person of ordinary
 6 skill in the art could have reached the Asserted Claims by choosing from a finite number of
 7 identified, predictable solutions, with a reasonable expectation of success; and/or (f) would have
 8 been prompted by known work, based on design incentives or other market forces, because such
 9 variations were predictable to one of ordinary skill in the art.

10 Moreover, the Supreme Court has stated that a motivation to combine may be simply
 11 “common sense” and that “familiar items may have obvious uses beyond their primary purposes,
 12 and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents
 13 together like pieces of a puzzle.” *KSR*, 550 U.S. at 420. Indeed, the Supreme Court held that it is
 14 sufficient that a combination of elements was “obvious to try,” holding that, “[w]hen there is a
 15 design need or market pressure to solve a problem and there are a finite number of identified,
 16 predictable solutions, a person of ordinary skill has good reason to pursue the known options
 17 within his or her technical grasp.” *Id.* at 421. Here, all the claim elements are common sense and
 18 are easily fit together by one of ordinary skill in the art.

19 While not necessary, a motivation to combine may also be found in the references
 20 themselves. One of ordinary skill in the art would have been motivated to combine a reference
 21 that refers to, or otherwise explicitly invites combination with, another reference. Where the
 22 references cited herein have such an explicit invitation to combine, that invitation would have
 23 motivated one of ordinary skill in the art to combine any such references.

24 **c. Exemplary Obviousness Combinations**

25 The accompanying claim charts explain how different portions of each prior art reference
 26 discloses each limitation of the Asserted Claim. If Finjan argues that any particular prior art
 27 reference lacks any feature, a POSITA as of the ’408 Patent’s priority date would at a minimum
 28 have been motivated to modify the reference to include the allegedly missing feature, or to

1 combine it with other references that include that feature, as discussed in the previous section.

2 To the extent Finjan asserts that the prior art in Table 1 does not disclose these claim
3 limitations, it would have been obvious to combine or modify each of the prior art references in
4 Table 1 and Table 2 with one or more prior art references in Table 1 and/or Table 2 to create
5 computer-based methods, systems and products for scanning content, including identifying tokens
6 within an incoming byte stream, the tokens being lexical constructs for a specific language,
7 identifying patterns of tokens, generating a parse tree for the identified patens, and identifying the
8 presence of potential exploits within the parse tree, as discussed in Bishop, Chandnani, F-Script,
9 Huang, Kolawa, Li, Necula, Privoxy, Reps, Walls, and Zurko. One of ordinary skill in the art
10 would have been motivated to combine Bishop, Chandnani, F-Script, Huang, Kolawa, Li, Necula,
11 Privoxy, Reps, Walls, and Zurko with one or more other references identified in Table 1 and
12 would have reasonably expected that the combination would achieve the intended purpose. Each
13 reference relates to computer and network security. A person of ordinary skill in the art looking
14 to create improved computer security methods and products would look to consider solutions
15 implemented in other computer security methods and products such as those disclosed in at least
16 Bishop, Chandnani, F-Script, Huang, Kolawa, Li, Necula, Privoxy, Reps, Walls, and/or Zurko
17 and other references as described in PAN's Invalidity Contentions and associated claim charts. A
18 person of ordinary skill in the art looking to solve this problem would review patents, patent
19 publications and prior art systems in the field of computer and network security such as Bishop,
20 Chandnani, F-Script, Huang, Kolawa, Li, Necula, Privoxy, Reps, Walls, and/or Zurko and other
21 references as described in PAN's Invalidity Contentions and associated claim charts. Exemplary
22 combinations are provided below but do not limit the potential invalidating combinations
23 disclosed in these contentions or that PAN intends to rely on.

24 To the extent that Finjan argues that the prior art references in Table 1 do not satisfy the
25 parser and analyzer rules limitations, it would have been obvious to a person of ordinary skill in
26 the art to modify or combine those references with another open-source tool, such as Bison, Flex,
27 and/or JSLint to create a scanner comprising parser and analyzer rules for a specific programming
28 language. Such a combination would have been simply applying a known technique to a known

1 method ready for improvement to yield predictable results and would have been obvious to try.

2 To the extent Finjan argues that the prior art references do not satisfy the dynamically
 3 building and dynamically detecting limitations, it would have been obvious to modify these
 4 references to dynamically build a parse tree and dynamically detect combinations and nodes in
 5 the parse tree which are indicators of potential exploits, as described in Bishop, Chandnani, F-
 6 Script, Huang, Kolawa, Li, Necula, Privoxy, Reps, Walls, and Zurko. One of ordinary skill in the
 7 art also would have reasonably expected that such a combination would achieve the desired
 8 structure and functionality of scanning content, including identifying tokens within an incoming
 9 byte stream, the tokens being lexical constructs for a specific language, identifying patterns of
 10 tokens, generating a parse tree for the identified patens, and identifying the presence of potential
 11 exploits within the parse tree, as discussed in Bishop, Chandnani, F-Script, Huang, Kolawa, Li,
 12 Necula, Privoxy, Reps, Walls, and Zurko, and would constitute combining prior art elements
 13 according to known methods to yield predictable results, and a simple substitution of one known
 14 element for another to obtain predictable results. Such a combination also would have been
 15 simply applying a known technique to a known method ready for improvement to yield
 16 predictable results and would have been obvious to try.

17 PAN reserves the right to rely on additional combinations.

18 **4. Patent L.R. 3-3(c) Invalidity Contentions Charts**

19 Pursuant to Patent Local Rule 3-3(c), charts identifying specifically where and how in
 20 each alleged item of prior art each limitation of each asserted claim is found are attached as
 21 Exhibits E-1 to E-13. Where elements are disclosed at multiple locations within a single item of
 22 prior art, PAN has not necessarily identified every iteration of every disclosure.

23 **5. Patent L.R. 3-3(d) Invalidity Based on 35 U.S.C. § 101, Indefiniteness** 24 **Under 35 U.S.C. § 112(2), or Enablement or Written Description** **Under 35 U.S.C. § 112(1)**

25 Based on PAN's present understanding of the Asserted Claim and/or PAN's apparent
 26 construction of the claims, as set forth in Finjan's Infringement Contentions, and subject to the
 27 reservation of rights above, PAN lists below the grounds upon which the Asserted Claims of the
 28 '408 Patent are invalid based on indefiniteness, lack of written description, and/or lack of

1 enablement under 35 U.S.C. § 112. To the extent PAN's identified grounds for invalidity are
2 based on Finjan's apparent constructions, PAN is not adopting Finjan's apparent constructions,
3 nor is PAN agreeing that any of Finjan's apparent constructions are correct. Moreover, Finjan's
4 deficient Infringement Contentions fail to provide PAN with adequate notice as to Finjan's
5 infringement theories. PAN reserves all rights to advance claim construction positions different
6 from Finjan's apparent constructions.

7 PAN's contentions that the following claims are invalid under 35 U.S.C. § 112 are made
8 in the alternative, and do not constitute, and should not be interpreted as, admissions regarding
9 the construction or scope of the Asserted Claims, or that any of the Asserted Claims are not
10 anticipated or rendered obvious by any prior art. Where PAN identifies a claim term in an
11 independent claim as being invalid, PAN further contends any asserted dependent claim is invalid
12 based on the presence of the same term.

13 In light of the deficiencies in Finjan's Infringement Contentions, PAN reserves the right to
14 amend, modify, and/or supplement these Contentions to further identify bases for invalidity under
15 35 U.S.C. § 112. PAN's Contentions shall not be construed as an admission that any claim
16 construction advanced by PAN in this case is in any way inconsistent, flawed or erroneous. Nor
17 should these Contentions prevent PAN from advancing claim construction and/or non-
18 infringement positions in lieu of, or in addition to, invalidity positions. Further, PAN's
19 Contentions shall not be construed as an admission of or acquiescence to Finjan's purported
20 construction of the claim language or of other positions advanced by Finjan during the course of
21 this litigation. PAN's Contentions under 35 U.S.C. § 112 may depend, in part, on the Court's
22 claim construction, as well as Finjan's asserted claim scope. Consequently, PAN only identifies
23 herein the issues under 35 U.S.C. § 112 of which it is presently aware based on PAN's present
24 understanding of the asserted claims and/or Finjan's apparent construction of the claims, as set
25 forth in Finjan's Infringement Contentions. PAN reserves all rights to advance claim
26 construction positions different from Finjan's apparent constructions and to amend these
27 contentions as it better understands Finjan's construction of the claims during the claim
28 construction process.

a. Indefiniteness Under 35 U.S.C. § 112(2)

“[A] patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014).

The following claim limitations of the Asserted Claims are invalid based on indefiniteness.

- “programming language”
- “instantiating, by the computer, a scanner for the specific programming language, in response to said determining”
- “wherein the analyzer rules identify certain combinations of tokens and patterns”

b. Lack of Written Description Under 35 U.S.C. § 112(1)

To satisfy the written description requirement, the description must “clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.” *Ariad Pharm., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (internal citation omitted). The test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date. *Id.*

The test requires an objective inquiry into the four corners of the specification from the perspective of a POSITA. Based on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed. “Whether the written description requirement is satisfied is a fact-based inquiry that will depend on the nature of the claimed invention, and the knowledge of one skilled in the art at the time an invention is made and a patent application is filed.” *Carnegie Mellon Univ. v. Hoffmann La Roche Inc.*, 541 F.3d 1115, 1122 (Fed. Cir. 2008) (internal citation omitted). Actual “possession” or reduction to practice outside of the specification is not enough. Instead, the specification itself must demonstrate possession.

While the written description requirement does not demand any particular form of

disclosure, a description that merely renders the invention obvious does not satisfy the requirement. *Lockwood v. Am. Airlines*, 107 F.3d 1565, 1571-72 (Fed. Cir. 1997).

Finjan’s apparent claim constructions render the Asserted Claims extremely broad in scope and well beyond the purported inventions described in the ’408 Patent. Finjan is attempting to construe the ’408 Patent in an idiosyncratic manner that is entirely inconsistent with the written specifications and prosecution histories of the ’408 Patent as well as with the understanding of one of ordinary skill in the art at the time the applications that issued as the ’408 Patent were filed. These allegations are inconsistent with the plain language of the claims, the supporting description, and the prosecution history.

The following claim limitations of the Asserted Claims are invalid for lack of written description:

- “wherein the analyzer rules identify certain combinations of tokens and patterns”
- “dynamically building, while said receiving receives the incoming stream, a parse tree whose nodes represent tokens and patterns in accordance with the parser rules”
- “dynamically detecting, while said dynamically building builds the parse tree, combinations of nodes in the parse tree which are indicator of potential exploits, based on the analyzer rules”

c. Lack of Enablement Under 35 U.S.C. § 112(1)

To satisfy the enablement requirement of 35 U.S.C § 112, the disclosure “must teach those skilled in the art how to make and use the full scope of the claimed invention without ‘undue experimentation.’” *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365 (Fed. Cir. 1997) (citations omitted). Moreover, “[i]t is the specification, not the knowledge of one skilled in the art, that must supply the novel aspects of [the] invention in order to constitute adequate enablement.” *Id.* at 1366. The Federal Circuit has enumerated several factors to consider in determining whether a disclosure would require “undue experimentation”: “(1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the

1 relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the
2 breadth of the claims.” *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988).

3 Finjan’s apparent claim constructions render the Asserted Claims extremely broad in
4 scope and well beyond the purported inventions described in the ’408 Patent. Finjan is
5 attempting to construe the ’408 Patent in an idiosyncratic manner that is entirely inconsistent with
6 the written specifications and prosecution histories of the ’408 Patent as well as with the
7 understanding of one of ordinary skill in the art at the time the applications that issued as the
8 ’408 Patent were filed. These allegations are inconsistent with the plain language of the claims,
9 the supporting description, and the prosecution history.

10 The following claim limitations of the Asserted Claims are invalid for lack of enablement:

- 11 • “wherein the analyzer rules identify certain combinations of tokens and patterns”
- 12 • “dynamically building, while said receiving receives the incoming stream, a parse
13 tree whose nodes represent tokens and patterns in accordance with the parser
14 rules”
- 15 • “dynamically detecting, while said dynamically building builds the parse tree,
16 combinations of nodes in the parse tree which are indicator of potential exploits,
17 based on the analyzer rules”

18 **G. Invalidity of the ’494 Patent**

19 **1. Priority Date**

20 Finjan alleges that each of the Asserted Claims of the ’494 Patent is entitled to a priority
21 date of November 8, 1996. Finjan’s Initial Disclosure of Asserted Claims and Infringement
22 Contentions, at 20. The ’494 Patent purports to claim priority to that date via U.S. Patent No.
23 7,613,926, which claims priority to November 6, 1997—the filing date of U.S. Patent No.
24 6,092,194—at the earliest. Moreover, the ’494 Patent purports to claim priority to November 8,
25 1996, via U.S. Patent No. 7,058,822, which claims priority to March 30, 2000, at the earliest.
26 Any priority claim of the ’494 Patent to a date earlier than March 30, 2000, is ineffective. *See*
27 *Medtronic Corevalve v. Edwards Lifesciences Corp.*, 741 F.3d 1359, 1362 (Fed. Cir. 2014) (“To
28 claim priority to International Application 2b, each intermediate application must recite every

intervening application before it all the way back to International Application 2b.”) Finjan has not established that any Asserted Claims of the ’494 Patent are entitled to a priority date earlier than March 30, 2000. However, as described below, the Asserted Claims are invalid even under Finjan’s alleged priority date.

2. Patent L.R. 3-3(a) Identification of Prior Art

Subject to the reservations of rights above, PAN identifies prior art that anticipates and/or renders obvious the Asserted Claims of the ’494 Patent. The prior art references identified are also relevant to show the state of the art and reasons and motivations for making improvements, additions, modifications, and combinations.

In addition, PAN incorporates the prior art, claims charts, and invalidity theories disclosed, listed and/or asserted by any entity during the course of other litigation (past, present/ongoing, or future) or patent office challenges (either reexaminations or IPRs). Finjan has failed to timely update its production of these materials, which has prejudiced PAN in its preparation of these contentions. PAN reserves the right to rely on any prior art reference, prior art combination, motivation to combine, invalidity theory, and/or materials disclosed in these other proceedings. At least the following prior art references anticipate and/or render obvious the Asserted Claims of the ’494 Patent, and/or illustrate the state of the art at the time of the alleged invention:

a. Patent Prior Art

Ref. No.	Publication No.	Short Name	Filing Date	Publication Date	Priority Date
1.	U.S. 5,757,915	Aucsmith	August 25, 1995	May 26, 1998	August 25, 1995
2.	U.S. 5,983,348	Ji ’348	September 10, 1997	November 9, 1999	September 10, 1997
3.	U.S. 5,623,600	Ji ’600	September 6, 1995	April 22, 1997	September 6, 1995
4.	W.O. 98/21683	Touboul ’683	November 6, 1997	May 22, 1998	May 22, 1998

Ref. No.	Publication No.	Short Name	Filing Date	Publication Date	Priority Date
5.	W.O. 99/35583	Touboul '583	December 16, 1998	July 15, 1999	July 15, 1999
6.	U.S. 6,367,012	Atkinson	December 6, 1996	April 2, 2002	December 6, 1996
7.	U.S. 6,067,575	McManis	December 8, 1995	May 23, 2000	December 8, 1995
8.	U.S. 6,128,774	Necula	October 28, 1997	October 3, 2000	October 28, 1997
9.	U.S. 6,092,147	Levy '147	April 15, 1997	July 18, 2000	April 15, 1997
10.	U.S. 6,622,247	Isaak '247	December 19, 1997	September 16, 2003	December 19, 1997
11.	U.S. 6,253,370	Abadi '370	December 1, 1997	January 26, 2001	December 1, 1997
12.	U.S. 5,283,830	Hinsley '830	September 30, 1992	February 1, 1994	September 30, 1992
13.	U.S. 6,357,008	Nachenberg '008	September 23, 1997	March 12, 2002	September 23, 1997

b. Non-Patent Publication Prior Art

Ref. No.	Publication	Short Name	Publication Date
1.	Dr. Solomon's Virus Encyclopedia	DSVE	1995
2.	MiSFIT: A Freely Available Tool for Building Safe Extensible Systems	MiSFIT	1996
3.	Trust Management for the World Wide Web	Chu	June 13, 1997
4.	Encapsulating Mobile Objects	Härtig	1997
5.	A Flexible Security Model for Using Internet Content	Islam	October 1997
6.	An Immune System for Cyberspace	Kephart	1997
7.	MIME Encapsulation	Bahreman	June 13, 1996

Ref. No.	Publication	Short Name	Publication Date
8.	Int'l. Publ. No. WO 95/33237	Schnurer	December 7, 1995
9.	Blocking Applets at the Firewall	Martin	February 10, 1997
10.	Dynamic Detection and Classification of Computer Viruses Using General Behavior Patterns	Swimmer	September 1995

PAN additionally identifies and relies on each of the additional patent or publication references that describe or are otherwise related to the prior art systems identified below.

c. System or Product Prior Art

PAN sets forth numerous prior art products or systems in the table below. For such prior art products and systems, PAN has identified, based on its current knowledge, approximate dates on which such products were sold, on sale, made, known, and/or used in the U.S. PAN's investigation of prior art products and systems is ongoing. Further information and/or documents regarding such products and their sale, offer for sale, and use dates will be produced or disclosed as it is (they are) obtained in discovery or otherwise becomes available to PAN. PAN reserves the right to amend, modify, and/or supplement these Contentions based on further and subsequent investigation and discovery. Additionally, PAN reserves the right to rely on the documents identified below as standalone prior art references separate from the prior art system or product they describe.

PAN additionally identifies and relies on any system, product, or public knowledge or use that embodies or otherwise incorporates any of the prior art patents and publications listed above. PAN reserves the right to identify and rely on systems that represent different versions or are otherwise related variations of the identified products and systems.

Ref No.	System Name	Short Name	Date Made, Known, Used, Sold, or On Sale
1.	ThunderBYTE Anti-Virus Utilities	“ThunderBYTE”	1995
2.	Norton Antivirus for Internet Email Gateways	“NAV for Gateways”	1997
3.	Norton Antivirus 4.0	“NAV 4.0”	1997
4.	Dr. Solomon’s Anti-Virus Toolkit	“AVTK”	1995
5.	MIMESweeper	“MIMESweeper”	1995
6.	Sophos Sweep/Intercheck	“Sweep”	1997
7.	InterScan AppletTrap	“AppletTrap”	March 1999
8.	VICEd	“VICEd”	January 1997

(i) ThunderBYTE Anti-Virus Utilities

ThunderBYTE was sold, on sale, made, known, and/or used at least by 1995. The features, operations, and functionality of ThunderBYTE are described throughout the ThunderBYTE documentation produced in this case. These documents include:

- ThunderBYTE Anti-Virus Utilities User Manual (“ThunderBYTE Manual”) (PAN_FIN00102692 to PA_FIN00102890)

(ii) Norton Antivirus for Internet Email Gateways

NAV for Gateways was sold, on sale, made, known, and/or used at least by 1997. The features, operations, and functionality of NAV for Gateways are described throughout the NAV for Gateways documentation produced in this case. These documents include:

- “Understanding Symantec’s Anti-virus Strategy for Internet Gateways,” The Symantec Enterprise Papers Vol. XXX (1997) (“Gateways WP”) (PAN_FIN00106864 to PAN_FIN00106877)
- “Understanding and Managing Polymorphic Viruses,” The Symantec Enterprise Papers Vol. XXX (1997) (“Striker WP”) (PAN_FIN00106878 to PAN_FIN00106893)

- 1 • “Symantec Announces Norton Internet Email Gateway at Internet World,” Symantec
2 Press Release (1996) (PAN_FIN00106901 to PAN_FIN00106904)
- 3 • “Symantec Ships Norton AntiVirus for Internet Email Gateways,” Symantec Press
4 Release (1997) (PAN_FIN00106905 to PAN_FIN00106908)
- 5 • “Symantec Announces Norton Antivirus For Firewalls For Maximum Protection From
6 Internet-Borne Viruses,” Symantec Press Release (1997) (PAN_FIN00106894 to
7 PAN_FIN00106900)
- 8 • “Symantec, The Worldwide Leader in Antivirus, Ships Norton Antivirus for Firewalls,”
9 Symantec Press Release (1997) (PAN_FIN00106909 to PAN_FIN00106912)

10 (iii) Norton Antivirus 4.0

11 NAV 4.0 was sold, on sale, made, known, and/or used at least by 1997. The features,
12 operations, and functionality of NAV 4.0 are described throughout the NAV 4.0 documentation
13 produced in this case. These documents include:

- 14 • “Understanding Heuristics: Symantec’s Bloodhound Technology,” Symantec White Paper
15 Series Vol. XXXIV (1997) (“Bloodhound WP”) (PAN_FIN00106921 to
16 PAN_FIN00106937)
- 17 • “Symantec’s Norton AntiVirus 4.0 Delivers Multi-Platform Support,” Symantec Press
18 Release (1997) (PAN_FIN00106917 to PAN_FIN00106920)
- 19 • “Symantec’s AntiVirus Research Center Responds To Mutating Macro Viruses With
20 Bloodhound-Macro Technology,” Symantec Press Release (1997) (PAN_FIN00106913 to
21 PAN_FIN00106916)

22 (iv) Dr. Solomon’s Anti-Virus Toolkit

23 AVTK was sold, on sale, made, known, and/or used at least by 1995. The features,
24 operations, and functionality of AVTK are described throughout the AVTK documentation
25 produced in this case. These documents include:

- 26 • Dr. Solomon’s Anti-Virus Toolkit for Windows and DOS, User Manual (“AVTK
27 Manual”) (PAN_FIN00105097 to PAN_FIN00105337)

(v) MIMESweeper

MIMESweeper was sold, on sale, made, known, and/or used at least by 1995. The features, operations, and functionality of MIMESweeper are described throughout the MIMESweeper documentation produced in this case. These documents include:

- MIMESweeper Administrator Guide, Version 1.0d, Integralis Ltd. (Sept. 1995) (“MIMESweeper Guide”) (PAN_FIN00114688 to PAN_FIN00114767)
- “MIMESweeper package catches computer mail viruses before they are delivered,” Government Computer News (April 28, 1997) (PAN_FIN00114768 to PAN_FIN00114770)
- “MIMESweeper defuses virus network, ‘net mail bombs,” InfoWorld (May 20, 1996) (PAN_FIN00114771 to PAN_FIN00114775)
- “Integralis rolls out smart firewall,” Computerworld (Jan. 29, 1996) (PAN_FIN00114776 to PAN_FIN00114779)

(vi) Sophos Sweep/Intercheck

Sweep was sold, on sale, made, known, and/or used at least by 1997. The features, operations, and functionality of Sweep are described throughout the Sweep documentation produced in this case. These documents include:

- SWEEP for Windows NT Virus Detection User Manual (Oct. 1995) (“Sweep NT Manual”) (PAN_FIN00105957 to PAN_FIN00106069)
- SWEEP for Windows 95 Virus Detection User Manual (Dec. 1995) (“Sweep Win95 Manual”) (PAN_FIN00114599 to PAN_FIN00114680)

(vii) InterScan AppletTrap

AppletTrap was sold, on sale, made, known, and/or used at least by March 1999. The features, operations, and functionality of AppletTrap are described throughout the AppletTrap documentation produced in this case. These documents include:

- TFS00000001 – TFS00005934
- TM-FIN000001 – TM-FIN000563

(viii) **VICEd**

VICEd was sold, on sale, made, known, and/or used at least by 1997. The features, operations, and functionality of VICEd are described throughout the documentation produced in this case. These documents include:

- J. S. Lee, J. Hsiang, and P. H. Tsang, “A Generic Virus Detection Agent on the Internet,” Proceedings of the Thirtieth Hawaii International Conference on System Science, Vol. 4, Jan. 1997, pp. 210-219.

d. 35 U.S.C. § 102(f)

PAN reserves the right to assert that the Asserted Claims are invalid under 35 U.S.C. § 102(f) in the event PAN obtains additional evidence that the inventors named in any of the Asserted Patents did not invent the subject matter claimed therein. Should PAN obtain such evidence, it will provide the name of the person(s) from whom and the circumstances under which the alleged invention or any part of it was derived.

e. 35 U.S.C. § 102(g)

PAN reserves the right to assert that the Asserted Claims are invalid under 35 U.S.C. § 102(g) in the event PAN obtains additional evidence that any of the inventions claimed in the Asserted Patents were made in the United States by another inventor who had not abandoned, suppressed or concealed it, prior to the alleged invention by the applicant of the Asserted Patents. Should PAN obtain such evidence, it will provide the identities of the persons or entities involved in and the circumstances surrounding the making the inventions before the patent applicants.

3. Patent L.R. 3-3(b) Anticipation and Obviousness

The references in Table 1, alone or in combination with the knowledge of one skilled in the art, anticipate or render obvious the Asserted Claims of the '494 Patent.

Table 1: Prior Art References: Anticipation and Anticipation and Primary/Secondary Obviousness References

Short Name	Prior Art Under	Priority Date	Exemplary Claim Chart
ThunderBYTE	102(a), (b)	1995	C-2
NAV for Gateways	102(a), (b)	1997	C-3
NAV 4.0	102(a), (b)	1997	C-8
AVTK	102(a), (b)	1995	C-4
MIMESweeper	102(a), (b)	1995	C-7
Sweep	102(a), (b)	1997	C-9
AppletTrap	102(a), (b)	March 1999	C-5
VICEd	102(a), (b)	January 1997	C-1
Martin	102(a), (b)	February 10, 1997	C-6
Swimmer	102(a), (b)	September 1995	C-10

In addition, each of the references in Table 1 above, either alone, in view of the knowledge of a POSITA, and/or in combination with one or more references in Table 1 or Table 2, renders obvious the Asserted Claims of the '494 Patent.

Table 2: Additional Prior Art References: Obviousness

Short Name	Prior Art Under	Priority Date
Aucsmith	102(a), (b), (e)	August 25, 1995
Ji '348	102(a), (b), (e)	September 10, 1997
Ji '600	102(a), (b), (e)	September 6, 1995
Touboul '683	102(a), (b)	May 22, 1998
Touboul '583	102(a), (b)	July 15, 1999
Atkinson	102(a), (b), (e)	December 6, 1996
McManis	102(a), (b), (e)	December 8, 1995
Necula	102(a), (b), (e)	October 28, 1997
Levy '147	102(a), (b), (e)	April 15, 1997

Short Name	Prior Art Under	Priority Date
Isaak '247	102(a), (b), (e)	December 19, 1997
Abadi '370	102(a), (b), (e)	December 1, 1997
Hinsley '830	102(a), (b), (e)	September 30, 1992
Nachenberg '008	102(a), (b), (e)	September 23, 1997
DSVE	102(a), (b)	1995
MiSFIT	102(a), (b)	1996
Chu	102(a), (b)	June 13, 1997
Härtig	102(a), (b)	1997
Islam	102(a), (b)	October 1997
Kephart	102(a), (b)	1997
Bahreman	102(a), (b)	June 13, 1996
Schnurer	102(a), (b)	December 7, 1995

In addition, PAN incorporates by reference each and every prior art reference of record in the prosecution of the '494 Patent and any related patent or application, the statements made therein by the applicant, as well as the prior art discussed in the specification.

The cited portions of each prior art reference are exemplary and representative of the content of the reference, and should be understood in the context of the reference as a whole, as understood by one of ordinary skill in the art. To the extent a prior art reference is deemed not to anticipate or render obvious a claim as noted in the attached charts for failing to disclose, teach, or suggest one or more limitations of a claim, that claim would nonetheless have been obvious to one of ordinary skill in the art at the time of the alleged invention over the reference itself or by the combination of the reference with one or more other references disclosing the missing claim limitations or the knowledge of a person having ordinary skill in the art.

a. Prior Art Combinations

All of the Asserted Claims of the '494 Patent are obvious based on one or more

combinations of the prior art references above. The sections below provide motivations to combine the prior art references above. These obviousness combinations are provided in the alternative to PAN's anticipation and single-reference obviousness contentions and are not to be construed to suggest that any reference included in the combination is not itself anticipatory or would not render the Asserted Claims obvious in light of the knowledge of a person having ordinary skill in the art. PAN also hereby incorporates by reference the prior art, invalidity grounds, and expert testimony submitted in connection with any petitions for *inter partes* review of the '494 Patent.

b. Motivation to Combine

A POSITA would have been motivated to combine the preceding references for any number of reasons, such as the following exemplary reasons. Teachings, suggestions, motivations, and/or reasons to modify any of the references and/or to combine any two or more of the references can come from many sources, including the prior art, common knowledge, common sense, predictability, expectations, industry trends, design incentives or need, market demand or pressure, market forces, obviousness to try, the nature of the problem faced, and/or knowledge possessed by a POSITA.

Although a patent claim may be invalidated based on a teaching-suggestion-motivation ("TSM") rationale—*i.e.*, that some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior-art reference or to combine prior-art reference teachings to arrive at the claimed invention—the Supreme Court identified additional rationales in *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007). The following of these rationales apply here:

(A) the Asserted Claims combine prior-art elements according to known methods to yield predictable results;

(B) the Asserted Claims involve the simple substitution of one known element for another to obtain predictable results;

(C) the Asserted Claims involve the use of a known technique to improve similar devices (methods, or products) in the same way;

(D) the Asserted Claims apply a known technique to a known device (method, or product) ready for improvement to yield predictable results;

1 (E) the Asserted Claims involve combinations of prior-art references that would
2 have been “obvious to try”—a person of ordinary skill in the art could have
3 reached the Asserted Claims by choosing from a finite number of identified,
predictable solutions, with a reasonable expectation of success;

4 (F) the Asserted Claims are simply variations of work from one field of endeavor
5 or a different one that would have been prompted based on design incentives or
other market forces because the variations were predictable to one of ordinary skill
in the art.

6 *See KSR*, 550 U.S. at 415-18 (rejecting the Federal Circuit’s “rigid” application of the teaching,
7 suggestion, or motivation to combine test, and instead espousing an “expansive and flexible”
8 approach). Indeed, the Supreme Court held that a person of ordinary skill in the art is “a person
9 of ordinary creativity, not an automaton” and “in many cases a person of ordinary skill in the art
10 will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *KSR*, 550
11 U.S. at 420-21.

12 Thus, even in the absence of a specific teaching, suggestion, or motivation to combine
13 references, the Asserted Claims here are obvious and therefore invalid. Each of the cited
14 references or devices is in the same field, making it obvious for someone of ordinary skill in the
15 art to identify and combine elements from these references. One of ordinary skill in the art would
16 have recognized that improvements could be achieved by combining or modifying prior-art
17 references that described such improvements. Each of the above prior-art references describes
18 devices or methods that were known to offer such improvements, and, accordingly, one of
19 ordinary skill in the art would have been motivated to combine or modify the references as
20 identified in each of the combinations above.

21 Indeed, given that the references are in the same field, one of ordinary skill would have
22 readily, with predictable results, taken teachings from one reference and applied them to other
23 references. As referenced above, multiple prior art references teach or suggest the concepts
24 claimed in the ’494 Patent. To the extent Finjan argues that any concepts claimed in the
25 ’494 Patent were not contained in any prior art reference, it would, at a minimum, have been
26 obvious to adapt each reference to include the concept or combine it with other references that
27 disclose the concept. In addition, each of the constituent techniques described here was well
28 known to those of ordinary skill in the art, and understood to be among a menu of available

1 design choices for improving network security. This is one of many motivations to combine the
2 above references.

3 Furthermore, because methods and systems related to protecting network-connectable
4 devices from undesirable downloadable operation were well known and studied extensively prior
5 to the '494 Patent priority date, common industry knowledge supplied a reason to combine the
6 above references with each other. Each combination would have produced no unexpected results
7 and would simply represent a known alternative to one of ordinary skill in the art. This is a
8 further motivation to combine any of the above references.

9 The below sections further address particular reasons to combine the above references.
10 The below should not be construed as an admission that there is any value to the alleged invention
11 of the '494 Patent. As discussed previously, these contentions are based largely on how Finjan is
12 apparently construing the Asserted Claims in its Initial Infringement Contentions, which is an
13 incorrect and overbroad interpretation of the alleged invention of the '494 Patent. Accordingly,
14 to the extent the below refers to benefits of certain elements or industry trends towards these
15 elements, this is not an admission that the alleged invention of the '494 Patent provides any
16 benefits—to the contrary, properly construed and compared to the prior art, the '494 Patent
17 provides no benefits. Likewise, to the extent the below refers to substituting elements, this is not
18 an admission that the elements subject to the substitution are in any way similar, *e.g.*, perform the
19 same function, in the same way, to reach the same result.

20 The various elements of the Asserted Claims were well-known in the prior art at the time
21 of the alleged invention, and the combination was obvious to one of ordinary skill in the art. The
22 combination simply (a) combines prior-art elements according to known methods to yield
23 predictable results; (b) involves the simple substitution of one known element for another to
24 obtain predictable results; (c) involves the use of a known technique to improve similar devices
25 (methods, or products) in the same way; (d) applies a known technique to a known device
26 (method, or product) ready for improvement to yield predictable results; (e) involves
27 combinations of prior-art references that would have been “obvious to try”—a person of ordinary
28 skill in the art could have reached the Asserted Claims by choosing from a finite number of

1 identified, predictable solutions, with a reasonable expectation of success; and/or (f) would have
 2 been prompted by known work, based on design incentives or other market forces, because such
 3 variations were predictable to one of ordinary skill in the art.

4 Moreover, the Supreme Court has stated that a motivation to combine may be simply
 5 “common sense” and that “familiar items may have obvious uses beyond their primary purposes,
 6 and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents
 7 together like pieces of a puzzle.” *KSR*, 550 U.S. at 420. Indeed, the Supreme Court held that it is
 8 sufficient that a combination of elements was “obvious to try,” holding that, “[w]hen there is a
 9 design need or market pressure to solve a problem and there are a finite number of identified,
 10 predictable solutions, a person of ordinary skill has good reason to pursue the known options
 11 within his or her technical grasp.” *Id.* at 421. Here, all the claim elements are common sense and
 12 are easily fit together by one of ordinary skill in the art.

13 While not necessary, a motivation to combine may also be found in the references
 14 themselves. One of ordinary skill in the art would have been motivated to combine a reference
 15 that refers to, or otherwise explicitly invites combination with, another reference. Where the
 16 references cited herein have such an explicit invitation to combine, that invitation would have
 17 motivated one of ordinary skill in the art to combine any such references.

18 **c. Exemplary Obviousness Combinations**

19 The accompanying claim charts explain how different portions of each prior art reference
 20 discloses each limitation of the Asserted Claim. If Finjan argues that any particular prior art
 21 reference lacks any feature, a POSITA as of the ’494 Patent’s priority date would at a minimum
 22 have been motivated to modify the reference to include the allegedly missing feature, or to
 23 combine it with other references that include that feature, as discussed in the previous section.

24 To the extent Finjan asserts that the prior art in Table 1 does not disclose these claim
 25 limitations, it would have been obvious to combine or modify each of the prior art references in
 26 Table 1 with one or more prior art references in Table 1 and/or Table 2 to meet the limitations of
 27 the Asserted Claims, as discussed in ThunderBYTE, NAV for Gateways, NAV 4.0, AVTK,
 28 MIMESweeper, Sweep, AppleTrap, VICEd, Aucsmith, Ji ’348, Ji ’600, Touboul ’683, Touboul

1 '583, Atkinson, McManis, Necula, Levy '147, Isaak '247, Abadi '370, Hinsley '830, Nachenberg
 2 '008, DSVE, MiSFIT, Chu, Härtig, Islam, Kephart, Bahreman, Schnurer, Martin and/or
 3 Swimmer. Exemplary combinations are provided below but do not limit the potential
 4 invalidating combinations disclosed in these contentions or that PAN intends to rely on.

5 To the extent that Finjan argues that the prior art references are missing one or more
 6 elements of the Asserted Claims, it would have been obvious to modify those references such as
 7 described in ThunderBYTE, NAV for Gateways, NAV 4.0, AVTK, MIMESweeper, Sweep,
 8 AppleTrap, VICEd, Aucsmith, Ji '348, Ji '600, Touboul '683, Touboul '583, Atkinson,
 9 McManis, Necula, Levy '147, Isaak '247, Abadi '370, Hinsley '830, Nachenberg '008, DSVE,
 10 MiSFIT, Chu, Härtig, Islam, Kephart, Bahreman, Schnurer, Martin and/or Swimmer . One of
 11 ordinary skill in the art would have been motivated to combine Aucsmith, Ji '348, Ji '600,
 12 Touboul '683, Touboul '583, Atkinson, McManis, Necula, Levy '147, Isaak '247, Abadi '370,
 13 Hinsley '830, Nachenberg '008, DSVE, MiSFIT, Chu, Härtig, Islam, Kephart, Bahreman,
 14 Schnurer, Martin and/or Swimmer with one or more other references identified in Table 1 and
 15 would have reasonably expected that the combination would achieve the intended purpose. Each
 16 reference relates to computer and network security. A person of ordinary skill in the art looking
 17 to create improved computer security methods and products would look to consider solutions
 18 implemented in other computer security methods and products such as those disclosed in at least
 19 ThunderBYTE, NAV for Gateways, NAV 4.0, AVTK, MIMESweeper, Sweep, AppleTrap,
 20 VICEd, Aucsmith, Ji '348, Ji '600, Touboul '683, Touboul '583, Atkinson, McManis, Necula,
 21 Levy '147, Isaak '247, Abadi '370, Hinsley '830, Nachenberg '008, DSVE, MiSFIT, Chu, Härtig,
 22 Islam, Kephart, Bahreman, Schnurer, Martin and/or Swimmer and other references as described
 23 in PAN's Invalidity Contentions and associated claim charts. A person of ordinary skill in the art
 24 looking to solve this problem would review patents, patent publications and prior art systems in
 25 the field of computer and network security such as ThunderBYTE, NAV for Gateways, NAV 4.0,
 26 AVTK, MIMESweeper, Sweep, AppleTrap, VICEd, Aucsmith, Ji '348, Ji '600, Touboul '683,
 27 Touboul '583, Atkinson, McManis, Necula, Levy '147, Isaak '247, Abadi '370, Hinsley '830,
 28 Nachenberg '008, DSVE, MiSFIT, Chu, Härtig, Islam, Kephart, Bahreman, Schnurer, Martin

1 and/or Swimmer and other references as described in PAN's Invalidity Contentions and
2 associated claim charts.

3 One of ordinary skill in the art also would have reasonably expected that such
4 combination of ThunderBYTE, NAV for Gateways, NAV 4.0, AVTK, MIMESweeper, Sweep,
5 AppleTrap, VICEd, Aucsmith, Ji '348, Ji '600, Touboul '683, Touboul '583, Atkinson,
6 McManis, Necula, Levy '147, Isaak '247, Abadi '370, Hinsley '830, Nachenberg '008, DSVE,
7 MiSFIT, Chu, Härtig, Islam, Kephart, Bahreman, Schnurer, Martin and/or Swimmer and other
8 references as described in Table 1, Table 2, and the associated claim charts would achieve the
9 structure and functionality of the Asserted Claims because such a combination would constitute
10 combining prior art elements according to known methods to yield predictable results, and a
11 simple substitution of one known element for another to obtain predictable results. Such a
12 combination also would have been simply applying a known technique to a known method ready
13 for improvement to yield predictable results and would have been obvious to try.

14 **4. Patent L.R. 3-3(c) Invalidity Contentions Charts**

15 Pursuant to Patent Local Rule 3-3(c), charts identifying specifically where and how in
16 each alleged item of prior art each limitation of each asserted claim is found are attached as
17 Exhibits C-1 to C-10. Where elements are disclosed at multiple locations within a single item of
18 prior art, PAN has not necessarily identified every iteration of every disclosure.

19 **5. Patent L.R. 3-3(d) Invalidity Based on 35 U.S.C. § 101, Indefiniteness** 20 **Under 35 U.S.C. § 112(2), or Enablement or Written Description** 21 **Under 35 U.S.C. § 112(1)**

22 Based on PAN's present understanding of the Asserted Claims and/or PAN's apparent
23 construction of the claims, as set forth in Finjan's Infringement Contentions, and subject to the
24 reservation of rights above, PAN lists below the grounds upon which the Asserted Claims of the
25 '494 Patent are invalid based on 35 U.S.C. § 101, indefiniteness, lack of written description,
26 and/or lack of enablement under 35 U.S.C. § 112. To the extent PAN's identified grounds for
27 invalidity are based on Finjan's apparent constructions, PAN is not adopting Finjan's apparent
28 constructions, nor is PAN agreeing that any of Finjan's apparent constructions are correct.
Moreover, Finjan's deficient Infringement Contentions fail to provide PAN with adequate notice

1 as to Finjan's infringement theories. PAN reserves all rights to advance claim construction
2 positions different from Finjan's apparent constructions.

3 PAN's contentions that the following claims are invalid under 35 U.S.C. § 112 are made
4 in the alternative, and do not constitute, and should not be interpreted as, admissions regarding
5 the construction or scope of the Asserted Claims, or that any of the Asserted Claims are not
6 anticipated or rendered obvious by any prior art. Where PAN identifies a claim term in an
7 independent claim as being invalid, PAN further contends any asserted dependent claim is invalid
8 based on the presence of the same term.

9 In light of the deficiencies in Finjan's Infringement Contentions, PAN reserves the right to
10 amend, modify, and/or supplement these Contentions to further identify bases for invalidity under
11 35 U.S.C. § 112. PAN's Contentions shall not be construed as an admission that any claim
12 construction advanced by PAN in this case is in any way inconsistent, flawed or erroneous. Nor
13 should these Contentions prevent PAN from advancing claim construction and/or non-
14 infringement positions in lieu of, or in addition to, invalidity positions. Further, PAN's
15 Contentions shall not be construed as an admission of or acquiescence to Finjan's purported
16 construction of the claim language or of other positions advanced by Finjan during the course of
17 this litigation. PAN's Contentions under 35 U.S.C. § 112 may depend, in part, on the Court's
18 claim construction, as well as Finjan's asserted claim scope. Consequently, PAN only identifies
19 herein the issues under 35 U.S.C. § 112 of which it is presently aware based on PAN's present
20 understanding of the asserted claims and/or Finjan's apparent construction of the claims, as set
21 forth in Finjan's Infringement Contentions. PAN reserves all rights to advance claim
22 construction positions different from Finjan's apparent constructions and to amend these
23 contentions as it better understands Finjan's construction of the claims during the claim
24 construction process.

25 **a. Unpatentable Subject Matter Under 35 U.S.C. § 101**

26 The Asserted Claims of the '494 Patent are directed to non-statutory subject matter, under
27 35 U.S.C. § 101, because the claims are directed to the general idea of deriving security profile
28 data and storing security profile data, which is an abstract concept. The recitation of generic

computer components does not amount to significantly more than the abstract idea itself. *See CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011) (reasoning that the use of the Internet to verify a credit card transaction does not meaningfully add to the abstract idea of verifying the transaction). Moreover, the claims can be performed in the human mind; and to the extent the claims recite any limitations that could not be performed mentally, those limitations are conventional and well-understood activities that do not change the mental character of the claims. *See Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1147 (Fed. Cir. 2016) (finding that claims for translating a functional description of a logic circuit into a hardware component description were abstract because they “can be performed mentally or with pencil and paper”). Additionally, claims 11-16 are directed to software per se. Therefore, the Asserted Claims of the ’494 Patent are not directed to patent-eligible subject matter under 35 U.S.C. §101, and are invalid.

b. Indefiniteness Under 35 U.S.C. § 112(2)

“[A] patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014).

At least the following claim limitations of the Asserted Claims are invalid based on indefiniteness.

- “Downloadable”
- “security profile data”
- “suspicious computer operations”
- “list of suspicious computer operations that may be attempted by the Downloadable”
- “active control”
- “program script”
- “database manager”

c. Lack of Written Description Under 35 U.S.C. § 112(1)

To satisfy the written description requirement, the description must “clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.” *Ariad Pharm., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (internal citation omitted). The test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date. *Id.*

The test requires an objective inquiry into the four corners of the specification from the perspective of a POSITA. Based on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed. “Whether the written description requirement is satisfied is a fact-based inquiry that will depend on the nature of the claimed invention, and the knowledge of one skilled in the art at the time an invention is made and a patent application is filed.” *Carnegie Mellon Univ. v. Hoffmann La Roche Inc.*, 541 F.3d 1115, 1122 (Fed. Cir. 2008) (internal citation omitted). Actual “possession” or reduction to practice outside of the specification is not enough. Instead, the specification itself must demonstrate possession.

While the written description requirement does not demand any particular form of disclosure, a description that merely renders the invention obvious does not satisfy the requirement. *Lockwood v. Am. Airlines*, 107 F.3d 1565, 1571-72 (Fed. Cir. 1997).

At least the following claim limitations of the Asserted Claims are invalid for lack of written description:

- “deriving security profile data for the Downloadable, including a list of suspicious computer operations that may be attempted by the Downloadable”
- “storing the Downloadable security profile data in a database”
- “wherein the Downloadable includes an active control”
- “wherein the Downloadable includes program script”
- “a Downloadable scanner coupled with said receiver, for deriving security profile data for the Downloadable, including a list of suspicious computer operations that

1 may be attempted by the Downloadable”

- 2 • “a database manager coupled with said Downloadable scanner, for storing the
- 3 Downloadable security profile data in a database”
- 4 • “suspicious computer operations include calls made to an operating system, a file
- 5 system, a network system, and to memory”

6 **d. Lack of Enablement Under 35 U.S.C. § 112(1)**

7 To satisfy the enablement requirement of 35 U.S.C § 112, the disclosure “must teach those
8 skilled in the art how to make and use the full scope of the claimed invention without ‘undue
9 experimentation.’” *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365 (Fed. Cir. 1997)
10 (citations omitted). Moreover, “[i]t is the specification, not the knowledge of one skilled in the
11 art, that must supply the novel aspects of [the] invention in order to constitute adequate
12 enablement.” *Id.* at 1366. The Federal Circuit has enumerated several factors to consider in
13 determining whether a disclosure would require “undue experimentation”: “(1) the quantity of
14 experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or
15 absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the
16 relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the
17 breadth of the claims.” *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988).

18 At least the following claim limitations of the Asserted Claims are invalid for lack of
19 enablement:

- 20 • “deriving security profile data for the Downloadable, including a list of suspicious
- 21 computer operations that may be attempted by the Downloadable”
- 22 • “storing the Downloadable security profile data in a database”
- 23 • “a Downloadable scanner coupled with said receiver, for deriving security profile
- 24 data for the Downloadable, including a list of suspicious computer operations that
- 25 may be attempted by the Downloadable”
- 26 • “a database manager coupled with said Downloadable scanner, for storing the
- 27 Downloadable security profile data in a database”
- 28 • “suspicious computer operations include calls made to an operating system, a file

1 system, a network system, and to memory”

2
3 **II. PATENT LOCAL RULE 3-4 DOCUMENT PRODUCTION ACCOMPANYING**
4 **INVALIDITY CONTENTIONS**

5 **A. Patent L.R. 3-4(a) Accused Product Documentation**

6 Pursuant to Patent L.R. 3-4(a), PAN has produced the following documentation sufficient
7 to show the operation of aspects or elements of accused instrumentalities identified by Finjan in
8 its Patent L.R. 3-1(c) charts located during a reasonable search: PAN_FIN00000225 to
9 PAN_FIN00000414; PAN_FIN00000847 to PAN_FIN00001020; PAN_FIN00001036 to
10 PAN_FIN00001058; PAN_FIN00001127 to PAN_FIN00001178; PAN_FIN00000236 to
11 PAN_FIN00000388; PAN_FIN00000593 to PAN_FIN00000764; PAN_FIN00000789 to
12 PAN_FIN00000806; PAN_FIN00001059 to PAN_FIN00001073; PAN_FIN00001088 to
13 PAN_FIN00001094; PAN_FIN00001179 to PAN_FIN00001189; PAN_FIN00001332 to
14 PAN_FIN00001341; PAN_FIN00003642 to PAN_FIN00003671; PAN_FIN00004734 to
15 PAN_FIN00004742; PAN_FIN00005972 to PAN_FIN00005988; PAN_FIN00006044 to
16 PAN_FIN00006053; PAN_FIN00006124 to PAN_FIN00006132; PAN_FIN00008165 to
17 PAN_FIN00008166; PAN_FIN00008281 to PAN_FIN00008414; PAN_FIN00008682 to
18 PAN_FIN00008684; PAN_FIN00008710 to PAN_FIN00008712; PAN_FIN00008755 to
19 PAN_FIN00008772; PAN_FIN00008914 to PAN_FIN00008940; PAN_FIN00008957 to
20 PAN_FIN00008966; PAN_FIN00008977 to PAN_FIN00009003; PAN_FIN00009005 to
21 PAN_FIN00009013; PAN_FIN00009015 to PAN_FIN00009021; PAN_FIN00009040 to
22 PAN_FIN00009044; PAN_FIN00009058 to PAN_FIN00009068; PAN_FIN00009074 to
23 PAN_FIN00009077; PAN_FIN00009203 to PAN_FIN00009212; PAN_FIN00010141 to
24 PAN_FIN00010308; and PAN_FIN00010328 to PAN_FIN00010409; PAN_FIN00000001 to -
25 PAN_FIN00000224; PAN_FIN00000807 to PAN_FIN00000846; PAN_FIN00000853 to
26 PAN_FIN00000858; PAN_FIN00001021 to PAN_FIN00001035; PAN_FIN00001074 to
27 PAN_FIN00001087; PAN_FIN00001095 to PAN_FIN00001126; PAN_FIN00001190 to
28 PAN_FIN0001331; and PAN_FIN00006190 to PAN_FIN00008043; PAN_FIN00118323 to
PAN_FIN00141098;. Moreover, PAN has made source code related to the accused

1 instrumentalities available for Finjan's inspection for over one year. Before the stay order in
 2 December 2015, Finjan had over nine months of access to PAN source code and deposed a PAN
 3 witness on that code. After the stay was lifted in January 2021, Finjan has had over three months
 4 of access to updated PAN source code. PAN continues to make its source code available for
 5 inspection. PAN reserves the right to supplement or amend this disclosure if, and as, warranted.

6 **B. Patent L.R. 3-4(b) Prior Art**

7 Pursuant to Patent L.R. 3-4(b), PAN has produced or is concurrently producing copies of
 8 the prior art identified in the tables above: PAN_FIN00100675 to PAN_FIN00118322,
 9 PAN_FIN00142987 to PAN_FIN00143822. PAN reserves the right to supplement or amend this
 10 disclosure if, and as, warranted.

11 **C. Patent L.R. 3-4(d) Sales, Revenue, Cost, and Profits**

12 Pursuant to Patent L.R. 3-4(d), PAN has produced the following documents sufficient to
 13 show the sales, revenue, cost, and profits for the accused instrumentalities identified in Finjan's
 14 Infringement Contentions: PAN_FIN00141099 to PAN_FIN00142878, PAN_FIN00143823 to
 15 PAN_FIN00143825. PAN reserves the right to supplement or amend this disclosure if, and as,
 16 warranted.

17 **D. Patent L.R. 3-4(e) Agreements and Patent L.R. 3-4(c) Licenses**

18 Pursuant to Patent L.R. 3-4(e), PAN has produced copies of the following agreements that
 19 PAN may use to support its damages case: PAN_FIN00142879 to PAN_FIN00142986. One or
 20 more of these agreements may also fall within the category set forth by Patent L.R. 3-4(c)
 21 pending review of Finjan's Damages Contentions to be served on July 6, 2021. In addition to the
 22 above-disclosed documents, there are additional documents that may fall within these categories
 23 but that PAN is precluded by confidentiality provisions from disclosing until after a notice period
 24 has been provided. PAN is taking steps to comply with its third party confidentiality obligations
 25 and will produce the additional documents after the applicable notice periods expire. PAN
 26 reserves the right to supplement or amend this disclosure if, and as, warranted.

1 Dated: May 17, 2021

MORRISON & FOERSTER LLP

2
3 By: /s/ Diek Van Nort

4 Diek Van Nort

5 Attorneys for Defendant
6 PALO ALTO NETWORKS, INC.
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CERTIFICATE OF SERVICE

I declare under penalty of perjury that on May 17, 2021, I served a copy of:

**DEFENDANT PALO ALTO NETWORKS, INC.'S INVALIDITY
CONTENTIONS AND RELATD DISCLOSURES PURSUANT TO
PATENT LOCAL RULES 3-3 AND 3-4**

☒ **BY ELECTRONIC SERVICE [Fed. Rule Civ. Proc. Rule 5(b)]** by electronically mailing a true and correct copy through Morrison & Foerster LLP's electronic mail system to the e-mail address(s) set forth below, or as stated on the attached service list per agreement in accordance with Federal Rule of Civil Procedure Rule 5(b).

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24 Executed at San Francisco, California, this 17th day of May, 2021.

25 By: /s/ Christopher M. Meier
26 Christopher M. Meier
27
28